Supreme Court, U.S.
FILED
98 239 AUG 5 1998
OFFICE OF THE CLERK

No.

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1997

HESTER INDUSTRIES, INC.,

Petitioner,

vs.

STEIN, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

ROBERT W. ADAMS
Counsel of Record
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4000

Attorneys for Petitioner

126 PP

QUESTION PRESENTED

Did the United States Court of Appeals for the Federal Circuit judicially negate the statutory provisions concerning broadening patent reissues by misinterpreting the word "error" in 35 U.S.C. § 251 through an improper expansion of the "recapture rule" contrary to (a) the clear legislative history and intent of Congress as manifested by the primary author of the reissue statute, (b) prior case law and (c) the long-established practice and regulations of the Patent Office?

PARTIES TO THE PROCEEDING

In addition to the two parties named in the caption, Hester Industries, Inc. merged with ConAgra Corporation after the filing of the Notice of Appeal. This merger took place on December 17, 1997.

Stein, Inc. was acquired by FMC Corporation in 1996, *i.e.*, about the time of the filing of the complaint on May 22, 1996.

TABLE OF CONTENTS

QUESTION PRESENTED i

PARTIES TO THE PROCEEDING ii

TABLE OF CONTENTS iii

TABLE OF CITATIONS iv

APPENDIX vii

OPINIONS BELOW 1

STATEMENT OF JURISDICTION 2

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED 2

STATEMENT OF THE CASE 3

Undisputed Facts 9

The District Court's Decision 12

The Federal Circuit's Decision 13

REASONS FOR GRANTING THE WRIT 18

I. THE OPINION BELOW CONFLICTS WITH THE LEGISLATIVE INTENT OF SECTION 251 CONCERNING THE RECAPTURE RULE 18

II. THE OPINION BELOW CONFLICTS WITH THE EXPRESS STATUTORY LANGUAGE OF SECTION 252 MANDATING FAIRNESS TO BOTH THE PATENT OWNER AND THE PUBLIC AS DEFINED BY THE INTERVENING RIGHTS DOCTRINE 23

CONCLUSION 26

TABLE OF CITATIONS

Cases Cited **Page**

In re Amos, 953 F.2d 613 (Fed. Cir. 1991)..... 4, 12

Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1961). 7

Ball Corp. v. United States, 729 F.2d 1429 (Fed. Cir. 1984)..... passim

In re Clement, 131 F.3d 1464 (Fed. Cir. 1997).....19

Dobson v. Lees, 137 U.S. 258 (1890)..... 5

Ethicon Endo-Sugery, Inc. v. United States Surgical Corp., 93 F.3d 1572 (Fed. Cir. 1996)..... 4

Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, (Fed. Cir. 1985).....22

Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472 (Fed. Cir. 1998) ..... passim

Hester Indus., Inc. v. Stein, Inc., 963 F. Supp. 1403 (E.D. Va. 1997) ..... passim

In re Hounsfield, 699 F.2d 1320 (Fed. Cir. 1983)..... 4

Interconnect Planning Corp. v. Feil, 774 F.2d 1132 (Fed. Cir. 1985).....22

Kingsdown Med. Consultants v. Hollister Inc., 863 F.2d 867 (Fed. Cir. 1988). 4

Leggett v. Avery, 101 U.S. 256 (1880) 5

Litton Sys. Inc. v. Honeywell Inc., ___ F.3d ____, 47 U.S.P.Q.2d 1106 (Fed. Cir. 1998)..... passim

Mahn v. Harwood, 112 U.S. 354 (1884)..... 5

Mentor Corp. v. Coloplast, Inc., 998 F.2d 992 (Fed. Cir. 1993)..... 18

Miller v. Brass Co., 104 U.S. 350 (1882)..... 5

Morey v. Lockwood, 75 U.S. 230 (1869)..... 5

Newton v. Furst & Bradley Mfg. Co., 119 U.S. 373 (1886)..... 5

Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991) 3

Sperry v. Florida ex rel. Florida Bar, 373 U.S. 379 (1963) 4

Texas Instruments, Inc. v. United States International Trade Commission, 988 F.2d 1165 (Fed. Cir. 1993) 16

Topliff v. Topliff, 145 U.S. 156 (1892) 3, 17

U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668 (1942)..... 12

Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997) ..... passim

In re Wilder, 736 F.2d 1516 (Fed. Cir. 1984).....3 & 4

W.L. Gore & Assoc. Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) 8

Other Authorities **Page**

28 U.S.C. § 1254(1) 2
U.S. Const. Art. 1, sec. 8, cl. 8 2
35 U.S.C.A. § 251 ..... passim
35 U.S.C.A. § 252 ..... passim
P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 2 (1954) ..... passim
Hon. G. Rich, *Congressional Intent - Or, Who Wrote The Patent Act of 1952, in Patent Procurement and Exploitation* 13-16 (1963) 5
Rule 56 of the Federal Rules of Civil Procedure.....12
35 U.S.C.A. § 282 (1998) 22
Manual of Patent Examining Procedure (6th ed., rev. 3, 1997) 22

APPENDIX

Appendix A – Opinion of the United States Court of Appeals for the Federal Circuit Filed May 7, 1998 ..... 1a

Appendix B – Order of Mandate of the United States Court of Appeals for the Federal Circuit Filed May 28, 1998 ..... 30a

Appendix C – Order of the United States District Court for the Eastern District of Virginia, at Arlington, Dated March 25, 1997 and Memorandum Opinion Dated May 6, 1997 .. 31a

Appendix D – Oral opinion of the United States District Court for the Eastern District of Virginia at Arlington, Dated March 25, 1997 ..... 62a

Appendix E -- Cover and Pages 85 and 87 from "A Patent and Trademark Office Review" for Fiscal Year 1997 ..... 81a

Appendix F – Portions of J. P. Federico, Commentary on the 1952 Patent Act 83a

Appendix G -- Section 1412.02 of the *Manual of Patent Examining Procedure* (6th ed., rev. 3, 1997) 91a

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1997

HESTER INDUSTRIES, INC.,
PETITIONER

V.

STEIN, INC.
RESPONDENT

PETITION FOR WRIT OF CERTIORARI

Petitioner, Hester Industries, Inc. ("Hester"), respectfully requests issuance of a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998) (App. A). The order issued on May 28, 1998 (App. B).

The decision of the district court is reported at *Hester Industries, Inc. v. Stein, Inc.*, 963 F. Supp. 1403

(E.D. Va. 1997) (App. C). The oral opinion upon which this decision is based is not reported (App. D).

STATEMENT OF JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") was entered on May 7, 1998. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, Section 8, Clause 8 of the Constitution provides that Congress shall have the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. Art. 1, §8, cl. 8.

Section 251 of Title 35 provides, in para. 4, that "[n]o reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." 35 U.S.C.A. §251 ¶ 4 (1984).

Section 252 of Title 35 (as in effect prior to January 1, 1996)[1] provides, in para. 2, that "[n]o reissued patent shall abridge or affect the right of any person or his

---

[1] Pub. L. 103-465 (effective January 1, 1996) expanded this statute to include an "offer for sale." *See* 35 U.S.C.A. § 252 historical and statutory notes (1998). However, Hester's Re. Pat. No. 33,510 issued on January 1, 1991. Thus, the "offer to sell" provisions are not applicable.

successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue." 35 U.S.C.A. §252 ¶ 2 (1984) (amended 1994).

STATEMENT OF THE CASE

Congress and the courts have long recognized that patent applicants and their counsel often make errors of judgment and misunderstand the scope of patentable subject matter. *See, e.g., In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984); *see also Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1575 (Fed. Cir. 1991) ("The law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue"). Indeed, this Court has long recognized that "[t]he specification and claims of a patent ... constitute one of the most difficult legal instruments to draw with accuracy." *Topliff v. Topliff*, 145 U.S. 156, 171

(1892); *see also Sperry v. Florida ex rel. Florida Bar*, 373 U.S. 379, 383 (1963) (quoting *Topliff*, 145 U.S. at 171).

For these reasons, the patent owner is entitled to seek expanded reissue patent protection for his invention as broadly as his invention disclosure and the prior art permit. *See e.g., In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991) (holding that the proper inquiry is whether, based on "the entirety of the original disclosure ... an inventor could fairly have claimed the newly submitted" reissue claims in the original application); *In re Hounsfield*, 699 F.2d 1320, 1323 (Fed. Cir. 1983). A patent owner is even entitled to seek a broadened reissue patent based upon his knowledge of a competitor's product. *See e.g., Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1575-1576, 1579 (Fed. Cir. 1996); *cf. Kingsdown Med. Consultants v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988) (continuation application).

Congress enacted Section 251 of Title 35 to provide a specific statutory remedy of broadening reissue for correcting an "error" on the part of the inventor or his attorney in claiming "more or less than he had a right to claim in the patent." The courts have uniformly recognized the "remedial" nature of the statute and have mandated that the "error" requirement should be "liberally construed." *See In re Wilder*, 736 F.2d at 1519; *Ball Corp. v. United States*, 729 F.2d 1429, 1435-36 (Fed. Cir. 1984) (broadly construing the term "error").

Because reissue patents require a second proceeding at the United States Patent and Trademark Office (USPTO), they are particularly valuable intellectual property rights. Indeed, unlike most patent applications, they are normally

filed only in situations where patent protection is sought to protect existing, commercially valuable products or processes. The USPTO grants several hundred of these commercially valuable reissue patents every year. (App. E) Although no official USPTO statistics are maintained on this point, Petitioner believes that most of these reissue patents are "broadened" reissues that contain claims broader than those in the original patent.

This Court has long recognized the fundamental public importance of reissue patents. Bearing in mind that patent opinions make up a small percentage of this Court's decisions, it is noteworthy that this Court has decided at least twenty (20) cases relating to reissue patents. *See, e.g., Dobson v. Lees*, 137 U.S. 258 (1890); *Newton v. Furst & Bradley Mfg. Co.*, 119 U.S. 373 (1886); *Mahn v. Harwood*, 112 U.S. 354 (1884); *Miller v. Brass Co.*, 104 U.S. 350 (1882); *Leggett v. Avery*, 101 U.S. 256 (1880); *Morey v. Lockwood*, 75 U.S. 230 (1869).

However, all of these decisions relate to statutory provisions or judicial holdings that are no longer in force in view of the 1952 Patent Act. As a result, the decisions are not binding or controlling upon the current reissue statutes.

For the first time since 1870, a major revision in the patent laws was enacted by the 1952 Patent Act, 35 U.S.C. § 1 *et seq*. See P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 2 (1954) (App. F), which sets forth the definitive explanation of the meaning of the 1952 Patent Act as well as its legislative history and intent.[2]

---

[2] Mr. P. J. Federico was the primary drafter of the 1952 Patent Act and was Examiner-In-Chief of the Patent Office at the time the new law was drafted. *See* Hon. G. Rich, *Congressional Intent –*

Under the new reissue patent provisions (35 U.S.C. §§ 251 and 252 in the 1952 Act), Congress retained some portions of the existing law but it also enacted substantial changes. *See id.* at 43-47. As is relevant here, Section 251 of the 1952 Patent Act codified a two-year deadline for filing broadening reissue patent applications. This deadline was a change in existing law because varying time periods had been permitted by the courts. *See id.* at 44-45. A broadening reissue is generally defined as one or more broader claims that cover a product or process that would not infringe any claim of the original patent. *See id.*

On the other hand, the "error" provisions of Section 251 were enacted by Congress without changing existing law. "There is no indication in the printed record that this change in language was intended to effect any change in substance....." *Id.* at 43. In this regard, the prior law relating to "error" was "rather liberally construed, except when reissue sought to recapture claims cancelled during the prosecution of the original patent." *Id.*

Thus, the clear legislative intent of Section 251 is that broadening reissue applications are appropriate, so long as they are filed within two years of the issuance of the original patent and provided they do not seek to "recapture claims cancelled during the prosecution of the original patent." This "recapture rule" encompasses only the limited situation where a claim in the original application is either amended to add new limitations or is cancelled *in toto* and, thereafter during reissue proceedings, the patent owner

---

Or, Who Wrote The Patent Act of 1952, in Patent Procurement and Exploitation 13-16 (1963).

attempts to "recapture" what he gave up by the amendment or cancellation in the original application.

Finally, the second paragraph of Section 252 expressly defines the "intervening rights" of the public vis-a-vis claims in reissue patents. This paragraph is not merely a codification of existing law, "since it varies in some respects from the case law and should be considered on its own terms." *Id.* at 45-46.

Section 252 provides for two forms of "intervening rights" protection. First, there is an absolute protection for any "specific objects actually made before the grant of the reissued patent and does not extend to the making of additional objects of identical or like kind." *Id.* at 46-47.[3] Second, discretionary protection may be granted by the court based on equitable factors. In general those equitable factors involve, *inter alia*, a showing by the third party of "substantial preparation" prior to the grant of the reissue and the "protection of investments made or business commenced" before the reissue grant. 35 U.S.C.A. § 252 ¶ 2 (last sentence).

Despite this Court's recognition of the importance of reissue patents, since the enactment of the 1952 Patent Act, no reissue patent case has been decided by this Court. Petitioner submits that the Federal Circuit departed from and confused the clear intent of the 1952 Patent Act. In the

---

[3] Even this "absolute protection" is subject to the "reconstruction" exception. *Cf. Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345-46 (1961) (citation omitted) ("The decisions of this Court require the conclusion that reconstruction of a patented entity, comprised of unpatented elements, is limited to such a true reconstruction of the entity as to 'in fact make a new article....'").

present case, the Federal Circuit created new law that is contrary to the express remedial provisions of the reissue statutes and is contrary to the legislative intent.

Specifically, the Federal Circuit invalidated Hester's broadened reissue patent rights by holding for the first time and contrary to prior law (1) that the recapture doctrine is not limited to claim amendments but also encompasses attorney arguments alone without any claim amendments and (2) that the rights of third parties are to be determined under the doctrine of prosecution history estoppel, rather than by applying the intervening rights test defined in Section 252.

The net effect of this decision is to effectively invalidate most (if not all) broadening reissue patents since attorney arguments that "the claims as a whole" define over the prior art can be found in literally every patent application. *See, e.g., W.L. Gore & Assoc. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed. Cir. 1983) (by law, "[e]ach claimed invention must be considered as a whole"). Under the rationale of the Federal Circuit, virtually any argument as to the differences between the claims and the prior art would forever bar broadening reissue, even in the complete absence of claim amendment or cancellation.

In addition, the Federal Circuit decision overrules the long-established policy of the USPTO with respect to the grant of broadening reissues. Therefore, a conflict exists between the policy of the USPTO (as reflected, for example, in the grant of the Hester reissue patents) and the Federal Circuit decision at issue in this petition.

Undisputed Facts

This case does not present any issue of disputed fact. The parties and the courts below agree that:

1. Hester filed its original patent application for a "High Humidity Steam Cooker With Continuously Running Conveyor" in July 1979.

2. The original patent application as filed had only one independent claim (claim 1). At no time during the prosecution of the original patent application was a claim presented to the USPTO that was commensurate in scope with the reissue patent claims at issue in this case.

3. Throughout the prosecution of the original patent application, no substantive amendment was made to claim 1. Thus, all of the limitations that were removed in the reissue patent claims at issue were always in claim 1 of the original patent application from the date that application was filed until the date that it issued on April 15, 1986 as U.S. Pat. No. 4,882,047.

4. Claim 1 of the original patent application is a "picture claim" that includes nearly every limitation of the preferred embodiment of the invention. Moreover, claim 1 was the only independent claim presented to the USPTO. The filing of only one independent claim is highly unusual because patent attorneys normally attempt to define the invention in more than one way with various different independent claims.

5. Throughout the prosecution of the original patent application, Hester's attorney (Laurence R. Brown, Esq.)

argued on many occasions that claim 1, as a whole, served to distinguish the invention over the cited prior art. For example, he argued in his appeal brief (page 8) that the Examiner cited "no prior art fairly showing the entire claimed combination." These limitations include (a) cooking solely with steam and (b) the use of two steam sources.

6. After issuance of the original patent in April 1986, Hester learned in January 1988 that Stein planned to manufacture and sell a cooker in the future that Hester believed would incorporate its invention. After obtaining the opinion of counsel, Hester timely filed a broadening reissue patent application based upon the "error" of the inventor and the attorney in failing to properly claim the full scope of the invention. Hester also notified Stein of its intention to file such a broadening application in early 1988.

7. Hester filed its reissue application in a timely manner within two years of the grant of the original Pat. No. 4,882,047 on April 15, 1986. The inventor's declarations to the USPTO expressly state that the "error" was that neither he (Mr. Elwood Williams) nor attorney Brown fully appreciated the broad scope of claims to which he was entitled and, for that reason, broader claims were not presented in the original patent application.

8. Hester did not amend the description of the invention in the reissue application. However, it did submit new, broadened reissue claims.

9. Through reissue, Hester broadened its patent claims by removing limitations repeatedly argued by

attorney Brown during the original patent prosecution. Thus, the reissue claims focused upon the use of "high humidity steam" to directly cook food products on a spiral conveyor within a closed cooker during a continuous food processing operation. After carefully reviewing the prior art (including prior art provided by Stein), the USPTO agreed with Hester's arguments and granted Hester two reissue patents.

10. Stein did not sell its first cooker of the type involved in this litigation until December 1990 (which was many months after it had been notified by Hester that Hester's first reissue patent had been allowed).

11. Two reissue patents were ultimately granted by the USPTO to Hester – *i.e.*, Re. Pat. No. 33,510 issued on January 1, 1991, and Re. Pat. No. 35,259 issued on June 4, 1996.

12. Hester and Stein intermittently engaged in settlement and other discussions relating to the reissue applications from at least as early as the summer of 1990 to May 22, 1996. Hester filed suit against Stein on May 22, 1996.

13. In December 1996, Stein filed a motion for summary judgment relating to the "error" provision of Section 251. This motion was denied by (then) Chief Judge J. C. Cacheris.

14. Just prior to trial in March 1997, Stein renewed its motion for summary judgment. At the close of the first day of trial, Judge T. S. Ellis, III read an opinion from the bench (App. D) granting Stein's motion and invalidating

Hester's reissue patents. A written Opinion (App. C) was entered a few weeks later.

The District Court's Decision

The district court's decision invalidated Hester's reissue patents on two separate legal grounds. *See Hester Indus., Inc.*, 963 F. Supp. at 1412. Because the second ground for invalidity was reversed by the Federal Circuit, *see Hester Indus., Inc.*, 142 F.3d at 1485, it need not be discussed in detail.[4]

As is relevant here, the district court's decision focused upon the "error" requirement of Section 251 and held that this requirement was not satisfied because Hester's original decision not to seek different claims in the original patent application was "intentional."[5] In short, the district

---

[4] By way of brief summary, the district court held on this second ground that the Hester reissue patents failed to meet the "original invention" requirement of Section 251 as applied in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942). *See Hester Indus., Inc.*, 963 F. Supp. at 1412-15. The Federal Circuit reversed this holding because the enactment of Section 251 in the 1952 Act eliminated the separate requirement of an objective "intent to claim" and because the *U.S. Industrial* decision was based upon an earlier reissue statute that required the reissue claims to be for the "same invention." *See Hester Indus., Inc.*, 142 F.3d at 1484-85 (citing *In re Amos*, 953 F.2d at 616-19).

Indeed, Section 251 of the 1952 Patent Act includes neither the "original invention" nor the "same invention" language relied upon by the district court and Stein.

[5] On appeal, Hester argued that this holding as to "intent" constituted an improper finding of fact contrary to the requirements of Rule 56 of the Federal Rules of Civil Procedure. As will be discussed *infra*, the Federal Circuit did not adopt this finding by the district court but, instead, based its holding of invalidity solely on Hester's alleged

court concluded that the alleged failure of Hester's counsel to appreciate the scope of the invention was belied by the language of the original patent claims, the prosecution history of the original patent and the alleged absence of an explanation as to the nature or cause of the attorney's failure to appreciate the full scope of the invention. *See Hester Indus., Inc.*, 963 F. Supp. at 1411-12.

Significantly, however, neither the lower court nor Stein provided any factual evidence that either the inventor or attorney Brown ever considered any claims broader than claim 1 prior to or during the prosecution of the original patent application. Thus, for this reason (and others), Hester filed a timely appeal to the Federal Circuit noting, *inter alia*, that the question of intent is a disputed factual issue that should not have been decided by way of summary judgment. Moreover, there is no evidence that the inventor or attorney Brown ever considered broader claims during the original prosecution. On this basis, Hester argued that summary judgment should have been entered in its favor since there can be no "intentional" decision under those circumstances.

The Federal Circuit's Decision

The Federal Circuit affirmed the district court's holding of invalidity under Section 251. However, in doing so, it rejected the rationale of the district court. Instead, it held that Hester's reissue claims violate the recapture rule, even though no claim amendments or cancellations were

---

violation of the recapture rule. *See Hester Indus., Inc.*, 142 F.3d at 1484-85. Thus, this factual dispute concerning the "intent" of the inventor and attorney is not relevant to this petition.

made to claim 1 of Hester's original patent during prosecution. *See Hester Indus., Inc.*, 142 F.3d at 1484.

At the outset, the Federal Circuit conceded that "[o]ne of the most commonly asserted 'errors' in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application." *Id.* at 1479-80. The court then focused upon the question of whether Hester's reissue patents violated the recapture rule.

In its opinion, the Federal Circuit plainly admitted that it has never decided the question of whether the recapture rule applies to the situation in which no claim amendments or cancellations were made. Thus, the Federal Circuit conceded that its decision creates new law – "Prior to this case, this court has not squarely addressed the question." *Id.* at 1481.

Significantly, the Federal Circuit also did not consider the legislative history or intent of the 1952 Patent Act with respect to the recapture rule. Moreover, every case cited by the court in its opinion limited application of the recapture rule to situations where there was a claim amendment or cancellation. *See id.* at 1480-81. Of course, there was no such claim amendment or cancellation during the Hester's original patent prosecution.

Likewise, although the Federal Circuit noted that the reissue statutes are based upon "fundamental principles of equity and fairness," *see id.* at 1481 (citation omitted), it failed to take into account or apply the equitable factors that the reissue statute identifies with respect to the public interest via the intervening rights doctrine of Section 252.

As a result, the court simply ignored the specific intervening rights factors mandated by that statute.

Rather, the court relied upon this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), as support for its holding that attorney arguments alone bar subsequent reissue patents. *See Hester Indus., Inc.*, 142 F.3d at 1481-82. However, this Court did not address reissues in *Warner-Jenkinson*. Indeed, this Court gave no indication whatsoever in that decision that prosecution history estoppel had any relationship to the remedial rights conveyed by reissue statutes or that it can be equated with the recapture rule.

The Federal Circuit improperly relied upon *Warner-Jenkinson* to support the application of prosecution history estoppel in the absence of claim amendment or cancellation. In contrast, however, this Court actually stated: "Our prior cases have consistently applied prosecution history estoppel only where claims have been amended for a limited set of reasons, and we see no substantial cause for requiring a more rigid rule invoking an estoppel regardless of the reasons for a change." *Warner-Jenkinson Co.*, 520 U.S. at 26 (emphasis added).

Thus, this Court's decision in *Warner-Jenkinson* does not support the Federal Circuit opinion below. Indeed, Judge Plager (who wrote the Federal Circuit *Hester* decision at issue in this petition) recently admitted that he is unsure of the meaning of the language in the *Warner-Jenkinson* decision with respect to prosecution history estoppel. *See Litton Sys. Inc. v. Honeywell Inc.*, ___ F.3d ___, 47 U.S.P.Q.2d 1106, 1107 (Fed. Cir. 1998) (Plager,

J., dissenting) ("It is not clear to me exactly what the Supreme Court had in mind ....").[6]

As an alternative basis, the Federal Circuit relied upon its decision in *Texas Instruments Inc. v. United States International Trade Commission*, 988 F.2d 1165 (Fed. Cir. 1993) to support its opinion that arguments alone (*i.e.*, without any claim amendment or cancellation) can give rise to prosecution file estoppel. *See Hester Indus., Inc.*, 142 F.3d at 1482. However, that citation is equally improper because *Texas Instruments* involved neither the recapture doctrine nor even a reissue patent. Thus, the considerations relevant to Sections 251 and 252 were not present there.[7]

The Federal Circuit concluded that Hester did not satisfy the "error" requirement of Section 251 and found that the attorney prosecuting the original patent application made arguments regarding the scope of the invention resulting in a "surrender" of subject matter. Thus, the

---

[6] Moreover, in *Litton*, at least two other Federal Circuit judges questioned whether the court was adhering to this Court's instructions in *Warner-Jenkinson*. *See Litton Sys. Inc.*, 47 U.S.P.Q.2d at 1107 (Clevenger, J., dissenting) ("Someone, in this case or in another case soon, should explain to the Supreme Court" that this panel did not follow the language of the decision in *Warner-Jenkinson*.); *id.* at 1112 (Gajarsa, J., dissenting) ("I believe the Litton panel misreads the clear instructions of *Warner-Jenkinson*.").

[7] The Federal Circuit decision in *Hester* at issue here recognized an exception to the recapture rule where the patentee broadens the claim in some aspects but also adds limitations that materially narrow the claim in other aspects. *See Hester Indus., Inc.*, 142 F.3d at 1482-83. Although Hester disagrees with the court's factual application of that issue to this case, it does not appeal that issue because the absence of any claim amendment or cancellation in the original Hester patent application makes the recapture rule simply inapplicable here.

Court held that the broadened reissue claims were invalid under Section 251 because they violated the judicially created "recapture rule." *See id.* at 1482-84. This unprecedented holding by the Federal Circuit must be reviewed by this Court for the following reasons.

The essence of the recapture rule is that a conscious and deliberate decision was made during the original prosecution to "surrender" certain subject matter by claim amendment or cancellation in the face of a rejection by the USPTO. However, as a threshold to such a "surrender" under the recapture rule, the applicant and his attorney must have actually considered the broader claim at that time. It is for this reason that the "error" provision of the reissue statutes has encompassed the situation where the patent attorney or the inventor did not understand the full scope of the invention during the original prosecution.

Thus, the purpose of Sections 251 and 252 of Title 35 is to permit patentees to return to the USPTO to correct an "error" involving their misunderstanding about the true scope of the invention. In other words, the law expressly permits patentees to seek broader claims within two years after the patent issues, even where they discover that "error" after the patent issued. That is exactly the situation in this case. Hester never "surrendered" any broader claim during the original prosecution because neither the attorney nor the patent applicant ever considered any broader claims at that time. In this regard, Hester again notes that this Court has specifically recognized that a patent's specifications and claims "constitute one of the most difficult legal instruments to draw with accuracy." *Topliff*, 145 U.S. at 171.

REASONS FOR GRANTING THE WRIT

Petitioner respectfully submits that the decision of the Federal Circuit presents the type of case where the Supreme Court has granted *certiorari* in the past. Specifically, it involves an issue of statutory construction; it involves the judicial negation of an act of Congress; it involves an issue of first impression as admitted by the Federal Circuit; it involves an issue where there is a clear dispute between the agency assigned to apply the patent laws (the USPTO) and the one circuit court that hears patent cases (the Federal Circuit); and, perhaps most importantly, the decision will be used to attack and invalidate most, if not all, of the many thousands of commercially significant, existing broadening reissue patents (App. E).

The Federal Circuit admittedly created new law by holding that claim amendment or cancellation is not necessary for the recapture rule to apply. To that end, the court held that "[a]mendment of a claim is not the only permissible predicate for establishing a surrender" and that, "in a proper case, a surrender can occur through arguments alone." *Hester Indus., Inc.*, 142 F.3d at 1481, 1482.

I. THE OPINION BELOW CONFLICTS WITH THE LEGISLATIVE INTENT OF SECTION 251 CONCERNING THE RECAPTURE RULE

Until the Federal Circuit decision in *Hester*, the law relating to the reissue provisions of the 1952 Patent Act uniformly held that the recapture rule arises only when a claim amendment or cancellation was made. *See, e.g., Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (Fed.

Cir. 1993) ("It is precisely because the patentee *amended his claims* to overcome the prior art that a member of the public is entitled to occupy the space abandoned by the patent applicant." (emphasis added)); *Ball Corp.*, 729 F.2d at 1436 ("The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those *claims that were canceled* from the original application" (last emphasis added)).[8]

Perhaps the most clear indicia of this appears in the "Commentary on the New Patent Act" written by P.J. Federico, who was the primary author of the 1952 Patent Act. With respect to the "error" provision of Section 251 of the 1952 Patent Act, Mr. Federico stated in his famous speeches and written commentary: "There is no indication in the printed [congressional] record that this change in language was intended to effect any change in substance and ... the old phrase was usually rather liberally construed, except when the reissue sought to recapture claims cancelled during the prosecution of the original patent ...." 35 U.S.C.A. at 43 (1954).

Thus, the legislative intent supports Hester's position in this petition that there is no recapture bar so long as there has been no claim amendment or cancellation.

---

[8] The Federal Circuit's *Hester* opinion employs judicial "sleight of hand" by relying upon *In re Clement*, 131 F.3d 1464, 1469 (Fed Cir. 1997), because the court changes the word "and" in that opinion to read "or." *See Hester Indus., Inc.*, 142 F.3d at 1480-81. *Clement* involved both claim amendments and attorney statements. As a result, *Clement* does not support the decision of the Federal Circuit that mere attorney argument alone supports the application of the recapture rule.

Moreover, as discussed above, the Federal Circuit's citation to the Supreme Court's decision in *Warner-Jenkinson* for the proposition that "the recapture rule is quite similar to prosecution history estoppel," *Hester Indus., Inc.*, 142 F.3d at 1481, is misplaced. To the contrary, the Supreme Court in *Warner-Jenkinson* stated that prosecution history estoppel has applied "only where claims have been amended." *Warner-Jenkinson Co.*, 520 U.S. at 26.

Thus, this Court never gave any indication in *Warner-Jenkinson* that the equities relating to the judicial doctrine of prosecution history estoppel (which is applied in the context of determining infringement under the doctrine of equivalents) have any application to the distinctly different equities underlying the congressionally mandated reissue statutes. In short, *Warner-Jenkinson* does not address the equitable issue of whether a patent owner can obtain a broadened reissue where there was no claim amendment or cancellation.

Despite the long coexistence of broadening reissues and the doctrine of prosecution history estoppel, including a major legislative revision in 1952, no one heretofore has held that mere attorney argument alone bars broadening reissue. Certainly, *Warner-Jenkinson* does not support that result because that decision limits prosecution history estoppel to situations where claims have been amended.

Significantly, several judges (including Judge Plager) of the Federal Circuit recently admitted that they are unsure whether the *Warner-Jenkinson* decision of this Court changed the prior holdings of the Federal Circuit with respect to prosecution history estoppel. *See Litton*

Sys. Inc., 47 U.S.P.Q.2d at 1107 (Plager, J., dissenting) ("It is not clear to me exactly what the Supreme Court had in mind ...."). Because Judge Plager wrote the decision in *Hester* below, his admission is most illuminating.[9]

Moreover, in *Litton*, at least two other Federal Circuit judges asked this Court for guidance with respect to *Warner-Jenkinson*. *See id.* at 1107 (Clevenger, J., dissenting) ("Someone, in this case or in another case soon, should explain to the Supreme Court" that this panel did not follow the language of the decision in *Warner-Jenkinson.)*; *id.* at 1112 (Gajarsa, J., dissenting) ("I believe the Litton panel misreads the clear instructions of *Warner-Jenkinson.*").

Hester respectfully submits that this clear request for clarification as to the meaning of this Court's decision in *Warner-Jenkinson* by at least three judges of the Federal Circuit further supports the grant of the writ in this case.

Because Hester's original patent claim 1 was not cancelled or amended during the original prosecution to insert limitations that were not already in claim 1 when filed, the Federal Circuit improperly revised Sections 251 and 252 by expanding the "recapture rule" beyond the intent of Congress and prior law concerning the 1952 Act.

---

[9] The decision of the Federal Circuit in *Hester* was rendered by only two judges of that court. The third judge (Judge Newman) voluntarily recused herself after fully participating in the oral argument. Although no reason was stated for the recusal, Judge Newman's tenure as patent counsel for FMC prior to appointment to the Federal Circuit provides a likely basis. As noted in the "Parties To The Proceedings" section of this brief, *supra*, FMC is the parent company of Stein.

The Federal Circuit's opinion also establishes a clear conflict between the policy of the agency that has been assigned the duty to regulate the reissue patents (the USPTO) and the circuit court that oversees all patent appeals (the Federal Circuit). Specifically, the Federal Circuit's decision contravenes the long-standing USPTO practice with respect to the recapture rule.

In this regard, Section 1412.02 of the *Manual of Patent Examining Procedure* (6th ed. rev. 3 1997) (App. G) provides that: "A reissue will not normally be granted to 'recapture' claimed subject matter deliberately canceled in an application to obtain a patent." Likewise, the Manual states in that same section (relying upon the *Ball Corp.* decision) that "'[t]he recapture rule bars the patentee from acquiring, through reissue claims that are of the *same or broader scope* than those claims that were canceled from the original application.'" *Id.*

This conflict between the agency to whom Congress delegated the responsibility of applying the 1952 Patent Act and the Federal Circuit (which reviews all patent cases) also warrants the grant of the writ.

Finally, based upon its determination that Hester had made an appropriate showing of "error" under Section 251, the USPTO issued the two reissue patents to Hester. By statute, Hester is entitled to a presumption of validity – *i.e.*, a presumption that the determination of "error" by the USPTO was correct. *See* 35 U.S.C.A. § 282 (1998). Further, when a reissue is involved, the burden of proof to invalidate that patent is "made heavier." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1139 (Fed. Cir. 1985) (quoting *Fromson v. Advance Offset Plate, Inc.*, 755

F.2d 1549, 1555 (Fed. Cir. 1985)). This legislative presumption of validity was dismantled, without addressing the issue, by the Federal Circuit's revision of reissue law.

II. THE OPINION BELOW CONFLICTS WITH THE EXPRESS STATUTORY LANGUAGE OF SECTION 252 MANDATING FAIRNESS TO BOTH THE PATENT OWNER AND THE PUBLIC AS DEFINED BY THE INTERVENING RIGHTS DOCTRINE

The legal analysis of the Federal Circuit with respect to the rights of third parties also is devoid of any consideration of the factors legislatively mandated by the last paragraph of Section 252. As a result, the Federal Circuit did not make any factual or legal holdings with respect to either the absolute equitable protection or the permissive equitable protection that was established by Congress in the 1952 Patent Act.

Instead, the Federal Circuit effectively held that the rights of third parties are to be determined solely under the doctrine of prosecution history estoppel, rather than Sections 251 and 252. However, those statutes do not identify, let alone mandate, the use of prosecution history estoppel as the basis for deciding the rights of third parties.

By the 1952 Patent Act, Congress enacted the special provisions that govern reissue practice. Congress struck a balance authorizing patent owners to obtain broadening reissues, so long as the reissue application is filed within two years of the grant of the original patent. However, Congress constrained the patent owners' right

under the recapture and intervening rights doctrines, which (a) bar the expansion of reissue rights to include claims that had been amended or cancelled and (b) potentially limited enforcement of those patent rights if a third party takes certain actions prior to the grant of the reissue. *See* 35 U.S.C.A. §§ 251, 252 (1984); Federico, 35 U.S.C.A. at 43-47 (1954). Again, Congress did not discuss, let alone authorize, the application of prosecution history estoppel (especially as applied by the Federal Circuit with respect to attorney argument alone).

Recognizing this deficiency, the Federal Circuit's opinion is cloaked with "fundamental principles of equity and fairness" and the admonition that "fairness to the public must also be considered." *Hester Indus., Inc.*, 142 F.3d at 1481 (citation omitted). While this general proposition is laudable, courts cannot ignore the express language of the reissue statutes in order to achieve that objective.

Here, the court failed to address the fact that the public is specifically placed on notice by Section 251 that a two-year window exists after the issuance of a patent, in which the patentee is lawfully permitted to go back to the USPTO to obtain broader reissue claims, so long as there is no violation of the recapture rule relating to claim amendment or cancellation. *See* 35 U.S.C.A. § 251 ¶ 4. From this standpoint alone, the general philosophy behind broadening reissues and prosecution history estoppel are incompatible.

The Federal Circuit simply failed to recognize that the divergent philosophies underlying the doctrines of "intervening rights" and prosecution history estoppel (as applied by the Federal Circuit) are at odds with each other

because they focus upon different factors and goals. In this regard, there is no legislative or legal basis for concluding that the intervening rights doctrine of the 1952 Patent Act is interchangeable with prosecution history estoppel as applied to attorney argument alone. Indeed, the legislative intent, prior case law and USPTO practice (as described *supra*) clearly show that the recapture doctrine is strictly limited to situations involving claim amendment or cancellation.

Even though Hester argued that the explicit statutory language of Section 251 authorizes a two-year window for filing broadening reissues, this point was not mentioned by the Federal Circuit when it discussed "equity and fairness." Thus, the Federal Circuit ignored this statutory notice to the public (including Stein) so as to judicially negate the last paragraph of Section 251.

The court also ignored the intervening rights test of Section 252. Indeed, the "equity" applied in the Federal Circuit's decision is contrary to and judicially negates the statutory doctrine of intervening rights. Consequently, the Federal Circuit did not address the intervening rights factors of "substantial preparation" or "protection of investments made or business commenced," as defined in Section 252. If the Federal Circuit had addressed intervening rights in the manner prescribed by the statute, then it would not have invalidated the reissue patents. Instead, it would have made an equitable and factual inquiry as to what, if any, protection Stein should receive under the intervening rights provision. Hester submits that, if such an inquiry had been made, Stein would receive no practical

protection under the facts of this case.[10]

In short, the Federal Circuit engaged in improper judicial legislating (1) by ignoring the statutorily mandated "intervening rights" test and (2) by applying a doctrine of "equity and fairness" that is contrary to or inconsistent with the statutory test.

CONCLUSION

In view of the foregoing legal errors by the Federal Circuit, Hester respectfully requests that its petition for writ of certiorari be granted.

Respectfully submitted

ROBERT W. ADAMS
Counsel of Record
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4022

---

[10] Of course, this is a factual issue that has not been addressed by either the district court or the Federal Circuit.

APPENDIX

APPENDIX A

United States Court of Appeals for the Federal Circuit

97-1352, 97-1353

HESTER INDUSTRIES, INC.,

Plaintiff-Appellant,

v.

STEIN, INC.,

Defendant-Cross Appellant.

DECIDED: May 7, 1998

Robert W. Adams, Nixon & Vanderhye, P.C., of Arlington, Virginia, argued for plaintiff-appellant. With him on the brief were *Robert A. Vanderhye*, *James T. Hosmer*, *Robert W. Faris*, and *William J. Griffin*.

Charles H. De La Garza, Arnold, White & Durkee, of Minneapolis, Minnesota, argued for defendant-cross appellant. With him on the brief were *L. Gene Spears*, Attorney of Record, and *James C. Pistorino*, of Houston, Texas.

Appealed from: United States District Court for the Eastern District of Virginia, Judge EllisBefore

PLAGER and SCHALL, *Circuit Judges*.[1]

PLAGER, *Circuit Judge*.

Hester Industries, Inc. ("Hester") appeals from a summary judgment of invalidity entered by the United States District Court for the Eastern District of Virginia. The district court ruled that the reissue patent claims asserted by Hester against Stein, Inc. ("Stein") are invalid for failing to meet the statutory "error" and "original patent" requirements for reissue patents set forth in 35 U.S.C. § 251 ¶ 1 (1994). *Hester Indus., Inc. v. Stein, Inc.*, 963 F. Supp. 1403 (E.D. Va. 1997). Stein cross-appeals a pretrial oral ruling in which the district court adopted Hester's proposed construction of the claim term "high humidity steam."

Because the asserted reissue claims impermissibly recapture subject matter surrendered by Hester through deliberate arguments repeatedly made to the Patent Office to overcome prior art, we hold that Hester is barred from asserting "error" within the meaning of 35 U.S.C. § 251 ¶ 1. We accordingly affirm the summary judgment of invalidity. Because the asserted claims are invalid, we need not and do not reach the claim construction issue.

BACKGROUND

At issue in this case are two reissue patents, U.S. Patent No. Re. 33,510 (the " '510 reissue patent") and U.S. Patent No. Re. 35,259 (the " '259 reissue patent"). The two patents are reissues of the same original patent, U.S. Patent No. 4,582,047 (the " '047 patent" or "original patent"), which they

---

1. A member of the panel that heard argument in this case was unable to continue with consideration of the case because of recusal. Pursuant to Rule 47.11 of this court, the matter was decided by the remaining members of the panel.

replaced pursuant to 35 U.S.C. § 251.[2] The patents are directed to a high humidity steam cooker having a continuously running conveyor for cooking food items such as poultry and other meat products. Hester, a processor of pre-cooked poultry and other meat products, owns the patents, and Charles E. Williams ("Williams"), a Hester employee, is the sole named inventor. After the '259 reissue patent (the second reissue) issued in 1996, Hester sued Stein, a manufacturer of industrial appliances, for allegedly infringing several reissue claims in the two reissue patents.

The two reissue patents and the original patent have the same written description; the patents differ only with respect to their claims. That written description describes an industrial-size steam cooker for cooking large quantities of food products. The cooker is described as having a cooker chamber in which a steam atmosphere is maintained. The food products are carried through the cooker chamber on a conveyor belt that runs through a spiral path. The written description teaches that efficient cooking is achieved without the loss of humidity, flavor, or appearance by maintaining a water-drop-free steam atmosphere within the chamber at near 100°C and 100% humidity, at above atmospheric pressure.

Two separate sources of steam, one internal and one external, are described for maintaining the steam atmosphere. The internal source of steam described is a pool of water on the floor of the cooker chamber, heated by a heating element in the pool. The external source described is a steam

---

2. The district court noted that the issuance of two reissue patents for the same original patent was a "curiosity" that appeared to be unprecedented. *Hester*, 963 F. Supp. at 1405 n.2. However, the propriety of two reissues for the same patent was not addressed below and has not been raised on appeal. Accordingly, we express no opinion on the matter.

generator, located outside the cooker chamber and connected by pipes to various locations within the cooker chamber to inject steam at those locations. The written description states that the external steam source typically provides 25% of the steam, with the remainder provided by the internal source. '047 patent, col. 3, ll. 42-45, 57-59. The heating element in the internal steam source is controlled to maintain the desired amount of steam and pressure within the cooker chamber. *Id.* col. 3, ll. 59-63.

The section of the written description entitled DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT describes the cooking atmosphere thus:

> The cooking is solely with water droplet free steam near 100° C. and 100% humidity at a pressure above atmospheric. The high humidity atmosphere prevents losses of humidity of the product as it passes through the cooker and helps retain juices, essences and flavor of the product. Also it improves the heating steam interface heat exchange at the product surface for more efficient cooking.
>
> The higher pressure not only produces a pressure-cooker like cooking efficiency to the cooking process, but is critical in connection with the flavor and conveyor type product flow as well.

Id. col. 3, ll. 22-33.

The original patent contains one independent claim, claim 1, directed to a food cooking system. The claim specifies that the cooking system cooks solely with steam and that the system includes two sources of steam to provide the steam atmosphere. Characteristics of the steam atmosphere are set forth, and the cooking system is said to include a means

passing a conveyor belt through the cooker housing. Claim 1, with relevant text emphasized, reads:

> A food cooking system *cooking solely with steam* foods such as fish, fowl, meats or produce carried through a cooker on a continuously running conveyor belt, comprising in combination, a cooker housing, *means passing said conveyor belt through said housing* to expose food products within the cooker housing only to *said steam as the sole cooking medium*, and *two sources of steam providing said steam* to cook the food products, nozzles for releasing steam located inside said housing, one comprising a steam generator supplying supplemental steam into said housing at said nozzles located there inside *to maintain the atmosphere together with the other steam source at near 100% humidity 100° C. and a pressure above atmospheric*, and the other source of steam comprising a pool of water within said housing with heating means for boiling the water to create steam.

Id. col. 5, l. 59 to col. 6, l. 8. For purposes here, this is substantially the same form in which the claim was first filed (as application claim 1) in the application for the original patent. Accordingly, we do not distinguish between the issued claim and the application claim, but instead simply refer to claim 1.

In addition to the independent claim, the original patent contains several claims which are dependent upon claim 1. Relevant here is dependent claim 12, which specifies in pertinent part: "A system as defined in claim 1 *wherein the conveyor belt is passed* inside said housing *in a spiral path* coiling downwardly . . . ." *Id.* col. 6, ll. 59-61 (emphasis added). This claim stemmed from original application claim

16, which specified that the conveyor belt is "passed . . . in a spiral path."

The application for the '047 patent (the original patent) was filed in 1979. The patent did not issue until 1986, nearly seven years later. Over the almost seven years in which the application was prosecuted before the United States Patent and Trademark Office ("Patent Office"), inventor Williams, through his attorney, repeatedly emphasized the "solely with steam" and "two sources of steam" features of the claimed invention in attempting to establish patentability over the prior art. For example, after the Examiner first rejected claim 1 as well as all the other claims as obvious, Office Action of Feb. 6, 1980, at 2, Williams distinguished a cited prior art cooker that cooked with a combination of infra-red dry heat and steam on the ground that the claimed invention cooked solely with steam, stating: "This principle is completely different from applicant's invention where the claims define cooking *solely* with steam." Applicant Response of Apr. 28, 1980 (emphasis in original). Williams also distinguished claim 1 on the basis of the "two sources of steam" limitation, the specified characteristics of the steam atmosphere, and the recited continuously running conveyor belt. *Id.*

Application claim 16, which specified a spiral conveyance path, was rejected as obvious in view of an additional prior art cooker that included a spiral conveyor. Office Action of Feb. 6, 1980, at 4. In response, Williams amended claim 16 to specify further details of the spiral conveyance path and then argued that the claimed spiral conveyance path was distinguished from that shown in the prior art. Applicant Response of Apr. 28, 1980.

However, the Examiner continued to reject all claims as obvious. Office Action of July 9, 1980. At that point, Williams placed even greater reliance on the "solely with

steam" and "two sources of steam" limitations in an attempt to overcome the obviousness rejection. For example, in his first appeal of the obviousness rejection to the Board of Patent Appeals and Interferences ("Board"), Williams stated, "The claimed system cooks *solely* with steam . . . by means of two separate and critical steam sources . . . ." Applicant Brief on Appeal, at 2 (Aug. 20, 1980) (emphasis in original). Later in the same brief, Williams specifically distinguished the cited prior art on the basis of these limitations:

> The primary reference Vischer cooks with IR radiation not steam. Clearly the claimed feature of cooking *solely* with steam is directly contrary to the teaching of the Vischer patent, which could therefore never make obvious any process or equipment cooking *solely* with steam as claimed.
>
> . . . .
>
> The Examiner errs in any implication that Jourdan shows two sources of steam.

Id. at 9-10 (emphasis in original).

Prior to the Board hearing Williams' appeal, the Examiner reopened prosecution on the merits in view of newly discovered prior art, thereby removing the appeal from the Board.[3] Office Action of Mar. 17, 1981. The Examiner then rejected all of the claims as obvious over the new prior art. *Id.* In response, Williams distinguished claim 1 over that prior art on the same bases, *i.e.*, the "solely with steam" and "two sources of steam" limitations. Applicant Response to Office Action (Apr. 17, 1981). However, the Examiner was

---

[3]. Accordingly, the Board never heard Willams' first appeal.

not persuaded, even after these same arguments were repeated in subsequent papers submitted to the Patent Office.

Accordingly, Williams initiated a second appeal to the Board. He again emphasized the "solely with steam" and "two sources of steam" limitations. Applicant Brief on Appeal, at 13 (Dec. 22, 1981). He explained that the two sources of steam interact to provide a "synergy" that is "novel and nowhere suggested in any of the cited [prior] art." *Id.* Williams drove home his reliance on the "solely with steam" limitation most forcefully in his reply brief to the Board: "Clearly the Examiner reversibly errs as a matter of fact and in his efforts to make a case out against the *very material claimed feature that steam is the sole cooking medium (claim 1)*. Thus reversal is respectfully solicited." Applicant Reply Brief on Appeal, at 6 (Sep. 30, 1982) (emphasis in original).

The Board was persuaded and accordingly reversed the obviousness rejection in its opinion dated June 21, 1985, stating:

> [W]e find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.

Thereafter the claims were allowed and the application issued as the '047 patent on April 15, 1986.

On the two-year anniversary of the '047 patent's issuance, Williams applied for a reissue pursuant to 35 U.S.C. § 251, alleging that the patent claims had been drawn

too narrowly due to attorney error. In the required oath accompanying the reissue application, Williams explained that he became aware of this alleged error after learning that Stein was in the process of developing a competing cooker in early 1988. According to his oath, Williams and his employer Hester concluded that the '047 patent should cover the Stein cooker, notwithstanding the fact that the cooker used a non-steam heat source and only one source of steam in the cooking process. Williams further explained that Hester's present counsel advised Hester that the '047 patent claims, as written, might not cover Stein's cooker. Thus, Williams, by oath, declared that the patent was insufficient because it claimed less than he had a right to claim.

Specifically, Williams identified two relevant deficiencies of the '047 patent, as follows (indentation and numbering added):[4]

> [1] that each of claims 1-14 therein requires cooking "solely with steam" and exposing food products within the cooker housing "only to said steam as the sole cooking medium" . . . . [and]
>
> [2] that each of claims 1-14 therein requires "two sources of steam providing said steam to cook the

---

4. The reissue oath specifies two further insufficiencies, namely, that the '047 patent requires:

> [3] "a steam generator supplying supplemental steam into said housing at said nozzles located there inside to maintain the atmosphere together with the other steam source at near 100% humidity 100° C, and a pressure above atmospheric" and
>
> [4] "a pool of water within the housing with heating means for boiling the water to create steam."

(Indentation and numbering added.)

food products, nozzles for releasing steam located inside said housing"[.]

These deficiencies, according to Williams, "arose after [he] executed and filed the original application from which the '047 patent issued" and were caused by "the failure of [his prior] patent attorney . . . to appreciate the full scope of [his] invention."

This application ripened into the '510 reissue patent nearly three years later on January 1, 1991. However, prior to its issuance, Williams filed a second reissue application, for reasons not relevant here, on June 21, 1990, alleging the same errors used to support the first reissue. Six years later, this second reissue application issued as the '259 reissue patent. Hester then filed this action, accusing Stein of infringing two claims in the first reissue patent and six claims in the second. Specifically, Hester accused Stein of infringing reissue claims 26 and 59 of the '510 reissue patent and reissue claims 28, 30, 31, 32, 75, and 76 of the '259 reissue patent.

The requirement in original claim 1 that cooking is "solely with steam" is absent from each of the asserted reissue claims. Also absent is the "two sources of steam" limitation. Rather, the asserted reissue claims merely recite a source of steam or at least one source of steam. None of the asserted reissue claims explicitly recite the steam atmosphere characteristics specified in original claim 1, *i.e.*, the characteristics of near 100°C and 100% humidity at above atmospheric pressure. Instead, all but one of the asserted reissue claims recite "high humidity steam."[5]

---

5. Claim 30 of the '259 reissue patent does not contain the "high humidity steam" language.

Claim 26 of the '510 reissue patent is representative of the two asserted reissue claims in that patent. It provides in pertinent part:

> A food cooking system for cooking food products carried on a moving conveyor belt, comprising:
>
> a cooker housing[,]
>
> *means disposed within said housing for defining a conveyance path*,
>
> a conveyor belt disposed along said conveyance path for supporting and conveying said food products along said path,
>
> means coupled to said belt for causing said belt and said food products supported thereby to substantially continually translate along said conveyance path . . . , and
>
> *a source of steam providing steam to contact and cook the food products, said steam source comprising at least one of the following*:
>
> > an external steam generator supplying steam into said housing, and
> >
> > a pool of water within said housing with heating means communicating with said pool of water for creating steam. . . . [,]
>
> *wherein said steam source provides high humidity steam* and said food products are directly exposed to said high humidity steam.

'510 patent, col. 8, ll. 8-31, 36-38 (emphasis added, and text of claim 24, upon which claim 26 depends, incorporated).

The asserted reissue claims of the '259 reissue patent are, for purposes here, substantially similar. One difference is that several of these claims explicitly recite a "spiral conveyance path." Claim 28, which is representative, provides in pertinent part:

> A spiral steam cooker for at least partially cooking exposed food products, said cooker comprising:
>
> a housing defining an internal volume therein;
>
> a conveyor belt at least partially *disposed along a spiral conveyance path* within said internal volume . . . ; and
>
> *a steam source* operatively coupled to said housing, said steam source *providing a high humidity steam atmosphere* within said internal volume, said high humidity steam atmosphere directly contacting and at least partially cooking the exposed food products . . . .

'259 patent, col. 9, l. 61 to col. 10, l. 12 (emphasis added).

Before the district court, Stein moved for summary judgment that the asserted reissue claims are invalid for failing to meet the requirements of the reissue statute, 35 U.S.C. § 251. That section (with emphasis added) reads:

> Whenever any patent is, through *error* without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent *for the invention disclosed in the original patent*, and in accordance

> with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In particular, Stein argued that the "error" requirement of § 251 ¶ 1, as well as the requirement therein that the reissue claims be "for the invention disclosed in the original patent" (the "original patent" requirement), were not met. With regard to the "error" requirement, Stein argued that Williams had not erred in including the "solely with steam" and "two sources of steam" limitations in the original claims, and further argued that the removal of those limitations violated the "recapture" rule. Stein further argued that the asserted reissue claims violated the "original patent" requirement because, Stein asserted, the original patent does not evidence an "objective" intent to claim the invention in the manner of the asserted reissue claims.

The district court granted Stein's motion. The court first concluded that there was no "error" as contemplated by § 251 ¶ 1. Specifically, the court concluded that the alleged failure of counsel to appreciate the scope of the invention was belied by the clear language in the original patent claims, the prosecution history of the patent, and the absence of any explanation as to the nature or cause of the attorney's failure to appreciate the full scope of the invention. *Hester*, 963 F. Supp. at 1408. The court did not reach Stein's assertion that the asserted reissue claims violate the recapture rule, though the court relied heavily on the original patent's prosecution history in determining that the "error" requirement was not met. *See id.* at 1409-11.

The district court ruled that the asserted reissue claims are alternatively invalid for failing to meet the "original patent" requirement. *Id.* at 1412. The district court

concluded that the "original patent" clause of § 251 ¶ 1 includes a separate requirement that the original patent manifest an "objective" intent to claim the invention as later claimed on reissue. *Id.* at 1412-13 The court concluded that the original patent does not manifest such an objective intent, and thus the claims are also invalid under the "original patent" clause of § 251 ¶ 1. *Id.* at 1412-15.

In its appeal of the invalidity judgment, Hester argues that the district court erred in concluding that the "error" and "original patent" requirements of § 251 ¶ 1 were not met. Stein, in seeking to uphold the judgment, makes the same arguments presented to the district court in its motion for summary judgment. Hester, on the other hand, argues that the "error" requirement was met by way of prior patent counsel's failure to appreciate the full scope of the invention. Hester further asserts that the recapture rule is inapplicable because the reissue claims were never presented during prosecution of the original patent and later abandoned by amendment or cancellation. With regard to the "original patent" clause of § 251 ¶ 1, Hester submits that there is no separate requirement of a manifestation of an objective intent to claim.

Also at issue on appeal is the district court's resolution of a "Motion For Claim Interpretation" brought by Stein. In that motion, Stein argued that the claim term "high humidity steam" should be construed in accordance with the only specific description of the steam atmosphere provided in the patents, *i.e.*, as water-droplet-free steam near 100°C and 100% humidity at above atmospheric pressure. Hester, relying on the opinion of its expert, proposed a broader construction, arguing that the description contained in the patents is merely one example of "high humidity steam." The district court, in a ruling delivered from the bench prior to

holding the asserted reissue claims invalid, adopted Hester's proposed construction of the claim term. The ruling was never reduced to a formal order or judgment. The parties, by way of cross-appeal by Stein, present the same issue on appeal.

DISCUSSION

I

In reviewing the summary judgment of invalidity, we keep in mind that summary judgment is appropriate only when the record shows that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). Whether the statutory requirements of 35 U.S.C. § 251 have been met is a question of law. *See In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997). This legal conclusion can involve underlying factual questions. *See id.*

II

As previously explained, the "error" and "original patent" requirements at issue here are found in the first paragraph of § 251. The "error" requirement limits the availability of a reissue patent to certain correctable errors. *See In re Amos*, 953 F.2d 613, 616, 21 USPQ2d 1271, 1273 (Fed. Cir. 1991). As seen in the above-emphasized text of § 251, one such correctable error is the patentee claiming his invention too broadly or too narrowly.[6] *See id.*

The "original patent" requirement is a second and independent requirement, *see Amos*, 953 F.2d at 615, 21 USPQ2d at 1272, which restricts a reissue patent to "the

---

6. The last paragraph of § 251 requires that a request to enlarge the scope of claims be "applied for within two years from the grant of the original patent." 35 U.S.C. § 251 ¶ 4 (1994).

invention disclosed in the original patent." 35 U.S.C. § 251 ¶ 1. We address each of these requirements in turn.

A

1

In considering the "error" requirement, we keep in mind that the reissue statute is "based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). We also keep in mind that "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Id.* Indeed, the reissue procedure does not give the patentee the right "to prosecute *de novo* his original application." *Id.* at 1582, 790 F.2d 1576, 229 USPQ at 677; *see also Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. *See Amos*, 953 F.2d at 616, 21 USPQ2d at 1273; *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. *See Clement*, 131 F.3d at 1468, 45 USPQ2d at 1163; *Wilder*, 736 F.2d at 1519, 222 USPQ at 371. Williams asserted this form of error as the basis for his reissue applications, and the Patent Office accepted his assertion as adequate.

However, the district court concluded that there was no such error by Williams' attorney. *Hester*, 963 F. Supp. at 1411. In reaching this conclusion, the court was particularly persuaded by the prosecution history of the original patent. The court concluded that the attorney's repeated attempts to

distinguish Williams' invention on the basis of the "solely with steam" and "two sources of steam" limitations belied Williams' assertion that his attorney failed to appreciate the full scope of his invention. *Id.* at 1409-11. The court also determined that there was no other form of § 251 "error" and thus held the asserted reissue claims invalid. *Id.* at 1411-12.

2

We share the district court's discomfort with Williams' attempt to remove, through reissue, the "solely with steam" and "two sources of steam" limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art. This concern is addressed most squarely by the "recapture rule," recently discussed at length in *Clement*, 131 F.3d 1464, 45 USPQ2d 1161. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. *See Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1525.

In its motion for summary judgment, Stein presented the recapture rule as one basis for finding the asserted reissue claims invalid, and Stein repeats this argument on appeal as one basis for affirming the summary judgment of invalidity. While the district court did not explicitly rule on this ground, its opinion indicates the view that Hester, through the reissue patents, recaptured surrendered subject matter. *Hester*, 963 F.Supp. at 1412 (stating that through the reissues, Hester obtained claims covering "ovens with characteristics repeatedly distinguished and disclaimed in the PTO" and that that was contrary to the "error" requirement of § 251). As will be next explained, we conclude that the asserted reissue

claims violate the recapture rule and that the summary judgment ruling is appropriately affirmed on this ground.

"Under [the recapture] rule, claims that are 'broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164 (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. *See id.* A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. *See id.* Here, it is undisputed that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the "solely with steam" and "two sources of steam" limitations found in each of the original patent claims.

Having determined that the reissue claims are broader in these respects, under the recapture rule we next examine whether these broader aspects relate to surrendered subject matter. *See id.* at 1468-69, 131 F.3d 1464, 45 USPQ2d at 1164. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection." *Id.* at 1469, 131 F.3d 1464, 45 USPQ2d at 1164 (emphasis added). This statement in *Clement* indicates that a surrender can occur by way of arguments *or* claim changes made during the prosecution of the original patent application. To date, the cases in which this court has found an impermissible recapture have involved claim amendments or cancellations. *See, e.g., id.* at 1469-70, 131 F.3d 1464, 45 USPQ2d at 1164-65; *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25. However, in addition to the suggestion in *Clement* that argument alone can effect a

surrender, this court expressly left open that possibility in *Ball Corp. v. United States*: "If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding." 729 F.2d 1429, 1436 n.19, 221 USPQ 289, 295 n.19 (Fed. Cir. 1984). Prior to this case, this court has not squarely addressed the question.

This court's prior opinions indicate that, as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. *See Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164 (noting that, with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable); *Mentor*, 998 F.2d at 995, 27 USPQ2d at 1524 (same); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984) (declining to apply the recapture rule when there was no evidence that the "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable"). In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. *See Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25 (finding surrender by way of claim amendments); *Ball*, 729 F.2d at 1436, 221 USPQ at 294 (noting that a court may draw inferences from changes in claim scope).

Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Indeed, in *Mentor* and *Clement* the findings of a surrender were based in part on the arguments made in

conjunction with the claim amendments. *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Clement*, 131 F.3d at 1470-71, 45 USPQ2d at 1165-66. Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.

The view that arguments alone can give rise to a surrender is consistent with the policy behind the reissue statute and the accompanying recapture rule. As already noted, the reissue statute is "based on fundamental principles of equity and fairness." *Weiler*, 790 F.2d at 1579, 229 USPQ at 675. There is no unfairness in binding the patentee to deliberate assertions made in order to obtain allowance of the original patent claims over the prior art. Indeed, fairness to the public must also be considered. In this regard, as stated in *Mentor*, "the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USQP2d at 1525. The recapture rule operates to prevent this from happening. *See id.* Furthermore, as recognized in *Ball*, the recapture rule is based on principles of equity and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296.

Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S.Ct. 1040, 1051, 137 L.Ed.2d 146 (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. *See id.*

Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another--reissue allows an expansion of patent rights whereas prosecution history estoppel is limiting. However, Hester's argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art. *See, e.g., Texas Instruments, Inc. v. International Trade Comm'n*, 988 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993). The same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that arguments alone can give rise to a surrender for purposes of the recapture rule.

Thus we conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the "solely with steam" and "two sources of steam" limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

As detailed above, Williams repeatedly argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less

than 27 places in six papers submitted to the Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was "critical" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "very material" in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

Having concluded that there has been a surrender, we must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. *See Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164. When the surrender occurs by way of claim amendment or cancellation, "[c]omparing the reissue claim with the canceled claim is one way to do this." *See id.* This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.

Clearly they were. None of the asserted reissue claims include either the "solely with steam" limitation or the "two sources of steam" limitation. Thus, this surrendered subject matter—*i.e.*, cooking other than solely with steam and with at least two sources of steam—has crept into the reissue claims.

The asserted reissue claims are unmistakably broader in these respects.

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. *See, e.g., Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. For example, in *Ball* the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the "spiral conveyance path" and "high humidity steam" limitations. The term "high humidity steam" is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term "high humidity steam" is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere "at near 100% humidity 100° C and a pressure above atmospheric." '047 patent, col. 6, ll. 3-4. Hester concedes that the term "high humidity steam" is not narrower than this

limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of "high humidity steam." Accordingly, the use of the term "high humidity steam" does not save the reissue claims from the recapture rule.

The term "spiral conveyance path" is also not materially limiting. This term appears explicitly in asserted reissue claims 28, 32, 75, and 76 of the '259 reissue patent; it does not appear explicitly in the other reissue claims asserted. Original claim 1 includes a corresponding limitation, namely, "means passing said conveyor belt through said housing . . . ." This is a so-called means-plus-function clause drafted pursuant to 35 U.S.C. § 112 ¶ 6 (1994).[7] According to § 112 ¶ 6, the clause is to be construed to "cover the corresponding structure . . . described in the specification and equivalents thereof." The only corresponding structure described in the specification (more properly, the written description of the patent) passes the conveyor belt through a spiral path. *See* '047 patent, col. 4, l. 64 to col. 5, l. 8. Thus, the explicit recitation of a "spiral conveyance path" in some of the asserted reissue claims does not materially narrow those claims. Indeed, Hester does not explain how the explicit recitation of a spiral conveyance path—which is present in prior art cookers cited by the examiner during the prosecution of the original patent—materially narrows these claims. In sum, neither alone nor together do the terms "high

---

[7] Use of the word "means" in a claim clause triggers a presumption that § 112 ¶ 6 applies. *See York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1623-24 (Fed. Cir. 1996). The presumption can be overcome if the clause recites sufficient structure. *See id.* The clause at issue here recites no structure for performing the function of passing the conveyor belt through the housing. Accordingly, § 112 ¶ 6 unquestionably applies.

humidity steam" and "spiral conveyance path" materially narrow the claims.

Furthermore, the "spiral conveyance path" and "high humidity steam" limitations are not aspects of the invention that were overlooked during prosecution of the original patent. To the contrary, as just explained, these aspects were included in original claim 1. Additionally, with regard to the "spiral conveyance path" limitation, original dependent claim 12 explicitly recites "a spiral path." '047 patent, col. 6, l. 60. In prosecuting the original patent, Williams pointed out these features in an attempt to overcome the Examiner's obviousness rejection. Hester cannot now argue that Williams overlooked these aspects during the prosecution of the original patent application. In conclusion, this is not a case which involves the addition of material limitations that overcome the recapture rule.

In effect, Hester, through eight years of reissue proceedings, prosecuted Williams' original patent application anew, this time placing greater emphasis on aspects previously included in the original patent claims and removing limitations repeatedly relied upon to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention. The reissue statute is to be construed liberally, but not that liberally. The realm of corrections contemplated within § 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to 'custom-fit' the reissue claims to a competitor's product.

No doubt if two patent attorneys are given the task of drafting patent claims for the same invention, the two attorneys will in all likelihood arrive at somewhat different claims of somewhat different scope. And such differences are even more likely when, as here, the second attorney drafts the

new claims nearly a decade later and with the distinct advantage of having before him the exact product offered by the now accused infringer. This reality does not justify recapturing surrendered subject matter under the mantra of "failure to appreciate the scope of the invention." The circumstances of the case before us simply do not fit within the concept of "error" as contemplated by the reissue statute. *See Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted.").

With respect to the recapture issue, there are no underlying material facts as to which there is a genuine issue in dispute. The original patent's prosecution history, on which we rely, is before us and undisputed. All that remains is the ultimate legal conclusion as to whether the asserted reissue claims fail to meet the "error" requirement because the claims impermissibly recapture surrendered subject matter. *See id.* at 994, 998 F.2d 992, 27 USPQ2d at 1524 (stating that whether the "error" requirement has been met is a legal conclusion). For the reasons explained above, we conclude as a matter of law that the asserted reissue claims fail in this regard. Summary judgment of invalidity of the asserted reissue claims under § 251 is called for. Accordingly, we affirm the district court's entry of summary judgment.

B

As an alternative basis for holding the asserted reissue claims invalid, the district court concluded that the reissue claims do not meet the "original patent" clause of § 251 ¶ 1, which requires that the reissue patent be "for the invention disclosed in the original patent." *Hester*, 963 F.Supp. at 1412. In reaching this conclusion, the court interpreted the

"original patent" clause as requiring an "objective" intent, manifested in the original patent, to claim the invention as claimed in the reissue patent. *Id.* The court based this interpretation on the Supreme Court's statement in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 676, 62 S.Ct. 839, 843-44, 86 L.Ed. 1105 (1942), that there was an objective intent requirement under the predecessor reissue statute, 35 U.S.C. § 64 (1964), which required that the reissue patent be "for the same invention." *Id.* at 1413.

Based on this construction of the "original patent" clause, the district court framed the issue as, "whether the 047 patent manifests an objective intent to cover ovens that utilize heat sources other than steam, and have less than two steam sources." *Id.* The district court concluded that the asserted reissue claims failed to meet this test and thus were invalid under the "original patent" clause. *Id.* at 1413-15. On appeal, the parties focus on whether the "original patent" clause embodies the requirement of an objective intent to claim.

This court squarely addressed the issue in *Amos*, 953 F.2d at 616, 21 USQP2d at 1273. The *Amos* court held that § 251 does not include a separate requirement of an objective intent to claim. 953 F.2d at 618-19, 21 USPQ2d at 1275-76. Rather, the court concluded: "the essential inquiry under the 'original patent' clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." *Id.* at 618, 953 F.2d 613, 21 USPQ2d at 1275. The court noted that this inquiry is analogous to the "written description" requirement of 35 U.S.C. § 112 ¶ 1 (1994). *Id.* The court further stated that, to the extent the construct of an objective intent to claim is useful, it is "only one factor that sheds light" on whether the "original patent" clause of § 251

is satisfied. *Id.* at 619 & n.2, 21 USPQ2d at 1275-76 & n.2 (quoting *In re Hounsfield*, 699 F.2d 1320, 1323, 216 USPQ 1045, 1047-48 (Fed. Cir. 1983)).

With regard to the Supreme Court's opinion in *U.S. Industrial*, 315 U.S. 668, 62 S.Ct. 839, 86 L.Ed. 1105, the *Amos* court noted that that case was decided under the predecessor reissue statute which required reissue claims to be for the "same invention," and concluded that *U.S. Industrial* does not now mandate a separate "objective intent to claim" requirement. *Id.* The *Amos* court noted that this court reached the same conclusion eight years earlier in *Hounsfield*, 699 F.2d at 1323, 216 USPQ at 1047-48. *Id.*

Thus, the district court's conclusion that the "original patent" clause of § 251 was not satisfied based on an "objective intent to claim" requirement was in error. Stein does not contend that the test set forth in *Amos* for the "original patent" clause—*i.e.*, whether one skilled in the art would identify the subject matter of the reissue claims as invented and disclosed by the patentee—is not met by the asserted reissue claims. Rather, Stein relies entirely on its assertion that there is an "objective intent to claim" requirement and that that requirement is not met. However, we need not resolve this issue further, having already concluded that the asserted reissue claims are invalid for failing to meet the "error" requirement of § 251.

III

Finally, Stein presents to us the question of whether the district court properly construed the claim term "high humidity steam." It is not immediately apparent whether this issue is properly before us. The district court did not construe the term in conjunction with a final judgment, such as a summary judgment of noninfringment or invalidity. Rather, the district court issued an oral ruling on the matter in preparation for trial. However, the district court having held the asserted claims invalid on summary judgment, which we here affirm, there can be no question of liability and hence the claim construction issue is moot. Therefore, we need not decide whether Stein's appeal of the claim construction is proper, and if so, whether the district court's construction was correct.

CONCLUSION

We affirm the grant of summary judgment of invalidity of the asserted reissue claims for failure to comply with 35 U.S.C. § 251 ¶1. Stein's cross-appeal is dismissed.

COSTS

Each party shall bear its own costs.

AFFIRMED

APPENDIX B

United States Court of Appeals
for the Federal Circuit

97-1352, - 1353

HESTER INDUSTRIES, INC.,

Plaintiff-Appellant,

v.

STEIN, INC.,

Defendant/Cross-Appellant.

JUDGMENT

ON APPEAL from the U.S. DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
in CASE NO(S). 96-719

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: AFFIRMED

ENTERED BY ORDER OF
THE COURT

/S/ Jan Horbaly / Kr
Jan Horbaly, Clerk

DATED MAY 7, 1998.

ISSUED AS A MANDATE: MAY 28, 1998

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

Civil Action 96-719-A

HESTER INDUSTRIES, INC.,

Plaintiff,

v.

STEIN, INC.,

Defendant.

ORDER

The matter came before the Court on a renewed motion by defendant for summary judgment on the question whether claims 26 and 59 of United States Patent No. Re. 33,510 and claims 28, 30, 31, 32, 75 and 76 of United States patent No. Re. 32,259 ("the asserted claims") are invalid for failure to comply with the substantive requirements for the reissue of patents found in 35 U.S.C. § 251. The matter has been argued orally and in writing, and is now ripe for disposition.

For the reasons stated from the bench, to be elaborated in a forthcoming Memorandum Opinion, defendant's motion is **GRANTED.** Thus, the asserted claims are invalid and plaintiff's complaint requesting damages for defendant's infringement of the those claims is **DISMISSED WITH PREJUDICE.**

The Clerk is directed to send copies of this Order to all counsel of record.

/s/ T.S. Ellis, III
United States District Judge
T.S. Ellis, III

Alexandria, Virginia
March 25, 1997

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

Civil Action 96-719-A

HESTER INDUSTRIES, INC.,

Plaintiff,

v.

STEIN, INC.,

Defendant.

May 6, 1997

Robert A. Vanderhye, Robert W. Adams, Nixon & Vanderhye, P.C., Arlington, VA, for Plaintiff.

James H. Laughlin, Jr., Bruce O. Jolly, Jr., Lane & Mittendorf, Washington, DC., Charles H. De La Garza, Joseph A. Uradnik, Arnold, White & Durkee, Minneapolis, MN, Stephen D. Dellett, L. Gene Spears, Arnold, White & Durkee, Houston, TX, for Defendant.

Elizabeth C. Simon, Ron Kamp, FMC Corporation, Chicago, IL, of counsel.

MEMORANDUM OPINION

ELLIS, District Judge.

In this patent infringement suite, plaintiff, a processor of pre-cooked poultry and meat products, accuses defendant, a manufacturer of industrial appliances, of infringing several claims in two reissue patents covering high humidity steam cookers. In the motion at bar, defendant moves for summary

judgment on the question whether the asserted claims of the reissue patents in suite are invalid for failure to comply with the substantive requirements for the reissue of patents found in 35 U.S.C. § 251.

I.

Plaintiff Hester Industries, Inc. ("Hester") has accused Stein, Inc. ("Stein") of infringing claims 26 and 59 fo U.S. Patent No. Re. 33,510 ("the 510 Reissue") and claims 28, 30, 31, 32, 75 and 76 of U.S. Patent No. Re. 35,259 ("the 259 Reissue").[1] Generally, these patents cover a cooker that employs a spiral converyor to escort meat products through a housing in which they are cooked using steam. Both patents are ereissue patents, which means that they were issued to replace a then-existing patent pursuant to 35 U.S.C. § 251. Specifically, both the 510 and 259 reissue patents replaced Hester's U.S. Patent No. 4,582,047 ("the 047 patent"), which cliamed, in part, the invention of a cooker that utilizes two steam sources, one external and one internal, and cooks solely with high humidity steam. The application for the 047 patent wa filed I July 1979, and issued in 1986. Two years after the issuance of the 047 patent, Hester applied for a reissue pursuant to 35 U.S.C. § 251, alleging that the cliams of the 047 patent had been drawn too narrowly due to attorney error. This application ripened into the 510 reissue patent.

---

[1] Hester is the assignee of both reissue patents in suit, as well as the original patent covering the invention claimed in these reissues, U.S. Patent No. 4,582,047.

Subsequently, a second reissue application was filed for reasons not relevant here,[2] and curiously led to the second reissue patent for the same invention. In any event, following allowance of the second reissue patent, Hester filed this action, accusing Stein of infringing two claims in the first reissue patent and four claims in the second.

Early in the case, in December 1996, Stein moved for summary judgment on the questionfo patent invalidity. Specificaly, Stein argued that the reissue patents in suit are invalid for failure to comply with the requirements of 35 U.S.C. § 251. This motion was denied by order dated January 3, 1997. At trial, Stein renewed its motion for summary judgment on patent validity.

II.

The principles governing summary judgment are well settled. Summary judgment is appropriate where the record shows that "there is no genuine issue as to any material fact

---

[2] The PTO's issuane of two reissue patents for the same invention is a curiosity. Indeed, counsel for parties represented at oral argument that htey know of no hter example of two valid reissue patents for the same invention; it is unique in the history of hte patent system. Hester contends that the second reissue, although contrary to PTO rules and procedures, was nontheless allowed because Stein "sandbagged" the first reissue by a late submission of relevant prior art to Hester. Stein, who was not a party to these ex parte proceedigns before the PTO, disputes this allegation of "sandbagging". Indeed, Stein, as a non-party, was under no obligation to submit prior art to Hester or the PTO with respect to Hester's reissue application. Thus, the "sandbagging" allegation seems unwarranted. Moreover, counsel for Hester represented that the second reissue application contained no additional limitations designed to secure the second reissue over the prior art. Hester, rather, simply submitted additional claims, some of which were allowed. In any event, the proprietyof two reissue patents fo rthe same invention is immaterial to the resolution of the instant motion.

and that the moving party is entitled to judgment as a matter of law." Rule 56(c), Fed.R.Civ.P.A factual question is material if a reasonable trier of fact could find for the non-moving party, in part, on its determination of that question. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1086). In determining whether there is a genuine issue of material fact, the evidence is viewed in the light most favorable to the non-moving party, with all doubt resolved in favor of that party. *Scripps Clinic & Research Foundation v. Genentech, Inc.* 927 F.2d 1565, 1571 (Fed.Cir.1991). But if the evidence is "merely colorable, or is not significantly probative, summary judgment may be granted." *Anderson,* 477 U.S. at 249-50, 106 S.Ct. At 2511.

In resolving a summary judgment, due consideration must be given to theburden of proof. *Celotex Corp. V. Catrett,* 477 U.S. 317, 325, 106 S.Ct. 2548, 2553-54, 91 L.Ed.2d 265 (1986). At trial, patent invalidity must be proven by Stein by clear and convincing evidence. Thus, in this motion, Stein must prove (I) there is no genuine issue fo material fact; and (ii) that Stein is entitled to judgment asa matter of law because it has proved, by clear and convinving evidence, that the asserted claims of the reissue patents in suite are invalid.

III.

The inquiry into compliance with § 251 appropriately begins with the language of hte statute, which states, in pertinent part, that:

> [w]henever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of hte patentee claiming more or less than he had a right to

> claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in theoriginal patent, and in accordance with a new and amended application, forthe unexpired part of the term of the original patent. No new matter shall be introduced into the patent for reissue.

35 U.S.C. § 251. As construed by the Federal Circuite, this section authorizes a reissue patent in four limited circumstances, namely:

(1) to correct an error in the specification;

(2) to correct a defective drawing;

(3) to narrow the claims of a patent, most often resulting from the belated discovery of partially-invalidating prior art; or

(4) to broaden the claims of a patent, most often resulting from post-issuance discovery of attorney error in understanding the scope of the invention.

In re Amos, 953 F.2d 613, 616 (Fed.Cir.1991). Only the fourth circumstance is presnet here. Hester secured its reissue patents to broaden patent claims.

Section 251 requires a patentee seeking reissue to submit an oath or declaration claiming (I) that the patent is defective, and (ii) that the defect or insufficiency in th patent occurred through error without deceptive intent. *Id.* Moreover, § 251 requires that the Commissioner reissue patents only "for the invention disclosed in the original patent", the language of the section specifically prohibiting the introduction of new matter

into thereissue application. *Id.* Thus, in sum, a reissue application may only be granted where:

(1) the original patent has a correctable error;

(2) the error was mzde without deceptive intent; and

(3) the invention claimed in the reissue patent is fully disclosed in and supported by the specification of hte original patent.

In analyzing these factors, it is well-settled that the statutory correction mechanism is "based on fundamental principles fo equity and fairness, and should be construed liberally." *In re Weiler,* 790 F.2d 1576, 1579 (Fed.Cir.1986).

Stein does not, for the purposes of this motion, contend that Hester engaged in deception during the reissue application. Rather, Stein attacks the reissue for its failure to satisfy the "error" and "original invention" requirements of § 251. Specifically, Stein's motion presents two principal questions:

(i) whether limitations in the claims of the 047 patent, which were broadened in the reissue patents, are the type of "errors" amenable to correction under § 251, and

(ii) whether the claims of the reissue patents asserted against Stein are fully disclosed in, and supported by, the original 047 patent.

Each is separately addressed.

A.

The complete realm of "errors" for the purposes of § 251 has not been explicitly defiend by Congress ro hte courts, but

the statute and Federal Circuit precedent provide some boundary signposts concerning what constitutes an "error" amenable to § 251 correction. The reissue statute, based on the principles of fairness and equity, is construed liberally "to avoid the forfeiture of substantive rights due to error made without intent to deceive." *Scripps Clinic,* 927 F.2d at 1575. Yet, the Federal Circuit has made unmistakably clear that "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Weiler,* 790 F.2d at 1579. Thus,

> [t]he reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.

Weiler, 790 F.2d at 1582.[3]

Although the statute itself provides no definition of "error", its history is instructive in this regard. Section 251 replaced the prior reissue statute, 35 U.S.C. § 64 (1946), which authorized the correction of patents that contained "error ... by inadvertence, accident, or mistake, and without fraudulent or deceptive intent." Section 251 eliminated the reference to "inadvertence, accident, or mistake" because those terms were deemed to be encompassed by"error" and, therefore, redundant. *Hewlett–Packard Co. v. Bausch &*

---

[3] Indeed, the Federal Circuit has observed that

> reliance on allegations of inventors' ignorance of drafting and claiming technique and counsel's ignorance of the invention are unavailing. Those allegations could be frequently made, and, if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in the disclosure.... Insight resulting from hindsight on the part of new counsel does not, in every case, establish error.

Weiler, 790 F.2d at 1583 n. 4.

Lomb, Inc., 882 F.2d 1556, 1565 (Fed.Cir.1989),*cert. Denied,* 493 U.S. 1076, 110 S.Ct. 1125, 107 L.Ed.2d 1031 (1990). Yet, this revision did not change the substantive standard for reissue, and "error", for the purposes of the reissue provision, is still interpreted as "inadvertence, accident or mistake." *Id. (Quoting Ball Corp. v. United States,* 729 F.2d 1429, 1435 & n. 9 (Fed.Cir.1984)). The first two of these terms, "inadvertence" and "accident", refer to circumstances arising unintentionally or unconsciously.[4] The third term, "mistake", could be more broadly construed to refer to either an intentional or unintentional error.[5] In light of the principle of *ejusdem generis,* however, these terms are best construed as requiring an "error" to be made unintentionally in order for that "error" to be eligible for § 251 correction. *See generally, In re Mead,* 581 F.2d 251, 257 (CAPA 1978)(deliberate, conscious choice not an error amenable to correction by § 251).

---

[4] Thus, Webster's Third International defines "inadvertent", in part, as follows

> not turning the mind to a matter: HEEDLESS, NEGLIGENT, INATTENTIVE ... UNINTENTIONAL.

See Webster's Third International Dictionary Unabridged, at 1140 (1993). And Webster's defines "accident", in part, as follows

> an event or condition arising by chance or arising from unknown or remote causes ... lack of intention ... an unforeseen unplanned event or condition.

Id. At 11.

[5] Webster's defines the noun "mistake", in part, as follows

> a misunderstanding of the meaning or implication of something ... a wrong action o rstatement proceeding from faulty judgment, inadequate knowledge, or inattention; an unintentional error.

See Webster's Third International Dictionary Unabridged, at 1446 (1993).

The question presented here is whether the 047 patent limitations sought to be broadened through reissue are the result of an "error" amenable to § 251 correction. Where, as here, no facts material to the patentee's reason for seeking a reissue are disputed. the question whether an "error" has occurred for the purposes of § 251 is a question of law suitable for summary determination.[6] Thus, summary determination is appropriate in this case, given that the record supports only one conclusion concerning Hester's reason for seeking reissue.

The circumstances surrounding the decision to seek reissue are undisputed. Charles Elkwood Williams, an employee of Hester and the sole named inventor of the 047 patent and the reissue patents in suit, provided the required oath with his application for reissue. According to this oath, Williams and Hester learned of the accused Stein cooker on January 18, 1988, and concluded that the 047 patent should cover such a cooker, notwithstanding the fact that the Stein cooker used a non-steam het source and only one source of steam in the cooking process. Yet, Hester's present counsel advised Hester that the 047 patent claims, as written, might not cover Stein's cooker. Thus, Williams, by oath, declared that the patent was insufficient because it claimed less than he had a right to claim. Specifically, Williams identified two relevant deficiencies of the 047 patent, as follows:

---

[6] *See, e.g., Scripps Clinic,* 927 F.2d at 1574 ("Although there were factual aspects debated by the parties, they are not material to the question of hte legal adequacy of the patentee's reason for requesting reissue. That is a questionfo law, and the facts material to that question were not in dispute. The amtter could have been, and was, decided summarily."); *see also Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994 (Fed.Cir.1993)

(i) that "each of claims 1-14 therein **requires cooking 'solely with steam'** and exposing food products within the cooker housing 'only to said steam as the sole cooking medium'"; and

(ii) that "each of claims 1-14 therein **requires 'two sources of steam** providing said steam to cook the food products, nozzles for releasing steam located inside said housing'"[7]

(emphasis added).

These deficiencies, according to Williams, "arose after [he] executed and filed the original application from which the 047 patent issued" and were caused by "the failure of patent attorney Lawrence R. Brown to appreciate the full scope of [his] invention." To be sure, an attorney's failure to appreciate the full scope of an invention is often amenable to § 251 correction.[8] *In re Wilder,* 736 F.2d 1516, 1519

---

[7] The reissue oath specifies two further insufficiencies not relevant to the dispositionfo the instant motion, namely, that the 047 patent requires:

(i) "a steam generator supplying supplemental steam into said housing at said nozzles located there inside to maintain the atmosphere together with the other steam source at near 100% humidity 100 C, and a pressure above atmospheric"; and

(ii) "a pool of water within the housing with heating means for boiling the wate to create steam."

[8] Indeed, the most common defect corrected by a broadening of the claims is an attorney's failure to appreciate the full scope fo the invention. *In re Wilder,* 736 F.2d 1516, 1519 (Fed.Cir.1984), *cert. Denied,* 469 U.S. 1209, 105 S.Ct. 1173, 84 L.Ed.2d 323 (1985). And in

(Fed.Cir.1984), *cert. denied,* 469 U.S. 1209, 105 S.Ct. 1173, 84 L.Ed.2d 323 (1985). Yet, this record conclusively rebuts the existence of any attorney "failure to appreciate".

In alleging patent counsel's failure to appreciate the scope of the invention, Williams' oath stands alone, unsupported by any record evidence. Instead, viewed as a whole, the undisputed record provides clear and convincing evidence[9] that the claim limitations did not result from any failure of counsel to understand or appreciate the scope of the invention claimed. This evidence includes the clear language of the patent claims, the prosecution history of the patent, and the absence of any statement from Williams or patent counsel Brown concerning the nature or cause of Brown's failure to appreciate the full scope of Williams' invention.

The 047 patent, originally filed in July 1979, claimed, in relevant part,

---

this regard, it matters not whether this failure could have been avoided "at the time fo prosecution with a more thorough patentability search or with improved communications between the inventors andthe attorney...." *Id.* At 1519.

[9] The "clear and convincing" burden of proof derives from the statutory presumptionof validity of duly issued patents. *See Interconnect Planning Corp. v. Feil,* 774 F.2d 1132, 1139 (Fed.Cir.1985). This presumption extends to reissue patents. Indeed, Federal Circuit precedent suggests that the burden of proving invalidity is "made heavier" by reissue. *Id.* (Citing *Fromson v. Advance Offset Plate, Inc.,* 755 F.2d 1549, 1555 (Fed.Cir.1985)). And, as the Federal Circuite has further observed, the statutory presumption "derives in part from recognition of hte technological expertise fo the patent examiners." *Feil,* 774 F.2d at 1139. In this case, it is unclear what, if any, role hte examiner's technological expertise played in determining whether the putative claim deficiencies were caused by "error". In any event, the analysis here proceeds by giving effect to the presumption that the claims of the reissue patents in suite are valid.

> [a] food cooking system **cooking solely with steam** foods such as fish, fowl, meats or produce carried through such cooker o a continuously running conveyor belt, ... and **two sources of steam providing said steam** to cook the food products....

(emphasis added). Thus, the 047 patent was originally limited to an oven cooking solely with steam provided by two steam sources, the two limitations relevant here. These limitations remained throughout nearly seven years of patent prosecution. Indeed, in the final version of the 047 patent, this claim not only requires "cooking solely with steam" and "two sources or steam", but reiterates the importance of steam-only cooking by stating that steam is "the sole cooking medium."[10] Significantly, the relevant limitations did not arise from patent counsel's drafting of a highly technical or difficult aspect of a complex invention. To the contrary, the limitations arose from the insertion of simple, straightforward language that is featured prominently in the patent. This factor alone belies any assertion that poor communication or a misunderstanding caused patent counsel's failure to appreciate the full scope of the claimed invention. To the contrary, the claim language leads to the inescapable conclusion that counsel and inventor deliberately chose the scope of the invention, and that this

---

[10] As amended, claim 1 of hte 047 patent reads, in relevant part:

> [a] food cooking system **cooking solely with steam** foods such as fish, fowl, meats or produce carried through such cooker ona continuously running conveyor belt, ... **means passing said conveyor belt through said housign to expose food products within the cooker housing only to said steam asd the sole cooking medium,** and **two sources of steam providing said steam** to cook the food products..

(emphasis added)

scope was limited to ovens cooking solely with steam from two steam sources.

Any failure to patent counsel to appreciate the full scope of the claimed invention is further belied by the prosecution history of the 047 patent. Throughout almost seven years of Patent and Trademark Office ("PTO") actions, rejections, and appeals, the limitation to steam only cooking from two steam sources remained. Indeed, Williams and Hester emphasized the importance of using two steam sources in no fewer than five PTO pleadings.[11] And they did the same with respect to the importance of cooking solely with steam in no fewer than six PTO pleadings.[12] The record makes unmistakably clear that these repeated emphases were not incidental or offhand, but rather reflect the inventor's and counsel's clear understanding of the centrality of steam only cooking from two steam sources to Williams' invention.

Illustrative of this is the response fo Hester and Williams to PTO actions rejecting, as obvious, the invention claimed in teh047 patent application. In a PTO Action dated February 6, 1980 concerning the application that ripened into the 047 patent, the PTO examiner rejected claims 1-5 in the

---

[11] See, e.g., Applicant's Brief on Appeal fo the Examiner's Rejection of Claims dated September 17, 1981, at 13 (December 22, 1981) ("Two diverse steam sources are claimed, namely–a steam generator with nozzles–and–a pool of boiling water–.... [T]he synergy of these two interacting steam sources is novel and nowhere suggested in any of the cited art.").

[12] See, e.g., Applicant's Response to Final Office Action dated September 17, 1981, at 3 (November 9, 1981) ("[Prior art] heats the products in water ... and in no way is limited to the claimed steam as the sole or critical source .... The claimed invention of claim 1 conversely has exposure of food ony to steam, a novel feature not in a single one of the references applied.").

application, pursuant to 35 U.S.C. § 103, "as obvious over Vischer, Jr. in view of Jourdan." The examiner explained:

> Vischer, Jr., teaches steamcooking of foods being conveyed through said cooker while spraying food with steam. Jourdan teaches steam cooking of food in a cooker employinga pool of water within the base or housing with means for heating said water. To provide Vischer, Jr., with two sources of steam would be obvious if so desired inview of Jourdan.

In his final rejection dated September 17, 1981, [13] the examiner reaffirmed his position on obviousness, citing new examples of prior art and stating:

> Claims 1, 5, 11 and 12 are rejected under 35 U.S.C. § 103 as being obvious over Wilson and Hice in view of Farkas. The patent to Wilson discloses the concept of a chamber ... having two cooking sources steam 56b and steam from water "pool" *W* heated by 56a. The fact that the water in pool *W* is heated at about 2.2° ... steam would be inherently given off. The patent to Hice discloses the concept of a[sic] above atmospheric cooking arrangement wherein cooking is performed in a complete gaseous environment [sic], with steam being provided by a

---

[13] A final rejection was initially issued on July 9, 1980 and Hester appealed to the Borad of Patent Appeals. Subsequent to the filing of Hester's appeal brief, the examiner reopened prosuection of the patent with an Office Action dated March 17, 1981. This reopened proceeding was terminated on September 17, 1981 when a second final rejection was issued. This second final rejection was reversed by a decision of the Board of Patent Appeals dated June 21, 1985, after a successful appeal by Hester.

> water pool and a second inlet for a pressure source at 26.

Thus, the examiner maintained throughout the 047 patent prosecution that the use of steam in the oven invented by Hester and Williams added nothing to the prior art that was not obvious.[14]

In response to the various actions by the examiner, Hester and Williams consistently asserted the unique natrue of their invention, referring repeatedly to the novelty of cooking solely with steam from two sources of steam. Thus, on appeal from the examiner's first final rejection on the basis of obviousness,[15] Hester and Williams asserted that the examiner erred in concluding that the 047 patent application was obvious in light of Vischer and Jourdan, stating:

> [t]he primary reference Vischer cooks with IR radiation not steam. Clearly the claimed featrue of cooking *solely* with steam is directly contrary to the teaching of hte Vischer patent, which could never make obvious any process or equipment cooking *solely* with steam as claimed. Thus, this is an improper reference under 35 U.S.C. § 103, unless another reference explicitly teaches replacement of the IR in Vischer, Jr. with a steam source, which Jourdan does not.

---

[14] *See also* Examiner's Answer to Applicant's Brief on Appeal (August 8, 1982) ("[Claim] is obvious since Hice food product ... is not submerged in water and his statement that the food is cooked by steam, it is obvious that one source of steam in Fig 1. comes from the heated water pool ... and the heating means can take the form of steam.").

[15] As discussed *supra* note 13, two final rejections were issued by the Examiner in the 047 patent prosecution.

(emphasis in original).[16] Further, in response to the examiner's March 17, 1981 action which reopened the 047 patent prosecution, Williams and Hester reemphasized steam as the sole cooking medium, amending claim one to read, in relevant part:

> means ... to expose food products within the cooker housing *only* to said steam *as the sole cooking medium,* and two sources of steam providing said steam to cook the food products.

(emphasis in original).[17] In explaining the motivation for offering this amendment, Williams and Hester stated:

> [c]laim 1 is amended to clarify the constituency of the cooking medium .... Note therefore that at least two structural distinctions are present in claim 1 not in Wilson, namely (1) steam is the sole cooking medium whereas Wilson dunks the food into the water W, and (2) water pool is boiled to produce a steam source.

Applicant Response to Office Action of March 17, 1981 (April 20, 1981). And yet again, in response to the second final rejection of September 17, 1981, Hester and Williams argued that:

---

[16] *See also* Applicant's Amendment and Response to Office Action mailed February 6, 1980 (April 28, 1980)("[C]ooking necessarily is done by infra-red in Vischer and the steam is primarily for the purpose of preventing the food from drying out because of the dry IR heat. The cooking could not be done without the IR rods. This principle is completely different from applicant's invention where the claims define cooking *solely* with steam.")(emphasis in original).

[17] This emphasis indicates the language added by way of amendment to claim one in the patent application.

> [i]n the 35 U.S.C. § 103 rejections the Examiner is still failing to find art pertinent to the claimed combination of interacting elements.... **The art just simply fails to show ... using ... solely steam in the cooking** for efficient energy transfer to the food but more importantly for preventing the drying out with dry air or gas roasting or washing off of food juices and essences with water as they are cooked and transported.... **The claims are explicit. Thus, claim 1 defines clearly–exposing food products within the cooker housing only to said steam as the sole cooking medium–. All the references cited (Wilson, Hice and Farkas) would need be change to something they are not to do this.**

Applicant's Response to Fianl Office Action dated September 17, 1981 (November 9, 1981)(emphasis added).[18]

Protestations regarding the novelty of steam-only cooking from dual steam sources were unable to sway the examiner, thus, Hester and Williams appealed the examiner's repeated obviousness rejection of Williams' claimed invention. By Decision dated June 21, 1985, the Board of Patent Appeals reversed the examiner's final rejection of the 047 patent claims, concluding that "there is insufficient evidence to

---

[18] Further in this Response, Williams and Hester reiterate the centrality of steam only cooking to their invention, stating that

> Farkas et al. heats the producst in water ... and in no way is limited to the claimed steam as the sole or critical source .... The claimed invention of claim 1 conversely has exposure of food only to steam, a novel feature not in a single one of the references applied.

Applicants Response to Final Office Action dated September 17, 1981, at 3 (November 9, 1981)

warrant a conclusion of obviousness within the meaning of 35 U.S.C. § 103." Specifically, the Board concluded that:

> no suggestion in the combined teachings of the references ... would have led the ordinary skilled worker in the art to an apparatus **utilizing steam as the sole cooking medium**; [and] **utilizing two separate sources of steam,** one of which includes a pool of water in the cooking chamber with means for boiling the water ... While Wilson arguably discloses a dual steam supply ... the reference clearly employs, and in fact requires water as a cooking medium.

(emphasis added). Thus, the examiner's obviousness rejection was reversed on the grounds argued repeatedly by Hester and Williams throughout the prosecution of the patent, namely, that an oven cooking solely with steam from two steam sources was a novel, non-obvious invention in light of the prior art. Williams' and Hester's representations throughout the prosecution of the 047 patent refute any conclusion that the limitation of the 047 patent to ovens cooking solely with steam from two steam sources resulted from patent counsel's failure to appreciate the scope of Williams' invention.

Finally, the record contains no evidence concerning the cause or nature of the failure of patent counsel Brown to appreciate the full scope of Williams' invention. Significantly, no declaration from Brown was submitted in the reissue proceedings or in this matter. And while Williams' reissue oath invokes the mantra of counsel's "failure to appreciated", Williams offers no explanation as to why Brown erroneously believed that cooking solely with steam from two steam sources were limitations on the claimed invention. Instead, the oath includes only an unsupported, conclusory, hearsay statement concerning the state of Brown's understanding.

While an attorney's failure to appreciate the full scope of a claimed invention is an "error" amenable to correction pursuant to § 251, the record is pellucidly clear that no such failure to appreciate infected the prosecution of the 047 patent claims. Williams' unsupported allegation of attorney failure in the reissue oath is wholly unpersuasive when viewed in light of the 047 patent claim language and prosecution history. This does not mean that an inventor must, in every case, obtain corroboration from patent counsel to invoke attorney error for the purposes of § 251. In certain circumstances, the nature and cause of an "error" may be evident from the "error" itself. Yet, if courts are to define the subset of patent prosecution problems amenable to § 251 correction, the nature of an attorney's failure in patent prosecution must be ascertained. And this is especially so where, as here, an allegation of attorney error is wholly unsupported and overwhelmingly contradicted in the record. Accordingly, while an attorney's failure to appreciate the scope of a claimed invention is an "error" amenable to correction pursuant to § 251, no reasonable trier of fact could find such a failure on the facts of this case.

Broadening reissues are not limited to those circumstances discussed in *Wilder,* 736 F.2d at 1519, in which an attorney fails to appreciate the scope of a claimed invention. Rather, such reissues can extend to circumstances where a claim is drawn too narrowly because of an "error" which, while not specifically discussed in *Wilder*, is otherwise the result of "inadvertence, accident, or mistake." And such "error" can include errors of law. *See, e.g., Scripps,* 927 F.2d at 1575 ("[errors of law] not excluded from the class of error subject to correction in accordance with the reissue statute"). Yet, no other such "errors" were asserted by Hester and Williams, nor does the record reflect any "error" of law or understanding resulting in the 047 patent limitation. To the

contrary, the record points persuasively to the reason for the reissue sought by Hester and Williams: hindsight inspired by the accused Stein oven. And, in the facts of this case, this reason is not an "error" amenable to § 251 correction.

The plain language and prosecution history of the 047 patent, as recited above, reflect a deliberate, intentional choice by Hester and Williams to limit the claims of the 047 patent to ovens cooking solely with steam from two steam sources. In light of the Stein oven, it is understandable that Hester regrets this choice. But this is classic hindsight, and "[i]nsight resulting from hindsight on the part of new counsel does not, in every case, establish error." *Weiler*, 790 F.2d at 1583 n. 4. Otherwise, reissues could be granted on anything and everything mentioned in the disclosure, a result neither intended nor permitted by § 251. *Id.* In this case, reissue provided Hester an opportunity to prosecute, *de novo*, patent claims issued after nearly seven years of PTO actions in order that those claims cover ovens with characteristics repeatedly distinguished and disclaimed in the PTO. To allow reissue in these circumstances is inconsistent with the *ejusdem generis* interpretation of § 251, which requires an "error" to be inadvertent and unintentional. On this record, the 047 claim limitations broadened through reissue were clearly neither inadvertent nor unintentional. Thus, as a matter of law, Hester's reason for seeking reissue is legally inadequate.

This conclusion, compelled by the statute's language and consistent with Federal Circuit precedent, is also supported by the policies served by the reissue statute. Section § 251 serves to protect a patentee against the forfeiture of patent rights, *see Scripps Clinic*, 927 F.2d at 1575, not to provide a mechanism by which a patentee, dissatisfied with the decisions she made in a patent's prosecution, can return to the PTO for another bite at the apple. *See, e.g., Weiler*, 790

F.2d at 1582 ("reissue statute was not enacted ... as a grant to the patentee of a second opportunity to prosecute *de novo* his original application"). Significantly, the denial of a reissue here would not have resulted in a forfeiture of Hester's patent rights, but merely would have confined Hester to the invention claimed through the deliberate and intentional prosecution of the 047 patent, namely, an oven cooking solely with steam from two steam sources. There can be no doubt that the universe of circumstances amenable to § 251 correction is expansive, but it must have limits. And if this case is not beyond those limits, then it is difficult to imagine where the boundaries might lie. Accordingly, the reissue of the asserted claims in the reissue patents was improperly granted and those claims are, thereby, invalid.

B.

Given the absence of "error" amenable to § 251 correction, it is unnecessary to reach Stein's further contention that the asserted claims of the reissue patents cover an invention not disclosed in the 047 patent. Nevertheless, the "original invention" requirement of § 251 does provide an alternative basis for concluding that the reissue of the asserted claims was improper and that these claims are invalid.

The essential question concerning compliance with the "original invention" requirement of § 251 is:

> whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.

Amos, 953 F.2d at 618. It is well-settled that an inventor need not have the subjective intent to claim the broadened invention for a reissue to be appropriate. *See Scripps*, 927 F.2d at 1575. But reissue does require an "objective" intent

manifested in the original patent. *Id.* In other words, looking at the claims, drawings, and specifications of the original patent, a person with ordinary skill in the art must be able to conclude that the inventor could have claimed the new subject matter in the original application. *See Amos,* 953 F.2d at 618. "Could have claimed" does not mean that a claim is merely indicated or suggested by the specification. To the contrary, the proper standard requires the specification to have been capable of supporting all of the elements of the new subject matter had that matter been included in the original patent. As the Supreme Court observed more than a half century ago:

> it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue **was intended to have been covered and secured by the original.**

U.S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 676, 62 S.Ct. 839, 844, 86 L.Ed. 1105 (1942)(emphasis added).[19]

The 047 patent claims cover an oven cooking solely with steam provided by two steam sources. Indeed, this fact is conceded by Hester, and these limitations were a principal reason why Hester and Williams sought reissue. The common denominator of the several claims of the reissue patents asserted by Hester against Stein, and the relevant material change from the 047 patent, is the absence of the limitations to ovens that (i) cook solely with steam, and (ii)

---

[19] As discussed *supra*, the "intent" required by the Supreme Court is an objective intent, as disclosed on the face of the patent, not the subjective intent of the inventor. *See Scripps,* 927 F.2d at 1575.

have two steam sources.[20] Thus, the question presented here is whether the 047 patent manifests an objective intent to cover ovens that utilize heat sources other than steam, and have less than two steam sources. If not, the reissue impermissibly includes new subject matter, and the claims covering this subject matter are invalid.[21]

It is worth noting that the search for support may well be a less rigorous inquiry where the erroneous limitation in the patent involves an element less central to the claimed invention.[22] For example, if the 047 patent required a steel oven housing, and the reissue sought to include housings made of aluminum or other materials that do not alter the utility of the cooker, specification support for the new materials covered might br provided by the absence of an emphasis on "steel" in the specifications, and the incidental nature of this element of the claim. Yet, where, as here, the reissue seeks to broaden the claims to cover a central element

---

[20] The reissue also sought to correct two further insufficiencies relating to requirements concerning (I) the humidity and temperature maintained in the oven; and (ii) a pool of water within the housing to create steam. *See supra*, note 7. The propriety of these corrections are ot challenged by Stein, and are not material to the resolution of the instant motion.

[21] The 047 patent has only one independent claim, claim 1, that includes both limitations relevant to Stein's motion for summary judgment. Thus, if the elimination of these limitations results in impermissible new matter, then any reissue claim without these limitations was improperly reissued and is therefore invalid. All of the reissue claims here asserted omit the relevant limitations.

[22] The centrality of steam-only cooking to the invention covered in the 047 patent is clear from the prosecution history of the 047 patent, which is replete with comments concerning the uniqueness of an oven cooking solely with steam. *See supra*, notes 10-18 and accompanying text.

in a manner specifically disavowed in the original patent,[23] the specifications should make it clear to one with ordinary skill in the art that those elements are objectively intended by the specifications, notwithstanding the claims' language.

Hester contends that the 047 patent application manifests an objective intent, clear to someone with ordinary skill in the art, to claim ovens with a non-steam heating element. Assuming, *arguendo*, that a patent's specifications can manifest, to someone with ordinary skill in the art, an intent to claim an invention specifically disavowed in the patent's claims, the 047 patent specifications clearly do not do so. It must appear, "from the face of the instrument", that the 047 patent covers ovens using steam and non-steam heating elements. *U.S. Industrial Chemicals*, 315 U.S. at 676, 62 S.C. at 844. It is not enough that a person with ordinary skill in the art could conclude that Williams could have claimed a cooker that utilized steam in conjunction with another heating element had he chosen to do so in his original patent application. Nor is it enough, as the patent examiner evidently concluded in considering the propriety of the second reissue application, that "the claims **seem to be for the same thing** as in the original patent as well as the first reissue patent." (emphasis added). It must appear, to someone skilled in the art, that the 047 patent did, in fact, disclose a cooker utilizing non-steam heating elements. *Id.*

Nowhere in the 047 patent claims or specification is there a suggestion that meats cooked in the claimed invention could be cooked with a heat source other than steam. Indeed, the specifications of the 047 patent, including its claims, drawings, and preferred embodiment, all manifest the

---

[23] The language "solely with steam" disavows coverage of an invention cooking, at least in part, with heating elements other than steam.

centrality of a dual steam system providing steam-only cooking. This conclusion is confirmed by the representations of the inventor of the 047 patent, Williams; an individual with ordinary skill in the relevant art. In PTO filings on the application leading to the 047 patent, Williams repeatedly stated that his invention and disclosures covered only an oven cooking solely with steam. For example, in a pleading responding to the examiner's final rejection of claims on the basis of obviousness, Williams states, in part:

> it has been **stated in applicant's [Williams'] specification** and record that the invention objectives and problems solved are unique–namely, (1) very high energy efficiency attained by **solely steam heat interfacing with the food....**

See Applicant's Response to Final Office Action dated September 17, 1981, at 5 (November 9, 1981) (emphasis added); *see also, supra,* notes 10-18 and accompanying text. Thus, Williams' own PTO representations reflect the opinion of one skilled in the art that the 047 patent discloses an oven cooking solely with steam.[24]

The absence of any mention in the 047 patent and its specification of any mode of cooking beyond steam-only

---

[24] In this respect, it is worth noting that there is some overlap in the evidence relevant to the "error" requirement, discussed in section III-A, and the "original invention" requirement. Thus, in the instant case, the absence of any disclosure of an oven using a non-steam source fo heat to cook food products reinforces the conclusion that patent counsel did not fail to understand the full scope fo the claimed invention while prosecuting the 047 patent. Thus, the 047 specifications do not disclose a broader invention that patent counsel failed to comprehend or understand. To the contrary, those specifications disclose precisely the invention covered by the 047 patent claims prosecuted by Hester, Williams and Brown in the original application.

cooking, combined with Williams' opinions expressed in the PTO proceedings, clearly and convincingly demonstrate that the 047 patent does not disclose the enlargement of coverage allowed in the reissue. Hester attempts to create an issue of fact through the submission of the sworn declaration of an expert witness, Dr. Terry Titus, who stated that the patent specifications of the 047 patent would convey to a person with ordinary skill in the art that the 047 patent supports the broadened reissue claims. Because this declaration is conclusory, and not sufficiently probative of the relevant issues, it does not create a material issue of fact on which a reasonable trier of fact could find that the 047 patent discloses an oven cooking with non-steam heat.[25]

Titus' declaration reveals that he reviewed the claims of the reissue patent and compared them with the 047 patent specifications, finding support for the asserted claims in those specifications. Yet, Titus' testimony is not focused on the relevant inquiry and thus, his conclusions are largely irrelevant to the determination of the instant matter. Titus looked at each of the asserted claims, to determine if they had support in the specifications of the 047 patent. But the broadening of the 047 patent was accomplished by removing prior restrictions, not by adding additional language to the claims. In these circumstances, there will always be support in the specifications for the language of the broadened claim. This proposition is illustrated by the facts of this case.

---

[25] *See, e.g., Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1572 (Fed.Cir.1984) ("[Expert] affidavit expressed no more than an unsupported conclusory opinion which ignored, rather than conflicted with, the evidence of record. Thus, no genuine issue of material fact was raised by appellant."); *see generally Duvall v.Bristol–Myers–Squibb Co.*, 103 F.3d 324, 331 (4th Cir.1996) (holding conclusory allegations were insufficient to create material issue of fact).

The 047 patent claims are limited to ovens cooking "solely with steam." To enlarge these claims to cover ovens utilizing non-steam heat, Williams could amend the claims in one of two ways, namely, (i) by specifying other ovens to which coverage is explicitly extended, *i.e.*, gas and steam, infra-red and steam, etc.; or (ii) by replacing "solely" with "partially", so that the claims would now cover an oven cooking "partially with steam". Both amendments require that coverage of ovens using non-steam heat be disclosed objectively in the 047 patent's specifications. Titus' analysis is only probative if the first amendment approach is taken. In that event Titus' approach would compare the enlargement of coverage expressed in the reissued claims with the relevant specification. But where, as here, the second approach is taken, Titus' conclusion has no probative value. Any system that cooks "solely" with steam also cooks in part with steam. Thus, Titus' declaration only recites the obvious, *i.e.* that support in the specifications for a claim's requirements will also support a claim with a subset of those requirements. In contrast, the relevant question for a valid reissue is not whether the specifications support the claim language, but whether these specifications, viewed by one with ordinary skill in the art, disclose the new subject matter covered by that language. The Titus declaration is silent on that issue.

Nowhere does Titus match up specifications in the 047 patent to an invention with non-steam heating elements. In a chart attached to his declaration, titled "Example Specification Support for Asserted Claims", Titus addresses the non-steam heating element in only one respect. In addressing claim 75 of the 259 reissue, Titus confronts the claim of a cooking system "including a heat source in addition to said steam providing means, said additional heat source introducing additional heat into said housing for heating and at least in part cooking said products." Thus, the issue of specification support for an

extra heating element, not expressly limited to steam, is presented squarely. But the only example of specification support indicated by Titus is that "[f]igure 1 [of the 047 patent] shows a heater 41 that introduces additional heat into housing 16." This heater 41 is part of the boiler on the floor of the oven that heats a pool of water to provide the internal source of steam. Thus, the specification support indicated for a second heating element is specifically for a steam producing heating element, and neither Titus nor the specification demonstrate that this disclosure covers non-steam heat.

In sum, the Titus declaration asserts only the obvious fact that an invention cooking solely with steam, *a fortiori*, cooks in part with steam. Thus, this declaration is not probative of the relevant issue, and does not create a factual issue material to the question whether the reissue patents in suit improperly cover new matter. *See, e.g., Union Carbide,* 724 F.2d at 1572. In the final analysis, the undisputed material facts include (i) the complete absence of any disclosure in the patent of cooking with non-steam heating elements, (ii) the centrality of steam only cooking in the specifications and claims of the 047 patent, and (iii) Williams' representations concerning the scope of the invention disclosed in the 047 specifications made during the PTO proceedings. Although a close question, in the circumstances of this case, these undisputed facts clearly and convincingly demonstrate that the reissue patent claims indeed cover new matter not covered by the 047 patent, namely, ovens cooking with steam and a non-steam heating element.[26] Accordingly, the asserted claims of

---

[26] Given that the asserted claims of the reissue patents contain impermissible new matter because they cover ovens using non-steam heating sources to cook products, it is not necessary to reach the question whether the 047 patent discloses the invention of an oven with one steam source to one with ordinary skill in the art.

the reissue patent were issued contrary to § 251's command that "[n]o new matter shall be introduced into the patent for reissue" and are invalid.

The asserted claims of the reissue patents in suit were reissued in contravention 35 U.S.C. § 251 and, thus, Stein's motion for summary judgment on the question of the validity of the asserted claims of the reissue patents is granted. As there can be no infringement of these invalid claims, plaintiff's cause of action must be, and hereby is, dismissed.

An appropriate Order has entered.

The Clerk is directed to send copies of this Memorandum Opinion to all counsel of record.

APPENDIX D

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

CIVIL ACTION 96-716-A

HESTER INDUSTRIES, INCORPORATED,
Plaintiff,

v.

STEIN, INCORPORATED,
Defendant.

REPORTER'S TRANSCRIPT
JURY TRIAL
VOLUME I
Tuesday, March 25, 1997

BEFORE: THE HONORABLE T.S. ELLIS, III, Presiding

* * * *

RULING BY THE COURT

THE COURT: What is before the Court at this time is the renewed motion of Stein for summary judgment on the question of whether the asserted claims of the patent in suit, the reissue patent -- and it would be both reissue patents -- are invalid for failure to comply with substantive requirements of Section 251, governing the reissue of patents.

As we know, Hester has accused the ovens manufactured by Stein and, I think by Becker -- is that right?

ATTORNEY DE LA GARZA: Checker.

THE COURT: -- Checker, of infringing two claims of the '510 patent and six claims of the '259 patent, both of which were reissue patents based on the '047 patent.

The patents cover a cooker employing a spiral conveyor to escort new products through a housing in which they are cooked. Hester originally claimed in '047, the cooking device, and the '047 claimed an invention of a cooker that utilized only steam, and two steam sources, one external, one internal.

The application for the '047 Patent was filed in July of '79, and the patent issued in 1986. Two years later, right at, I guess it was fairly close, after -- on the two year deadline, Hester applied for a reissue pursuant to '251, alleging that through attorney error their claims of the '047 Patent had been drawn too narrowly.

A second reissue application was filed, for reasons not relevant here, that we have been talking about. In any event, the two reissue patents ultimately granted, and they now form the basis of Hester's claims of infringement.

Now, Hester -- Stein move for summary judgment in December, and Stein contended that the contradicted record reflected that the reissue patents were invalid. The motion was denied. And then Stein renewed its motion, which is what the Court is now considering.

Summary judgment principles are too well-settled to require much elaboration here. They are set forth in Anderson against Liberty Lobby, in the Scripts case in the Federal Circuit, and so forth. I am not going to proceed to recite them in any length. Celotex is yet another one.

Now, the inquiry into whether there was compliance with Section 251, of course, begins with an examination of the language of that statute, with which we are all familiar, and I

don't need to review that now. But in essence, Section 251 requires that an application for reissue be based on one of four specified groups of correctable defects.

One is an error in specification. Two is a defective drawing. Three is a narrowing of the claims, typically resulting from belated discovery of partially invalidating prior art. And then fourth is a broadening of the claims, typically resulting from post issuance discovery of attorney error in understanding the scope of the invention. These four categories are elucidated in the Amos case in the Federal Circuit.

This case deals with the fourth, that is, the broadening of the claims. Section 251 requires that a patentee seeking reissue must submit an oath or declaration setting forth the defect, that it occurred through error, the defect occurred or insufficiency occurred without error -- or through error without deceptive intent.

And, of course, 251 requires that the reissuance only go for inventions disclosed in the original patent. You can't introduce new matter into the reissue application.

In analyzing these factors, it is well-settled that the statutory correction mechanism is based on fundamental principles of fairness and equity, and should be -- and that the statute itself should be construed liberally.

And the Federal Circuit has also observed that the rejection of the reissue claims has typically been founded on the failure of an applicant to show error without deceptive intent, or because newly submitted claims are not supported by the disclosure in the original patent.

Now, Stein here doesn't contend that Hester engaged in deception during the reissue. Rather, what Stein attacks is the reissuance, for the failure to satisfy the two requirements of

Section 251, the error requirement and the original invention requirement.

So, the questions presented are whether the claim limitations of the '047 Patent that are now asserted to be defects are the type of errors or defects amenable to correction under Section 251; and second, whether the claims of the reissued patents that are in issue here — and again, I am only addressing the claims that are in issue here -- are the same invention or disclosed -- there isn't some new invention not disclosed in the '047 Patent. I will be more precise on the formulation of how that is determined in a few moments.

Now, the first question, which is what the Weiler case says was the central question in that appeal, is whether there is an error here that can be remedied by reissue. And there it was clear, the Court made clear that while the Reissue Statute should be construed liberally, the Federal Circuit has made clear that not every event or circumstance that might be labeled error is correctable by reissue.

A reissue application must be accompanied by the reissue oath, in which the inventor must state that the patent is defective, what the defects are, and that error is without deceptive intent. That has been filed, of course, was filed in this case.

Essentially, the two defects that are central to the motion before the Court here are identified in Paragraph 5 of that oath, as in the first two sentences. The first sentence says:

> "An insufficiency in the claims of the said '047 patent is that each of the Claims 1 through 14 requires cooking solely with steam and exposing food products within the cooker housing only to said steam as the sole cooking medium."

That's the first defect.

The second defect that's at issue here is in the second sentence:

> "A further insufficiency in the claims of the said '047 patent is that each of the Claims 1 through 14 therein requires two sources of steam, providing said steam to cook the products, nozzles" —

and so forth. So, those are the two defects that are in issue here.

There is a third defect, that is less clear that it's a defect, but nonetheless because it can be read just to set forth those two and not any other, but it may also be read to suggest that another limitation that is in error, is the limitation that the steam source be at near 100 percent humidity, 100 degrees centigrade and a pressure above atmospheric.

Whether that is an error is not what's central to the Court's consideration here. It's the other two, namely cooking solely with steam and two sources of steam.

Now, the most common form of defect, not suprisingly correctable by a broadening of the claims under 251, is the attorney's failure to appreciate the full scope of the invention.

Wilder recognizes this in the Federal Circuit, and the Federal Circuit has specifically observed that the fact that the error could have been discovered at the time of prosecution with a more thorough patentability search or with improved communications between the inventors and the attorney, does not by itself preclude a patent owner from correcting defects through reissue.

And this is certainly sensible, because most errors presumably resulting in an overly narrow description of the

invention could have been discovered. And, therefore, a rule that limited correction only to errors that could not have been discovered would restrict the availability of the remedy precisely in those circumstances where principles of equity and fairness would allow it.

But, nonetheless, the Reissue Statute, as Weiler then points out, is not enacted as a panacea for all patent protection nor prosecution problems, nor was a grant of a patentee a second opportunity to prosecute de novo his original application.

Those are the general principles that govern, and the Court has to take those cases and decide whether they point persuasively one way or the other here.

Here, the crux of the asserted error does not concern any complex, technical or mechanical aspect of the invention. Instead, the error really concerns a simple matter, the straightforward language featured prominently in the patent. The '047 Patent clearly states that it's a food cooking system, cooking solely with steam.

In fact, examination of the '047 Patent makes clear in the specifications and in all of the -- I think there is, as I recall, there is one independent claim and thirteen dependent claims -- I believe I have that right -- for the '047 Patent.

ATTORNEY DE LA GARZA: You do, your Honor.

THE COURT: All right. And they all require cooking solely with steam and having two sources of the steam.

I won't bother to go through the patent, but obviously that's not really disputed among the parties, or there wouldn't have been a reissue effort.

And the file wrapper, the history is with the emphasis by the patentee that its cooker was patentable because it cooked

solely with steam. It did that any number of times in the record, trying to, and successfully distinguishing prior art, including prior art that used other sources of heat in connection with steam.

So, we have a fairly compelling record that that's what was intended, that was the deliberate choice. And so, we have a factual record that I think is without any issue of fact for the jury on how this all came about.

And the language in the claims of the '047 Patent and in the specifications on their face, the terms, on its face, the patent makes unmistakably clear there was a deliberate choice over the scope of the claims in the '047 Patent

In the Court's view -- let me add, also, in the Court's view, the -- whereas here there is a deliberate choice made unmistakable, that is neither inadvertence, accident, or mistake, then there is no basis for a reissue, and there is no basis for a correction under 251.

Congress has chosen to limit reissue to situations of inadvertence, accident or mistake as set forth in Weiler at 1582. And the circumstances here, particularly the clear language of the '047 Patent, belie any conclusion that such a situation is present here.

These facts and circumstances point compellingly, in the Court's view, to the conclusion that this is not an error comprehended or encompassed by 251.

That Hester now regrets Williams' choice of language, together with the lawyer, given the Stein cooker, is understandable. But to allow reissue on the basis of an unsupported allegation of an attorney error is to allow Hester to represent its patent application with a new theory on the scope. Such a result is not authorized by Section 251.

As the Federal Circuit has observed in Weiler, reliance on allegations of inventor's ignorance of drafting and claimed techniques -- claiming techniques and counsel's ignorance of the invention are unavailing. Those allegations could be frequently made, and if accepted as establishing error would require that the grant of reissues on anything and everything mentioned in the disclosure. And insight resulting from hindsight on the part of new counsel does not in every case establish error.

In the Court's view, those words fit this case perfectly. Distilled to its essence, what happened, as the testimony -- I beg your pardon -- as the declaration of the inventor discloses, is that he got a patent, went along, all of a sudden he came into possession of an advertisement or a circular of a -- of the Stein material.

This is now Paragraph 9 of the declaration.

He said on January 18, 1988, he first learned that Stein and others were currently in the process of developing a new Gyro Cooker, spiral belt steam oven, and he thought at the time that his patent covered -- that relatively broad patent protection, he thought it covered it.

But he went and got a lawyer, essentially, and the lawyer said, "No, it's narrow," and that the limitations in Paragraph 5, the ones about steam, cooking solely with steam, and two sources of steam, according to the lawyer, might prevent the '047 Patent from covering the cooker like the one disclosed in the Stein circular.

And so, as they say, he decided, it was decided that the present reissue application should be filed. I think the Weiler statement at 1583, Note 4, covers this perfectly.

This is a case of a deliberate intention made to limit and to limit the invention to steam only, two sources of steam, a limitation that's everywhere, that's repeated several times in the claim and in the specifications in the patent, and it's in the file wrapper, used as a basis to distinguish prior art, and overcome prior art, and so it was very deliberate.

This doesn't mean that a deliberate choice can't sometimes amount to an error. But in this case, in the Court's view, this is just what the Weiler case had in mind.

Now Hester, of course, is permitted to take advantage of the burden of proof that Stein bears as a moving party, both in a summary judgment motion and moving party, to show invalidity. They have the benefit of the presumption.

The language in the patent, of course, in the Court's view, supports by clear and convincing evidence the contention made here by Stein that the drafting of the '047 Patent by the attorney doesn't reflect the kind of mistake of law or misunderstanding of the claimed invention that justifies a reissue due to error.

In opposition, Hester says that the '47 errors arose due to the failure of the patent attorney to appreciate the full scope of Williams' invention. And indeed, Williams has claimed just this, as he must, in the reapplication. But it's not explained, and why the attorney misunderstood, to explain the invention.

Was this a restriction, tactical or inadvertent mistake, or anything of that sort?

The fact of the matter is, it doesn't take the patent lawyer to read this patent and to understand that what's being claimed, that is, the '047 Patent, that is an invention that cooks only with steam. That's what was claimed.

If he had a broader invention, he could have squeaked up to the lawyer. In any event, this is particularly covered by the statement in Weiler about reliance on allegations of inventor's ignorance of drafting and claiming technique and counsel's ignorance of the invention, that they are unavailing. And that is what we have here.

In any event, we don't have anything from the lawyer indicating what he understood or misunderstood. Whereas here, the language is unambiguous and clear regarding the scope of the patent, the reviewing Court properly should conclude that both the inventor and counsel knew the scope of the claims and that they chose a narrow rather than a broader approach to the invention.

Indeed, the file wrapper shows that, because they emphasized steam only to get over prior art or distinguish prior art, and to hold otherwise, I think, would allow insight resulting from hindsight on the part of new counsel to authorize de novo prosecution of the patent claims to cover more than originally intended. This is not the purpose Congress had in mind when authorizing reissue.

So, in the Court's view, reissue of asserted claims in the reissue patent was improperly granted, and the Court concludes that those claims must, hereby, be declared invalid.

Now in the alternative, the reissue is improper where they cover more than disclosed in the original patent. Let me review that.

It would be -- the reissue would be improper if Stein can demonstrate by clear and convincing evidence that the asserted claims of the reissue patents do not cover the same invention disclosed in the '047 Patent.

Now, the essential inquiry under this section, invention requirement of 251, is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentee.

Now, it's well-settled that an inventor may not have subjective intent to claim the broadened invention for a reissue to be appropriate. The Scripts case makes that unmistakably clear. Reissue does require an objective intent manifested in the original patent, here the '047 Patent.

In other words, looking at the earlier patent, the claims, the drawings, the specifications of the '047 Patent, the person with ordinary skill in the art must be able to conclude that the inventor could have claimed the new subject matter in the original application. This is essentially the formulation of the Amos case.

Now, "could have been claimed" does not mean that a claim is merely indicated or suggested by the specification. Rather, the standard requires that the specification -- that the patent must be capable of supporting all of the elements of the new subject matter had the error been avoided and the subject matter explicitly included in the original patent.

The Supreme Court, more than a half century ago, I think, put it well in the Industrial Chemical case. It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument, that is, the patent, that what is covered by the reissue was intended to have been covered and secured by the original.

Now, that's amended in part, of course, by the cases that make clear since then that subjective intent is not what we are about. It's an objective inquiry.

Now, again, as I said in the case of analysis of whether this was an error, correctable under 251, the common denominator of the claims under '047, cooking solely with steam and the two steam sources, and what the reissue does is take away the cooking solely with steam and say cooking in part with steam, and doesn't have two steam sources.

The question is whether the '047 Patent manifests an objective intent to cover cookers that utilize heat sources other than steam and have fewer than two steam sources. If it doesn't, then the reissue impermissibly includes new subject matter and the claims covering this subject matter are invalid.

Now, Stein relies on the face of the patents themselves to support its position that the reissue patents claim new material. They cover cooker utilizing only steam, whereas the reissue patent -- the original one, only steam, and the reissue patents cover products, such as that manufactured by Stein, perhaps, that use non steam heat sources in conjunction with steam.

And so, the reissue clearly covers new material, namely cookers using none steam heat sources to cook, at least in part, the meat passing through the oven housing.

There is no doubt this is new material, especially given the centrality of steam only cooking to the invention covered in the '047 Patent. The prosecution history of the '047 Patent, as well as the language itself, as I have said repeatedly, is replete with these comments.

And I mentioned that it was used -- "cooking solely with steam" was used in the course of the application to overcome prior art, and that, too, is applicable in this analysis.

Now, there is no question there is new material. The coverage of an oven using nonsteam heat must be something

disclosed or supported by the '047 Patent application -- the '047 Patent, including the claims of the specification.

Now, it's worth noting that the search for support maybe a less rigorous inquiry where erroneous limitation in the patent involves an element central to the claimed invention.

For example, if the '047 Patent required a steel oven housing, and the reissues sought to include aluminum or other materials that don't alter the utility of the cooker or anything of that sort, then specification support for the new material might be provided by the absence of an emphasis on steel, if it just said "steel," and didn't say "solely with steel."

Yet whereas here the reissue seeks to cover and to broaden the claims to cover elements specifically disavowed in the original patent, the plain language of the patent claims command a clear statement in the specifications that those elements are objectively intended by the specifications, notwithstanding the claims language.

There was, in the course of many arguments that he we have had on this, there was an illustration offered by, I think it was counsel for Stein, where you have a patent that covers a vehicle that has four wheels, operational machinery, a metal body, and a radio, and the inventor seeks to reissue to drop the radio because he sees cars that don't have radios; and the inquiry into whether the patent application manifests an intent to cover cars without radios would appear to be different, if instead of merely listing the radio as a feature, the patent claim read "solely cars with radios," as if that were central to the invention.

In that event, it would be difficult to interpret inferences in the application to manifest an intention to invent a radio-less car. It could come up. It could result.

But what I am saying is that when you have claims that are as unequivocal as this, limiting it solely to steam, cooking only with steam, it's different from a hypothetical where you would have a patent that would just say "cooking with steam".

Now, Hester does contend that it's clear to someone with ordinary skill to claim ovens with one steam source and with a nonsteam heating element. It must appear from the face of the patent that Williams was claiming ovens using steam and nonsteam heating elements. This is the Industrial Chemical case again.

It's not enough that a person with ordinary skill in the art could conclude that Williams could have claimed a cooker that utilized steam in conjunction with other heat sources, had he chosen to do so in his original application, nor is it enough, as the patent examiner evidently concluded, that, quote, "The claims seem to be for the same thing as in the original patent as well as the first reissue patent," close quotes.

That statement is not terribly confidence-building. It certainly doesn't give the appearance of any thorough analysis.

It must appear to someone skilled in the art that the '047 Patent did, in fact, cover a cooker utilizing nonsteam heating elements.

Now, there isn't anywhere in the '047 Patent or the patent application that you will find a suggestion that meats cooked in the claimed invention could be cooked with a heat source other than steam.

No, the claims, drawings, the preferred embodiment, the representation of the inventor to the Patent Office, all manifest a centrality of a dual steam system including an external, internal steam source providing steam-only cooking, and

nothing in the patent history manifests an objective intent to cover cookers utilizing nonsteam as well as steam sources.

Now this, I think, provides clear and convincing support for the contention that the '047 Patent does not support the enlargement.

Now, there is an affidavit by Dr. Titus, a sworn declaration, stating that the patent specifications would convey to a person with ordinary skill in the art that the patent supports the claim.

This is a conclusion that he then goes on to support, to attempt to support with something that doesn't to go the conclusions at all.

As I'll point out, Dr. Titus asked the wrong question and therefore gets an immaterial answer. It does -- his affidavit, in the Court's view, does not create a material issue of fact.

Now, Titus' declaration reveals that he reviewed the claims of the reissued patent and compared them with the '047 Patent, specifications, filing support of the supporting claims in the patent specifications. This doesn't focus on the relevant inquiry. And as I said, by asking -- by focusing -- asking the wrong question in terms of this comparison, he gets irrelevant conclusions.

He looked at each of the asserted claims to determine if they had support in the specifications, and he developed a chart. But the broadening of the '047 Patent was accomplished by removing prior restrictions, not by adding something to the coverage of the claim explicitly. In these circumstances, there will always be support in the specifications for the language of the broaden claims. Take, for example, the '047 limitation to ovens cooking solely with steam.

To enlarge this claim to cover ovens using nonsteam heat, Williams would have amended his claim to specify other ovens for which coverage was specifically intended, for example, gas and steam, infrared and steam, and so forth; or he could have replaced the "solely with" part.

Both amendments require that a coverage of ovens utilizing nonsteam heat be objectively disclosed in the '047 Patent. But Titus' analysis is only probative in the first approach -- in the first approach taken. And that event, Titus' approach would compare the expressed enlargement of the coverage with the relevant specifications.

But whereas here the second approach is taken, then the Titus methodology doesn't have any probative value. Any system that cooks solely with steam also cooks in part with steam. Thus, Titus' declaration only recites the obvious, namely that support in the specifications or claims requirement will also support the same claim, where the two requirements of the claim are subtracted.

In contrast, the relevant question for valid reissue is not whether the specifications support the claim language, but whether these specifications, viewed by one with ordinary skill in the art, disclosed the new subject matter covered by the language of the reissue claims.

On this question, the Titus declaration is moot. Nowhere does the Titus declaration match up specifications in the '047 Patent to an invention with nonsteam heating elements.

In his chart, he addresses the nonsteam heating element in only one respect. In addressing Claim 75 of the '259 Reissue Patent, Titus confronts the claim of a cooking system, quote:

> "including a heat source in addition to said steam providing means, said additional heat source

introducing an additional heat in the said housing for heating and, at least in part, cooking said products,"

close quotes.

Thus, the issue of specification support for extra heating element not expressly limited to steam is presented squarely, but the only example specification that he indicates supports this is Figure 1, which, of course, is for a steam, a steam source of additional heat. And heater (Number 41) is what he refers to, and that's part of the boiler on the floor of the cooker that heats the pool of water that provide an internal source of steam.

Thus, the specification support indicated or a second heating element is specifically for a steam producing heating element.

The relevant inquiry is whether one skilled in the art, reading a '047 Patent specification, would identify the subject matter of the new claims as invented and disclosed by the '047 Patent.

The subject matter of the new claims is an oven that cooks with steam, but not exclusively with steam. The Titus' declaration establishes at best the uncontradicted and rather obvious point that an invention cooking solely with steam a fortiori cooks in part with steam.

Nothing in this declaration addresses whether the '047 Patent would convey to someone skilled in the art that the invention, expressly limited solely to steam, in fact covers ovens utilizing steam in part to cook meat.

There is no discussion in there about the extent to which -- and we have been through this at some length, about the importance of preserving moisture in the meat and all the rest; nothing about that anywhere in here.

Stein has demonstrated in this Court's view that the reissue patent claims covered new matter that isn't covered.

Now, there is a conclusion in the Titus -- there is the correct conclusion, but it's not supported by any analysis, and therefore I don't give it any weight, in any event, that's an alternative conclusion to the first conclusion, which was that this, the error sought to be corrected in this reissue, in the Court's view, are not, are not subsumed or encompassed in Section 251. But for both alternative reasons, the claim are invalid.

Now, in the circumstances, that would seem to the Court to end this matter. If the Court -- and it seems, while we have already started the trial, if the Federal Circuit concludes that this Court is mistaken in this regard, then we will nonetheless have moved along some distance toward getting the matter tried, in the sense that the preliminary instructions are done, the Markman -- and indeed the Court has already ruled on the Markman issue. And let me make clear that I ruled in the plaintiff's favor not only with respect to high humidity steam, but also on the means/function issues.

So, if there is to be an appeal, Mr. De La Garza, you may want to put that matter to the Federal Circuit, so that if I erred in that regard, then it can come back with some instructions to the Court to proceed.

ATTORNEY DE LA GARZA: We will indeed do that, your Honor, if it is appealed.

THE COURT: Now, it is always up to the parties to resolve this matter. It seems to me you used to do business together.

ATTORNEY DE LA GARZA: Yes, your Honor.

THE COURT: And sensible people can do business again. But of course, you are not the only defendant. I guess there are other suits against other entities that I don't know anything about and that aren't before me.

In any event, whatever happens, I think that the effort that the parties, if the matter is returned for trial, the effort the parties have made to prepare this matter for trial will have, will allow us to go promptly to trial again.

* * * *

THE COURT: If I have made an error and the case is returned, I will look forward to trying the case again.

* * * *

APPENDIX E

Fiscal Year 1997

A Patent and Trademark Office Review

Creating a Patent and Trademark System for the 21st Century

Table 2.
Patent Applications Filed
(FY 1978-1997)

Year	Utility[1]	Design	Plant	Reissue	Total
1978	100,473	7,440	171	660	108,744
1979	99,516	7,070	166	657	107,409
1980	104,219	7,269	186	641	112,315
1981	106,828	7,197	147	538	114,710
1982	116,052	8,069	193	486	124,800
1983	96,847	8,256	281	370	105,704
1984	109,010	8,446	248	281	117,985
1985	115,893	9,504	244	290	125,931
1986	120,988	9,792	291	332	131,403
1987	125,677	10,766	364	366	137,173
1988	136,253	11,114	377	439	148,183
1989	150,418	11,975	418	495	163,306
1990	162,708	11,140	395	468	174,711
1991	166,765	10,368	414	536	178,083
1992	171,623	12,907	335	581	185,446
1993	173,619	13,546	362	572	188,099
1994	185,087	15,431	430	606	201,554
1995	220,141	15,375	516	647	236,679
1996	189,979	15,160	564	573	206,276
1997	**219,453**	**16,272**	**714**	**606**	**237,045**

[1] Chemical, electrical, and mechanical applications.

Table 6.
Patents Issued[1]

(FY 1978 - FY 1997)

Year	Utility[2]	Design	Plant	Reissue	Total
1978	65,963	3,797	194	366	70,320
1979	51,686	3,269	151	312	55,418
1980	56,618	4,167	137	305	61,227
1981	66,617	3,882	168	343	71,010
1982	59,449	5,299	120	284	65,152
1983	54,744	4,401	219	351	59,715
1984	66,753	4,935	174	287	72,149
1985	69,667	5,058	277	300	75,302
1986	71,301	5,202	227	263	76,993
1987	82,141	6,158	240	254	88,793
1988	77,317	5,740	283	244	83,584
1989	95,831	5,844	728	309	102,712
1990	88,974	7,176	295	282	96,727
1991	91,822	9,386	318	334	101,860
1992	99,405	9,612	336	375	109,728
1993	96,676	9,946	408	302	107,332
1994	101,270	11,138	513	347	113,268
1995	101,895	11,662	390	294	114,241
1996	104,900	11,346	338	291	116,875
1997	**111,979**	**10,331**	**400**	**267**	**122,977**

[1] Excludes withdrawn numbers.
[2] Includes chemical, electrical, and mechanical applications.

APPENDIX F

COMMENTARY ON THE NEW PATENT ACT

P.J. FEDERICO
Examiner-in-Chief, U.S. Patent Office

Author's Note. After the new patent act [this title] was approved the writer was called upon to address various patent groups for the purpose of acquainting them with the details of the new law and with the revisions in the procedure of the Patent Office made in consequence thereof. These talks ranged from several series of three or four lectures covering the entire act in detail to single shorter ones of a more general nature or dealing with only particular phases of the act. The talks before the Los Angeles Patent Law Association, the Patent Law Association of Chicago, the New York Patent Law Association, the Patent Section of the American Bar Association and the American Patent Law Association were recorded and transcribed. The present essay is a consolidation and revision of these various transcriptions, with some condensation and a certain amount of added material.

While patents are creatures of statute, the entire body of patent law is much fuller than the statute itself, including a vast amount of case material on subjects such as invention and infringement which are dealt with by the statute only in general terms. Consequently a discussion of the statute alone cannot be a complete dissertation on patent law. Moreover, a treatment of a new act such as this will necessarily dwell on changes introduced by the new act at greater length than would ordinarily be warranted by the subject matter of some of the changes. This paper should be considered only as a survey of the patent statute, with the main objective of pointing out the changes which have been made by the new act. In such an extended discussion it is obviously impossible

to avoid expressions, either consciously or unconsciously, of personal opinion and it should be understood that the paper contains some opinions and views of the writer even though not always labeled as such.

It must be emphasized that any views or opinions expressed are not necessarily the views of the office in which the writer is employed or of any of its officials.

INTRODUCTION

Prior Patent Acts

For the first time since 1870 [Act July, 1870, c. 230, 16 Stat. 198], the patent statutes have been completely rewritten, by the statute approved July 19, 1952 [this title] which came into force on January 1, 1953. Before describing this new statute and its provisions, something will be said of the prior acts and of the manner in which the new act came about.

The patent laws are enacted by Congress in accordance with the power granted by the eighth clause of Section 8 of Article I of the Constitution, which provides that:

"The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive right to their respective writings and discoveries."

* * * *

Amendment and Correction of Patents (Chapter 25)

Reissues (section 251). An issued patent can be amended or corrected in several different ways, the most important of which is by reissue, which is the grant of a new patent to replace the original patent for the balance of its unexpired term. Sections 251 and 252 are derived from one section of the former law dealing with reissues and make a

number of changes and additions; section 251 deals with the conditions under which a reissue may be obtained and section 252 deals with the effect of a reissue.

The old statute provided that "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent." A number of changes have been made in this language. First, the phrase "if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention" has been replaced by "through error without any deceptive intention." There is no indication in the printed record that this change in language was intended to effect any change in substance and, since the old phrase was usually rather liberally construed, except when the reissue sought to recapture claims cancelled during the prosecution of the original patent, this question would be of minor significance except in connection with the situation mentioned. As to this situation there would be a large body of precedent to overcome, but one commentary urges that there is a liberalization in this respect.

The next change to which attention is directed is the insertion of the words "or less" in the phrase which in the new statute reads "by reason of the patentee claiming more or less than he had a right to claim in the patent." The old statute had been interpreted and applied so as to permit a patentee to

claim more in a reissue than he had claimed in the original patent, that is, to correct the error of having claimed less than he had a right to claim and so broaden the patent, and the new statute so provides explicitly.

While the old statute stated that the patent is reissued "for the same invention," the new statute states that the patent is reissued "for the invention disclosed in the original patent." Here, again, there is no indication in the printed record that any change was intended, although a slight broadening effect has been argued.

In the old statute, one of the grounds of reissue was stated to be "a defective or insufficient specification" whereas the expression in the new statute is "a defective specification or drawing," but the room for correction here is not very great since new matter cannot be introduced. In the clause prohibiting the introduction of new matter, a provision relating to models and drawings has been omitted as obsolete.

A new provision has been added permitting the assignee of a patent to apply for a reissue provided the reissue does not seek to enlarge the claims of the original patent.

While the old statute began with the word "Whenever" and no time limitation was expressed, the courts developed a rule of laches according to which a broadened reissue could not be applied for more than two years after the grant of the original patent except under extraordinary circumstances excusing the delay, and the delay was seldom excused. This rule of laches had been applied in a few instances when the delay was less than two years, and since 1939, when the former public use period of two years which served as an analogy for the time under the laches rule, was changed to one year, the period of laches has been taken as one year in some cases. The new statute enacts a fixed period of two

years from the grant of the original patent, within which to apply for a reissue "enlarging the scope of the claims of the original patent." Such a reissue cannot be obtained on an application filed more than two years after the date of the original patent, and presumably is timely if applied for within two years as far as the reissue requirements are concerned. The statute does not define a broadened reissue, or a reissue which enlarges the scope of the claims of the original patent, but the cases indicate that the general rule is that if a claim of a reissue can hold something as an infringement which would not be an infringement of any of the claims of the original patent (not considering the validity of such claims), then the particular claim of the reissue enlarges the scope of the claims of the original patent, and that a claim is broadened if it is broadened in any respect.

Effect of reissue, intervening rights (section 252). The first paragraph of section 252 on the effect of a reissue is a restatement of the corresponding portion of the old statute, but the second paragraph is a new provision dealing with the protection of intervening rights in reissues. The term intervening rights in reissues is used to refer to situations such as may be illustrated by the following example: assume that a patent has been obtained for a machine, that someone else makes or otherwise acquires a machine which does not infringe the patent, and that the patentee thereafter obtains a reissue of the patent with broadened claims which are infringed by the existing machine of the intervenor. The problems have been concerned with whether or not the continued use of the machine by the intervenor after the grant of the reissue should be held liable for infringement, and if not on what basis. From the time of the first reissue statute in 1832 up to the present patent act there have been three successive different treatments of situations such as that mentioned. During the first period the intervenor was held

liable as an infringer, literally applying the language of the statute which in its present from reads that the "reissued patent shall have the same effect and operation in law, on the trial actions for causes thereafter arising, as if the same had been originally granted in such amended form"; the continued use of a machine, or the sale thereof, would be a cause of action thereafter arising. During the second period, the reissue would be held invalid if the intervening rights situation were present, the invalidity not always being grounded on this fact, however. During the third period, the patent would not be held invalid (unless invalid for some other reason) but the intervenor would be excused from liability for infringement. The cases during this third period are somewhat confusing, there is no sharp point of demarcation from the preceding period and the reasoning is not always very logical.

The second paragraph of section 252 is not entirely a codification of the case law relating to the protection of the intervening rights since it varies in some respects from the case law and should be considered on its own terms. The paragraph provides that the reissued patent shall not abridge or affect certain rights of those who acted before the reissue was granted when certain conditions are present. First it should be noted that the critical date is the date of the grant of the reissue. If the intervenor has acted before the grant of the reissue he is protected under the circumstances mentioned in the statute. It is immaterial how long before the date of the reissue he started, if he started before the grant of the original patent he is still protected by the language of the statute. The statute gives a simple test for determining when intervening rights cannot be present and this is whether claims of the original patent which are repeated in the reissue are infringed. If the reissued patent has valid claims in it which were also in the original patent, and these claims are infringed, then the question of intervening rights cannot arise. The question of

intervening rights can only arise when the only claims infringed are claims of the reissued patent which were not in the original patent. This test is very simple to apply, especially since the specifications of reissued patents for some time have been printed in such a manner as to show which claims are repeated from the original patent; if the defendant infringes repeated original claims he is liable for infringement, if he does not infringe repeated original claims but infringes only new or amended claims, then the question of intervening rights may be raised. This test not only applies in the case of broadened reissues, but it extends the protection of intervening rights to so-called narrowed reissues which marks another departure from the case law. Assume an original patent with a broad claim which might have been infringed in terms, and a reissue which omits this broad claim and contains a new narrower claim which is infringed by the intervenor, he will be protected under the statute since he does not infringe a repeated original claim.

With respect to the character of protection, the new statute provides two different degrees of protection, one is absolute and the other is within the discretion of the court. The specific things made before the date of the reissue, which infringe the new reissue claims, are absolutely free of the reissued patent and may be used or sold after the date of the reissue without regard to the patent; in the language of the statute, the reissued patent shall not abridge or affect the right of any person "to continue the use of, or to sell to others to be used or sold, the specific thing" made, used or purchased prior to the grant of the reissue. This absolute protection extends only to the specific objects actually made before the grant of the reissued patent and does not extend to the making of additional objects of identical or like kind. With respect to the latter the court is given discretion to act. When the specified conditions obtain, the court has the power to permit

(1) continuation of the manufacture of things made before the grant of the reissue (that is, the manufacture of additional objects), and their use or sale, (2) the continued manufacture, use or sale when substantial preparation was made before the grant of the reissue, and (3) the continued practice of a process patented by the reissue practiced, or for the practice of which substantial preparation was made, before the grant of the reissue. This power is to be exercised to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

* * * *

APPENDIX G

Manual of PATENT EXAMINING PROCEDURE

Original Sixth Edition, January 1995
Latest Revision July 1997

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

1412.02 Recapture of Canceled Subject Matter [R-2]

A reissue will not normally be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent *>*Ball Corp* v. *United States*, 729 F.2d 1429, 221 USPQ 289, 295 (Fed. Cir. 1989); <*In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). **>;< *In re Richman*, 161 USPQ 359, 363, 364 (CCPA 1969); * *In re Wadlinger*, **181 USPQ 826 (CCPA 1974). As *>stated< by the * >Federal Circuit < in *Ball***>:<

> The recapture rule bars the patentee from acquiring, through reissue claims that are of the *same or broader scope* than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent.

See MPEP § 1412.03

> A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C.

103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b) without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). <

Supreme Court, U.S.
FILED
SEP 17 1998
OFFICE OF THE CLERK

(2)

No. 98-239

In the Supreme Court of the United States

OCTOBER TERM, 1998

HESTER INDUSTRIES, INC., PETITIONER,

v.

STEIN, INC., RESPONDENT.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

L. GENE SPEARS
Arnold, White & Durkee
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1611

STEPHEN M. SHAPIRO
Counsel of Record
JEFFREY W. SARLES
Mayer, Brown & Platt
190 South LaSalle Street
Chicago, Illinois 60603
(312) 782-0600

CHARLES H. DE LA GRAZA
Arnold, White & Durkee
4850 First Bank Place
601 Second Avenue South
Minneapolis, Minnesota 55402
(612) 321-2800

Counsel for Respondent

32 pp

QUESTION PRESENTED

In a unanimous opinion, the Federal Circuit affirmed the district court's holding that petitioner did not comply with the "error" provision of the reissue statute (35 U.S.C. § 251) when it applied for (and obtained) a reissue patent broadened to obtain coverage of subject matter surrendered during original prosecution. The Federal Circuit's opinion decided an issue of first impression that raises no conflicts for this Court to resolve, cited only Federal Circuit precedent, and identified no points of disagreement, either with Federal Circuit precedent or with precedent of this Court.

The question presented is as follows:

Whether the 1952 Patent Act defined the standard for error correctable by reissue so as to permit petitioner to recapture subject matter surrendered through dozens of arguments advanced in multiple submissions to the Patent & Trademark Office.

LIST OF PARTIES AND RULE 29.6 STATEMENT

The parties to the proceeding in the United States Court of Appeals for the Federal Circuit were petitioner Hester Industries, Inc., and respondent Stein, Inc. For purposes of Rule 29.6, the respondent states that it is the wholly-owned subsidiary of FMC Corporation.

TABLE OF CONTENTS

QUESTION PRESENTED i

LIST OF PARTIES AND RULE 29.6 STATEMENT ii

STATUTE INVOLVED 1

STATEMENT OF THE CASE 1

A. Argument, Amendment, And Cancellation . . . 2

B. Hester's Invention And Original Patent 3

C. Hester's Reissued Patents 5

D. The District Court's Decision 6

E. The Federal Circuit's Affirmance 8

REASONS FOR DENYING THE PETITION 10

I. THE FEDERAL CIRCUIT'S DECISION DOES NOT CONFLICT WITH THE 1952 PATENT ACT 11

A. This Court Has Repeatedly Found No Correctable "Error" In Cases With No Claim Amendment Or Cancellation 13

B. Federico's Commentary Does Not Create A Conflict Between The 1952 Patent Act And The Federal Circuit's Decision 15

C. The Federal Circuit Has Consistently Found No Correctable "Error" Where Claims Were Not Abandoned Or Amended 16

D. The Federal Circuit's Decision Does Not Conflict With 35 U.S.C. § 252 18

II. THERE IS NO "CONFLICT" BETWEEN THE FEDERAL CIRCUIT AND THE PTO . . . 19

III. THIS CASE RAISES NONE OF THE ISSUES DECIDED IN *WARNER-JENKINSON* . . . 20

CONCLUSION 23

TABLE OF AUTHORITIES

Cases: **Page:**

Alpex Computer Corp. v. *Nintendo Co.*, 102 F.3d 1214 (Fed. Cir. 1996), cert. denied, 117 S. Ct. 2480 (1997) 22

Black v. *Cutter Labs.*, 351 U.S. 292 (1956) 21

Bonito Boats, Inc. v. *Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) 10

Byers, In re, 230 F.2d 451 (C.C.P.A. 1956) 13

Chevron U.S.A., Inc. v. *NRDC*, 467 U.S. 837 (1984) 21

Clement, In re, 131 F.3d 1464 (Fed. Cir. 1997) . . . 8, 9

Cole v. *Kimberly-Clark Corp.*, 102 F.3d 524 (Fed. Cir. 1996), cert. denied, 118 S. Ct. 56 (1997) 23

Coon v. *Wilson*, 113 U.S. 268 (1885) 14, 15, 16

Crawford v. *Heysinger*, 123 U.S. 589 (1887) 21

Gage v. *Herring*, 107 U.S. 640 (1883) . . 14, 15, 16, 21

Grant v. *Raymond*, 31 U.S. (6 Pet.) 218 (1832) 12

Gustafson v. *Alloyd Co.*, 513 U.S. 561 (1995) 16

Hewlett-Packard Co. v. *Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989) 17, 18

James v. *Campbell*, 104 U.S. 356 (1882) 13, 14

Lemelson v. *General Mills, Inc.*, 968 F.2d 1202 (Fed. Cir. 1992) 22

Mahn v. *Harwood*, 112 U.S. 354 (1884) 19

Markman v. *Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996) . . 10

Markman v. *Westview Instruments*, 517 U.S. 370 (1996) 2

Mentor Corp. v. *Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993) 9, 22

Newton v. *Furst & Bradley Mfg. Co.*, 119 U.S. 373 (1886) 14, 15, 16

Orita, In re, 550 F.2d 1277 (C.C.P.A. 1977) 13

Rite-Hite Corp. v. *Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995) 10

Shepard v. *Carrigan*, 116 U.S. 593 (1886) 21

Sontag Chain Stores Co. v. *National Nut Co.*, 310 U.S. 281 (1940) 18

Southwall Technologies, Inc. v. *Cardinal IG Co.*, 54 F.3d 1570 (Fed. Cir. 1995) 23

Standard Oil v. *American Cyanamid Co.*, 774 F.2d 448 (1985) 23

Texas Instruments, Inc. v. *United States Int'l Trade Comm'n*, 988 F.2d 1165 (Fed. Cir. 1993) . 9, 21, 23

U.S. Indus. Chem., Inc. v. *Carbide & Carbon Chem. Corp.*, 315 U.S. 668 (1942) 10

United States v. *Texas*, 507 U.S. 529 (1993) 16

Warner-Jenkinson Co. v. *Hilton Davis Chem. Co.*, 117 S. Ct. 1040 (1997) 20, 22

Weiler, In re, 790 F.2d 1576 (Fed. Cir. 1986) . . 13, 17, 18

Wisniewski v. *United States*, 353 U.S. 901 (1957) 11

Statutes and Regulations:

35 U.S.C. § 102 2

35 U.S.C. § 103 2

35 U.S.C. § 111 2

35 U.S.C. § 112 2

35 U.S.C. § 251 . . . . . *passim*

35 U.S.C. § 252 18

37 C.F.R. § 1.51 2

37 C.F.R. § 1.75 2

37 C.F.R. § 1.104 2

37 C.F.R. § 1.104(a)(1) 2

37 C.F.R. § 1.104(c)(2) 2

37 C.F.R. § 1.111(b) 2

37 C.F.R. § 1.111(c) 2

37 C.F.R. § 1.175 . . . . . 6, 20

Patent Act of July 3, 1832, Ch. 162, 4 Stat. 559, § 3 . . 12

Patent Act of July 4, 1836, Ch. 357, 5 Stat. 117, § 13 . 12

Patent Act of July 8, 1870, Ch. 230, 16 Stat. 198, § 53 12

Patent Act of May 24, 1928, Ch. 730, 45 Stat. 732, § 4916 12

Miscellaneous:

Commentary to PTO Revision of 37 C.F.R. § 1.175, printed in 54 Pat. Trademark & Copyright J. (BNA) 544 (Oct. 16, 1997) 20

H.R. Rep. No. 312, 97th Cong., 1st Sess. (1981) . . . 10

S. Rep. No. 275, 97th Cong., 1st Sess. (1981) 10

Respondent Stein, Inc. ("Stein") respectfully requests that this Court deny the petition for a writ of certiorari seeking review of the Federal Circuit's decision in this case.

STATUTE INVOLVED

The only rule of decision applicable to this case is the prohibition against recapture during reissue proceedings of subject matter surrendered during original prosecution. This recapture rule is derived from the statutory requirement that reissue be sought solely for the correction of error, which is codified at 35 U.S.C. § 251:

> Whenever any patent is, *through error without any deceptive intention*, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. (Emphasis added.)

STATEMENT OF THE CASE

Hester's petition challenges the Federal Circuit's application of the recapture limitation on the scope of correctable error to the specific facts and circumstances of Hester's prosecution of its original patent (U.S. Patent No. 4,582,047) and two reissue patents (U.S. Patent Nos. Re. 33,510 and Re. 35,259) before the Patent & Trademark Office (PTO). Specifically, Hester argues that the Federal Circuit erred in holding "that the recapture doctrine is not limited to claim amendments but also encompasses attorney arguments alone without any claim amendments." Pet. 8.

That argument touches upon narrow issues of patent prosecution practice and procedure before the PTO, for which some background is essential to a full understanding of the decisions below.

A. Argument, Amendment, And Cancellation

The patenting process begins with the filing in the PTO of a patent application, which includes (except in the case of provisional applications) one or more claims that "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention or discovery." 35 U.S.C. §§ 111, 112; 37 C.F.R. §§ 1.51, 1.75. Once approved by the PTO examiner and issued as a patent, the claims define the legal scope of the patentee's exclusive right. See *Markman* v. *Westview Instruments*, 517 U.S. 370 (1996). The PTO examiner is expected to "make a thorough study" of the application and "a thorough investigation of the available prior art relating to the subject matter of the claimed invention." 37 C.F.R. § 1.104. If the invention is not considered patentable as claimed, the examiner must reject the claim. 37 C.F.R. § 1.104(a)(1). When that rejection is based upon failure of the invention to comply with the novelty (35 U.S.C. § 102) and nonobviousness (35 U.S.C. § 103) provisions of the patent statute, the examiner "must cite the best [prior art] references at his command" and clearly explain the pertinence of each reference to each rejected claim. 37 C.F.R. § 1.104(c)(2). The applicant may respond with *argument* that "distinctly and specifically points out the supposed errors in the examiner's action." 37 C.F.R. § 1.111(b). The applicant may *amend* the claim(s) and "show how the amendments avoid such references or objections." 37 C.F.R. § 1.111(c). The applicant may *cancel* rejected claim(s), so that those claim(s) which are not rejected may issue in a patent. By these three devices—argument, amendment, and cancellation—the PTO

examiner and the patent applicant define what the patent should cover, and what it must exclude.

These principles may be illustrated through the example of a novel three-legged chair, fully described in a patent application for which chairs of the four-legged variety are prior art. The applicant may arrive at a patent claiming a three-legged chair (and surrendering coverage of four-legged chairs) through amendment, cancellation, or argument. In the first instance, the applicant claims "chairs," but amends the claim to recite "three-legged chairs" when the PTO examiner rejects the claim, citing the four-legged chairs of the prior art. In the second instance, the applicant specifies "chairs" in one claim and "three-legged chairs" in another, but cancels the broader first claim in response to the same rejection. In the third instance, the applicant claims only "three-legged chairs" and then argues for patentability over four-legged chairs without need to amend or cancel a claim. In each instance, the result is the same—limited coverage of three-legged chairs with a surrender of coverage for four-legged chairs. Hester asks this Court to find that Congress, in enacting the 1952 Patent Act, defined the recapture limitations on correctable "error" so as to include surrenders of the first and second sort, but to exclude surrenders of the third sort. Nothing in the 1952 Patent Act or its legislative history indicates that Congress intended or accomplished that result.

B. Hester's Invention And Original Patent

Hester's invention relates to industrial cookers. In the late 1970s, Charles Williams, the sole inventor named on the patents asserted in this case, bought from the Certified Manufacturing Company a steam cooker that employed a spiral conveyor to carry through its housing the products to be cooked. This Certified cooker provided steam inlets to be attached to an external steam source, which Williams

attached to that cooker after it was delivered to Hester. Williams later modified the Certified cooker to include a second steam source. This second steam source was inside of the cooker housing and included a heat exchanger in a water pan located at the bottom of the Certified cooker. Thus, the physical embodiment of the invention that Williams developed (as distinguished from the one purchased from Certified) employed two sources of steam (one internal and one external) and no other source of cooking heat.

Williams' modifications of the Certified cooker were the basis of a patent application that Hester filed on July 26, 1979. It issued on April 15, 1986, as U.S. Patent No. 4,582,047—the original patent that was ultimately reissued as the patents asserted in this case. The '047 patent highlighted the advantages of using two sources of steam, and emphasized that cooking solely with steam was an essential feature of Hester's cooker: "[t]he cooking is solely with water droplet free steam near 100° C and 100% humidity at a pressure above atmospheric." Consistent with what Williams actually worked with and disclosed in his patent application, Hester presented for examination a single independent claim (along with several dependent claims), which required cooking solely with steam from two sources. Pet. App. 4a-5a.

The examiner rejected Hester's original claims because they claimed subject matter that was obvious in light of prior art patents that disclosed steam cookers using one source of steam, including U.S. Patent Nos. 3,736,860 (to Vischer) and 2,011,247 (to Jourdan). Hester responded to these rejections by emphasizing on numerous occasions over a period of three years that its cooker was patentable over this (and other) prior art because it (1) employs two distinct steam sources, and (2) cooks solely with steam. The first limitation was urged at no less than 15 places in at least five

papers Hester submitted to the PTO; the second was urged at no less than 27 places in six papers. Pet. App. 21a-22a. In a reply brief submitted to the PTO Board of Patent Appeals on appeal from the examiner's final rejection of its claims, Hester explained that these two features of its invention interact to provide a "synergy" that is "novel and nowhere suggested in any of the cited art." *Id.* at 8a.

Based on these explicit representations as to what Hester actually invented, the PTO Board of Patent Appeals reversed the examiner's rejections and allowed the original patent to issue. The Board's decision identifies the "two steam source" and "steam only" cooking features of Hester's invention as the basis for its patentability:

> [We] find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.

Pet. App. 8a. Hester was issued U.S. Patent No. 4,582,047 on April 15, 1986. The claims of the '047 Patent are limited to cooking solely with two sources of steam.

C. Hester's Reissued Patents

Hester sought reissue to broaden the claims in its original patent to cover Stein's cooker. Williams and Hester were prompted to evaluate their patent position when they learned in 1988 that Stein was developing a steam cooker that employed a spiral conveyor. Hester's litigation counsel advised Hester that its original patent may not cover systems such as Stein's that used a non-steam source in conjunction

with a source of steam (or only a single steam source) to heat and cook food products. Pet. App. 41a. To sue Stein, Hester needed a much broader patent. Because Hester could not file a new application to ensnare Stein's ovens, Hester attempted to accomplish the same result through reissue of its original patent.

On April 15, 1988, Hester filed an application for reissue of the '047 Patent, which led to both of the reissue patents that Hester asserted in this case. Then-applicable regulations of the PTO obliged Hester to support this application with an oath that distinctly specifies each excess or insufficiency in the claims and particularly specifies "the errors relied upon, and how they arose or occurred." 37 C.F.R. § 1.175. To comply with that requirement, Hester tendered an oath of its inventor acknowledging that the claims of his original patent were limited to cooking solely with steam from two sources and announcing his desire to correct this "oversight." Pet. App. 42a. To comply with the statutory requirement of showing that these deficiencies arose through "error," Williams offered only a bare averment that these defects were due to "the failure of patent attorney Lawrence R. Brown to appreciate the full scope of [his] invention." *Ibid.* Hester submitted nothing from Mr. Brown to corroborate Williams' hearsay speculation as to Mr. Brown's alleged failure "to appreciate the full scope" of Williams' cooker. Pet. App. 51a.

D. The District Court's Decision

On the basis of the undisputed public record of Hester's original prosecution, Stein moved for summary judgment declaring that each of the asserted claims of Hester's patent is invalid under 35 U.S.C. § 251. Stein's motion urged two distinct bases for invalidity under § 251—want of reissue "error" and failure to claim the invention disclosed in the original patent. Stein's summary judgment motion was

denied by Judge James Cacheris on January 3, 1997, on the basis of "fact issues" that Hester contended were raised by a declaration of its technical expert. Two months later, in argument on a motion in limine to exclude all reference to the original prosecution, Hester urged the judge assigned to try the case (T.S. Ellis) that he could evaluate the sufficiency of Stein's § 251 defenses as a matter of law. Judge Ellis permitted Stein to reargue its motion, accepted briefing on the issue, and then ruled in Stein's favor in a bench opinion rendered on March 25, 1997. Pet. App. 62a-80a. The bench opinion was reduced to a written opinion on May 6, 1997. *Id.* at 31a-61a. Judge Ellis found that each of Hester's asserted claims is invalid for failure to satisfy both the "error" and the "original invention" requirements of § 251.

Acknowledging the liberal construction that must be afforded the reissue statute, Judge Ellis concluded that not everything that might be labeled "error" is correctable through reissue. Pet. App. 39a. Although an attorney's failure to appreciate the scope of an invention might be a sufficient basis for reissue error, Judge Ellis found that the patent record conclusively refuted such a position in this case. *Id.* at 42a-43a. Noting that the steam source limitations at issue involve straightforward language "featured prominently in the patent," Judge Ellis determined that they must have been the product of deliberate choice, not error. *Id.* at 44a. This conclusion was further supported by an extensive review of the prosecution record, which was found to "refute any conclusion that the limitation of the 047 patent to ovens cooking solely with steam from two steam sources resulted from patent counsel's failure to appreciate the scope of Williams' invention." *Id.* at 50a.

E. The Federal Circuit's Affirmance

The Federal Circuit affirmed the district court's judgment and ruled that Hester's patents failed to satisfy the "error" requirement of § 251. Pet. App. 26a. The basis for this conclusion differed from that advanced by the district court. The Federal Circuit found that Hester's conduct in reissue was "addressed most squarely by the 'recapture rule'" which was presented to the district court among Stein's arguments for invalidity, but not expressly addressed by the district court. *Id.* at 17a. Citing its own precedent, the Federal Circuit summarized the recapture rule as one which "prevents a patentee from regaining through reissue * * * subject matter that he surrendered in an effort to obtain allowance of the original claims." *Ibid.* The court explained that this rule is rooted in the "error" requirement of 35 U.S.C. § 251 in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. *Ibid.* Hester's petition does not question the court's formulation of the "recapture" limitation on reissue "error." That formulation is supported by extensive Federal Circuit precedent—precedent that has not drawn a single dissent in the panels that have produced it.

In applying the recapture rule to the facts of this case, the Federal Circuit followed the two-step analysis set forth in *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997). The first step of that analysis is to determine in what respects a reissue claim is broader than the original patent claims. The second is to determine whether the broadened aspects of the reissue claims relate to subject matter that was surrendered during original prosecution. Pet. App. 18a. As to the first step, the court found no dispute "that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the 'solely with steam' and 'two sources of steam' limitations found in each of the original

patent claims." *Id.* at 18a. That finding is not challenged in Hester's petition.

Turning to the second question, the court acknowledged that its decisions finding impermissible recapture involved claim amendments or cancellations, but reasoned that "[a]rguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender." Pet. App. 19a. The court found (and Hester agrees) that this issue was one of first impression. To resolve that question, the court cited (1) previous cases (*Clement* and *Mentor Corp.* v. *Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993)) that relied upon arguments made in combination with claim amendments as evidence of surrender; (2) the policy of the recapture rule, which prevents the reissue statute from being "construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so"; and (3) the similarity of the recapture rule to prosecution history estoppel, which (under Federal Circuit precedent) "can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art." Pet. App. 19a-21a.[1/] The court concluded that "in a proper case, a surrender can occur through arguments alone." *Id.* at 21a. Citing Hester's multiple assertions that

---

[1/] The Federal Circuit cited *Texas Instruments, Inc.* v. *United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174 (Fed. Cir. 1993), in which it held that "[a]mendment of a claim in light of a prior art reference * * * is not the *sine qua non* to establish prosecution history estoppel. Unmistakable assertions made by the applicant to the Patent and Trademark Office (PTO) in support of patentability, whether or not required to secure allowance of the claim, also may operate to preclude the patentee from asserting equivalency between a limitation of the claim and a substituted structure or process step."

the "two sources of steam" and "solely with steam" limitations distinguished the claimed invention from prior art, the Federal Circuit found that "Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations." *Id.* at 22a.

The panel decision was unanimous. Other than questioning the continued authority of *U.S. Indus. Chem., Inc.* v. *Carbide & Carbon Chem. Corp.*, 315 U.S. 668 (1942), on an issue separate from that identified in Hester's petition, it neither declined to follow nor disagreed with its own precedent or any precedent of this Court. Notwithstanding the Federal Circuit's practice of *sua sponte* granting *en banc* rehearing of cases that present controversial issues,[2/] no such rehearing was ordered here. Nor was it sought by Hester.

REASONS FOR DENYING THE PETITION

The question presented raises no issue of general significance and the holding below conflicts with no decision of this Court or any other court. The question involves application of a specialized rule of patent law to very specific facts (*viz.* to the 42 arguments made by petitioner in six PTO submissions). The court which issued this holding was created by Congress "to provide nationwide uniformity in patent law." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989) (quoting H.R. Rep. No. 312, 97th Cong., 1st Sess. 20 (1981)); see also S. Rep. No. 275, 97th Cong., 1st Sess. 3-6 (1981) (Federal Circuit created to provide "definitive" answers to patent questions so as to relieve burden of this Court). The Federal Circuit's opinion

---

[2/] See *Rite-Hite Corp.* v. *Kelley Co.*, 56 F.3d 1538, 1542 (Fed. Cir. 1995); *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 970 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996).

in this case advances the cause of uniformity. It reflects no intra-circuit divergence of opinion among the judges of the Federal Circuit, and conflicts with no precedent of this or any other court.[3/]

Hester argues that the Federal Circuit's decision in this matter conflicts with (1) the 1952 codification of the Patent Statute and (2) the PTO's current examination practice. In making these arguments, Hester disregards the plain language of the statute and the most pertinent precedent of both this Court and the Federal Circuit. Hester also ignores the current examination practice of the PTO and the role of the federal courts in reviewing PTO determinations of patentability. The Federal Circuit violated no rule of law when it found that Hester failed to satisfy the error requirement of § 251. That decision was a permissible exercise of the power granted by Congress when it created the Federal Circuit and vested it with exclusive appellate jurisdiction in patent matters.

I. THE FEDERAL CIRCUIT'S DECISION DOES NOT CONFLICT WITH THE 1952 PATENT ACT.

Based upon a misreading of a single phrase of commentary (not legislative history) relating to the 1952 Patent Act, Hester contends that there is no bar to the reissue of patents except when claims were amended or abandoned during original prosecution. Pet. 19. But there is nothing in the language of § 251 that draws any distinction between claims that were amended or canceled and claims that were not.

[3/] Even if there were an intra-circuit conflict, the Federal Circuit sitting *en banc* would be fully capable of resolving it without the intervention of this Court. See *Wisniewski* v. *United States*, 353 U.S. 901, 902 (1957) ("[i]t is primarily the task of a Court of Appeals to reconcile its internal difficulties"), and n.2, *supra*.

And there is nothing in the text of § 251 that suggests a patentee may recover subject matter surrendered by argument, as opposed to subject matter surrendered by cancellation or amendment. To support its reading of the statute, Hester's petition relies not on the text of the statute, but on phantom "intent" never expressed in the legislative history. Review of the history of reissue practice, of the relevant legislative enactments, of the precedent of this Court (and the Federal Circuit), and of the commentary relied upon by Hester exposes Hester's proposed rule as pure fiction.

The history of reissue practice begins with *Grant* v. *Raymond*, 31 U.S. (6 Pet.) 218 (1832), in which this Court approved the Secretary of State's decision to reissue an asserted patent, notwithstanding the absence (at that time) of any express statutory authority for such reissue. This Court found that the Secretary's reissue to correct "inadvertent error" gave effect to the "object and intention" of the patent act, and did not depart "from the spirit and character of the act." *Id.* at 243. Following this Court's lead, Congress promptly amended the patent statute to authorize reissue to correct "invalid or inoperative" patents that were obtained through "inadvertence, accident or mistake." Patent Act of July 3, 1832, Ch. 162, 4 Stat. 559, § 3. Language limiting reissue to correction of "error * * * by inadvertence, accident, or mistake" was employed in subsequent codifications of the patent laws in 1836, 1870, and 1928.[4/]

The 1952 codification of the patent laws replaced this language with reference to "error without any deceptive intention." 35 U.S.C. § 251. Although this Court has not addressed the validity of a reissued patent since that codifica-

---

[4/] Patent Act of July 4, 1836, Ch. 357, 5 Stat. 117, § 13; Patent Act of July 8, 1870, Ch. 230, 16 Stat. 198, § 53; Patent Act of May 24, 1928, Ch. 730, 45 Stat. 732, § 4916.

tion, the Federal Circuit (and its predecessor, the Court of Customs and Patent Appeals) has held that there is no difference between the "error without any deceptive intention" language of the 1952 Patent Act and the "inadvertence, accident, or mistake" language of the prior enactments. *In re Weiler*, 790 F.2d 1576, 1582 (Fed. Cir. 1986); *In re Orita*, 550 F.2d 1277, 1281 (C.C.P.A. 1977); *In re Byers*, 230 F.2d 451, 454 (C.C.P.A. 1956). Hester's alleged "legislative history"—a 1954 commentary of PTO Examiner Federico on the 1952 Patent Act published two years after its enactment—confirms the absence of any "indication in the printed record that this change in language was intended to effect any change in substance." Pet. App. 85a.

A. This Court Has Repeatedly Found No Correctable "Error" In Cases With No Claim Amendment Or Cancellation.

If Hester's argument were correct, one would expect that under the pre-1952 patent statutes, this Court would have sustained the validity of all reissued patents claiming subject matter that was not surrendered through claim amendment or cancellation. But Hester is not correct. On at least four occasions, this Court invalidated for want of correctable "error" reissued patents claiming subject matter that was *not* surrendered through amendment or cancellation.

In *James* v. *Campbell*, 104 U.S. 356 (1882), the asserted patent related to a stamp for postmarking letters and canceling postage stamps. The original claims required a blotter made of "wood, cork or rubber." The reissued claims permitted "cork, wood, or other suitable material." Citing representations in the specification that the use of elastic materials such as cork or rubber afforded advantages over the use of metal, this Court found that any claim which could be construed to embrace a blotter made of metal was void, since the omission of claims having such scope could

not have been a product of inadvertence or mistake. *Id.* at 375-76. If the patentee in that case presented, but canceled or amended, the broader claims during original prosecution, that fact is neither mentioned in this Court's opinion nor cited in support of this Court's determination of invalidity.

In *Gage* v. *Herring*, 107 U.S. 640 (1883), the original patent claimed a device for cooling and drying meal as an arrangement and combination of seven elements. The first claim in the reissued patent was broader in that it claimed a combination of only five of the seven elements recited in the original patent claim. There is no indication that the broadened subject matter of the first claim was surrendered by cancellation or amendment during original prosecution. In addition to citing the patentee's delay in seeking reissue, this Court found there was no correctable error. *Id.* at 645.

The original patent in *Coon* v. *Wilson*, 113 U.S. 268 (1885), covered a collar having short or sectional bands. On reissue, the patentee added claims to a collar having a single band that is curved and tapered—claim scope that this Court's opinion does not indicate was surrendered by amendment or cancellation during original prosecution. The Court, nevertheless, invalidated the patent, finding that reissue was "sought merely to enlarge the claim of the original patent, by repeating that claim and adding others" and that "no mistake or inadvertence is shown, so far as the short or sectional bands are concerned." *Id.* at 277.

The original patent in *Newton* v. *Furst & Bradley Mfg. Co.*, 119 U.S. 373 (1886), was directed to an improvement in plows. It claimed a combination of a lever, a rod, and a brake "arranged and operated as and for the purpose described." *Id.* at 381. The claims of the reissued patent were directed to a different combination—a swing-axle, a carrying wheel, and a "friction-clutch mechanism." *Ibid.* There is no indication anywhere in this Court's opinion that

the combination claimed in reissue was abandoned by cancellation or amendment during original prosecution. Once again, this Court found that the error requirement was not met. *Id.* at 385.

If, as Stein and Hester agree, the 1952 Patent Act effected no change in the legal standard of correctable "error," then there is no reason for this Court to grant Hester's petition. As *James, Gage, Coon*, and *Newton* all establish, the scope of correctable "error" has never been so broadly interpreted as to allow the patentee to reissue *any* claim that was not abandoned through cancellation or amendment. Nothing in this Court's pre-1952 case law contradicts or is inconsistent with the Federal Circuit's determination that the "error" requirement of § 251 was not satisfied when Hester claimed subject matter that it surrendered at least 42 times by argument. Thus, by Hester's own admission, nothing in the 1952 Patent Act is inconsistent with the Federal Circuit's decision in this case.

B. Federico's Commentary Does Not Create A Conflict Between The 1952 Patent Act And The Federal Circuit's Decision.

Ignoring this Court's pre-1952 "error" precedent, Hester attempts to create a conflict with the 1952 Patent Act by misreading Federico's commentary and then improperly elevating this misreading to the status of "definitive legislative history." Through this device, Hester arrives at its conclusion that there is no bar to reissue "so long as there has been no claim amendment or cancellation."

Federico's commentary is obviously not "legislative history." Although Federico participated in drafting the language of the 1952 Patent Act, he was not a member of Congress. He served on no staff, either of any individual Congressman or of any Congressional Committee (although

he acted as a consultant for the House Committee). He did not participate in the deliberative process surrounding enactment of the 1952 Patent Act. See *Gustafson* v. *Alloyd Co.*, 513 U.S. 561, 580 (1995) ("If legislative history is to be considered, it is preferable to consult the documents prepared by Congress when deliberating"). And his commentary was never adopted as legislative history. Indeed, it was written well after enactment and for that reason alone is not "legislative history." See *United States* v. *Texas*, 507 U.S. 529, 535 n.4 (1993). Nothing in the plain language of § 251 indicates that Congress intended that reissue be available in all instances where claim scope was not surrendered by cancellation or amendment. Federico's commentary on the 1952 Patent Act *cannot* support such a gloss.

And Frederico's commentary *does not* support the "legislative intent" that Hester advocates. Federico says only that the "error" provisions of the prior patent statutes were "liberally construed." He does not suggest that this "liberal construction" permitted reissue in all instances, except when the patentee sought claims surrendered through amendment or abandonment. Any such a suggestion would have been ridiculous—given this Court's decisions in *James, Gage, Coon*, and *Newton*.

C. The Federal Circuit Has Consistently Found No Correctable "Error" Where Claims Were Not Abandoned Or Amended.

Hester claims that the Federal Circuit "improperly revised" § 251 by invalidating reissued claims that were not canceled or surrendered by amendment during original prosecution. Pet. 21. If so, that "revision" was accomplished long before the Federal Circuit's decision in this case. On at least two occasions before this one, the Federal Circuit has invalidated (or held unpatentable) for want of

correctable "error" reissued claims that were not canceled or amended during original prosecution.

In the first case, *In re Weiler*, 790 F.2d 1576 (Fed. Cir. 1986), the original patent claimed a method for the quantitative analysis of "limonin." In reissue, the patentee sought claim 13, directed to a method for developing citrus strains low in limonin by identifying mutants having a low limonin content, and claim 19, directed to a gamma globulin fraction including antibodies reactive with limonin. The subject matter of claims 13 and 19 was not presented during original prosecution. Yet the Federal Circuit affirmed the Board of Patent Appeals and Interference's determination of invalidity, since Weiler "made [no] showing on which error could be found as the cause of his failure to claim the subject matter of claims 13 and 19." *Id.* at 1582-1583. Thus, the Federal Circuit found no correctable "error" within the meaning of § 251, even though the claims were not abandoned by amendment or cancellation.

In the second case, *Hewlett-Packard Co.* v. *Bausch & Lomb Inc.*, 882 F.2d 1556 (Fed. Cir. 1989), the patentee sought reissue to add claims of a narrower scope, directed to specific features of an X-Y plotter disclosed in the original patent. Litigation discovery demonstrated the falsehood of affidavits submitted to the PTO in support of the patentee's claim of correctable error. The affidavits asserted error arising out of poor communication between the inventor and his attorney; the attorney's diary showed frequent contact. The patentee urged that the attorney affidavit was immaterial, contending that correctable "error" is present whenever a patentee could have, but did not, include a narrower claim during original prosecution. This argument, which is substantially identical to the one advanced by Hester, was rejected by the Federal Circuit as collapsing the defect and error provisions of § 251 into a single inquiry, wherein the

omission of claims gives rise to an inference of "oversight." *Id.* at 1565. Once again, the Federal Circuit found no correctable "error" within the meaning of § 251 even though the claims were not abandoned by amendment or cancellation.

In short, this case does not present any break with post-1952 reissue law. Twice previously, the Federal Circuit refused to find correctable error in cases where the reissued claims were not canceled or surrendered by amendment in original prosecution. The Federal Circuit's decision in this case is completely consistent with *Weiler* and *Hewlett-Packard*, and with prior decisions of this Court.

D. The Federal Circuit's Decision Does Not Conflict With 35 U.S.C. § 252.

Hester's petition (at 23) criticizes the Federal Circuit's decision for failure to consider "the factors legislatively mandated by the last paragraph of Section 252." In so doing, Hester mixes statutory apples and oranges. As the Federal Circuit explained, section 251 sets forth two substantive conditions for the validity of a reissued patent—that it be issued only for certain correctable errors, and that it claim the "invention disclosed in the original patent." Pet. App. 15a-16a. Once the Federal Circuit determined that recapture of subject matter surrendered through argument was not correctable "error," it held Hester's reissued patents invalid under § 251.

Section 252, in contrast, presumes a valid patent. That provision codifies the equitable doctrine of "intervening rights," as set forth by this Court in *Sontag Chain Stores Co.* v. *National Nut Co.*, 310 U.S. 281 (1940). Under this doctrine, a court may grant an accused infringer a limited right to continue a practice that infringes a reissued claim, but not an original patent claim, typically for a time suffi-

cient to recoup its investment. Once the Federal Circuit invalidated Hester's reissued claims, there was no need to evaluate Stein's entitlement to "intervening rights," since Stein required no such "rights."

II. THERE IS NO "CONFLICT" BETWEEN THE FEDERAL CIRCUIT AND THE PTO.

Hester's petition hypothesizes a conflict between the Federal Circuit's decision and "long-standing USPTO practice." Pet. 22. As evidence of this alleged "long-standing practice," Hester cites the issuance of its own patents! *Id.* at 8. Hester's suggestion that each of the hundreds of patents that are reissued each year is now at risk is baseless.[5/] There is no reason to believe that patent applicants and the PTO have made a "practice" of violating the law by seeking and granting reissued patents that do not comply with the "error" requirements of § 251. If there were such a "practice" within the PTO, that practice would be owed no deference by the Federal Circuit or any other court in this country. As this Court has observed:

> Where it is evident that the commissioner, under a misconception of the law, has exceeded his authority in granting or reissuing a patent, there is no sound principle to prevent a party sued for its infringement from availing himself of the illegality, independently of any statutory permission so to do.

Mahn v. *Harwood*, 112 U.S. 354, 358 (1884). In such cases, "the courts are not bound by the decision of the commissioner." *Ibid.*

[5/] A LEXIS search immediately preceding the filing of this Brief in Opposition reveals that no district court has cited either the Federal Circuit's or the District Court's decision in supporting a judgment that invalidated a reissued patent.

Whatever potential for "conflict" might be raised through judicial review of § 251 "error" compliance was eliminated by the PTO in December 1997. Effective December 1, the PTO revised its regulations relating to the content of the reissue oath or declaration to eliminate the requirement for a factual showing of how the error(s) to be corrected by reissue arose or occurred. See *Commentary to PTO Revision of 37 C.F.R. § 1.175*, printed in 54 Pat. Trademark & Copyright J. (BNA) 544 (Oct. 16, 1997). In responding to comments that judicial review of "error" compliance is difficult to obtain, and that the courts and public are at a disadvantage absent an explanation of how the applicant's alleged error occurred, the Patent Office cited its inability to subpoena witnesses and evidence. In other words, the Patent Office has left it to the federal courts to police compliance with the "error" requirement of § 251. Under these circumstances, neither the Federal Circuit nor any other court could possibly invalidate a reissued patent in a manner that conflicts with a PTO standard for evaluating correctable error. Since December 1997, there has been no such "standard" because the PTO stopped examining reissue applications for correctable error.

III. THIS CASE RAISES NONE OF THE ISSUES DECIDED IN *WARNER-JENKINSON*.

Hester's petition purports to find tension between the Federal Circuit's decision in this case and those portions of this Court's decision in *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 117 S. Ct. 1040 (1997), relating to prosecution history estoppel as a limitation on infringement under the doctrine of equivalents. However, Hester's petition raises no issues of prosecution history estoppel, of infringement under the doctrine of equivalents, or of infringement in general. In fact, Hester admits that "*Warner-Jenkinson* does not address the equitable issue of

whether a patent owner can obtain a broadened reissue where there was no claim amendment or cancellation." Pet. 20. Instead, Hester complains that the Federal Circuit erred when it analogized the § 251 issue to surrenders under the doctrine of prosecution history estoppel of patent coverage pursuant to the doctrine of equivalents, which, under the Federal Circuit's precedent, may be effected by argument without cancellation or amendment. See *Texas Instruments*, 988 F.2d at 1173-74. Hester's objections are directed not to the *substance* of the Federal Circuit's holding in this case, but to its *reasoning*. Thus, Hester asks this Court to grant certiorari solely for the purpose of disagreeing with the Federal Circuit's reasoning (via analogy) in a case that raises no issues of prosecution history estoppel. But this Court reviews judgments, not opinions, *Chevron U.S.A., Inc.* v. *NRDC*, 467 U.S. 837, 842 (1984), or statements made in opinions. *Black* v. *Cutter Labs.*, 351 U.S. 292, 297 (1956).

Beyond this, the Federal Circuit's reasoning is sound. The analogy that the Federal Circuit drew between recapture limitations on the scope of correctable error and prosecution history estoppel limitations on the doctrine of equivalents is valid. The recapture rule and prosecution history estoppel share a common basis in this Court's case law—with cases under one doctrine frequently cited in or as support for the other. See *Crawford* v. *Heysinger*, 123 U.S. 589, 606 (1887) (citing a recapture case, *Leggett v. Avery*, 101 U.S. 256 (1880), as authority for a finding of prosecution history estoppel); *Shepard* v. *Carrigan*, 116 U.S. 593, 597-98 (1886) (same). And they share a common basis in policy—the exoneration of a competitor's reasonable reliance on the record that the patentee deliberately created in the PTO.[6/]

[6/] See *Gage*, 107 U.S. at 645 ("any mistake in the claim, which is the more important part, and upon which other inventors and the

Once the Federal Circuit drew this analogy, it was entirely correct in finding (citing *Texas Instruments*) that "[t]he same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that arguments alone can give rise to a surrender for purposes of the recapture rule." Pet. App. 21a. Moreover, the Federal Circuit has concluded that prosecution history itself, even apart from prosecution history estoppel, may affect the legal construction of the scope of patent claims. See *Alpex Computer Corp.* v. *Nintendo Co.*, 102 F.3d 1214, 1220 (Fed. Cir. 1996), cert. denied, 117 S. Ct. 2480 (1997). It follows, then, that the abandonment of arguments in order to win approval of claims may impact the legal construction of the claim scope to which the applicant is entitled for recapture purposes.

Hester gets nowhere by citing out of context a quotation from this Court's decision in *Warner-Jenkinson*. Pet. 15. The Court was not addressing the propriety of finding estoppel from argument—an issue concededly not before it in *Warner-Jenkinson*. Pet. 20. Instead, this Court merely pointed out that in each of its cases finding prosecution history estoppel, the surrender was tied to the avoidance of

---

public have the right to rely, as defining the limits of the invention patented, would be apparent on the face of the patent and could not escape the notice of any person reading it with the least care and attention"); *Warner-Jenkinson*, 117 S. Ct. at 1051 ("The presumption * * * gives proper deference to the role of claims in defining an invention and providing public notice"); *Mentor*, 998 F.2d at 996 ("the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so"); *Lemelson* v. *General Mills, Inc.*, 968 F.2d 1202, 1208 (Fed. Cir. 1992) ("Other players in the marketplace are entitled to rely on the record made in the Patent Office in determining the meaning and scope of the patent").

prior art or to some other concern that would have rendered the claimed subject matter unpatentable. The Court certainly gave no indication that it meant to overrule the numerous Federal Circuit cases finding estoppel from surrenders of subject matter by argument alone.[7/]

CONCLUSION

For the reasons set forth above, the petition for writ of certiorari should be denied.

Respectfully submitted.

L. GENE SPEARS
Arnold, White & Durkee
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1611

STEPHEN M. SHAPIRO
Counsel of Record
JEFFREY W. SARLES
Mayer, Brown & Platt
190 South LaSalle Street
Chicago, Illinois 60603
(312) 782-0600

CHARLES H. DE LA GRAZA
Arnold, White & Durkee
4850 First Bank Place
601 Second Avenue South
Minneapolis, Minnesota 55402
(612) 321-2800

Counsel for Respondent

SEPTEMBER 1998

7/ See *Standard Oil* v. *American Cyanamid Co.*, 774 F.2d 448, 452 (1985); *Texas Instruments*, 988 F.2d at 1173-74; *Southwall Technologies, Inc.* v. *Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995); *Cole* v. *Kimberley-Clark Corp.*, 102 F.3d 524 (Fed. Cir. 1996), cert. denied, 118 S. Ct. 56 (1997).

Supreme Court, U.S.
FILED
SEP 28 1998
OFFICE OF THE CLERK

(3)

No. 98-239

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1998

HESTER INDUSTRIES, INC.,

Petitioner,

vs.

STEIN, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

ROBERT W. ADAMS
Counsel of Record
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4000

Attorneys for Petitioner

TABLE OF CONTENTS

Page

The Federal Circuit Has Inconsistently Applied *Warner-Jenkinson* In Three Recent Decisions 1

No Factual Disputes Are Presented By This Petition 3

The Case Law, Legislative History And USPTO Rules Support The Grant Of This Petition 3

CONCLUSION 9

TABLE OF CITATIONS

Cases Cited **Page**

Amos, In re, 953 F.2d 613 (Fed. Cir. 1991)..... 8

Aro Mfg. Co., Inc. v. Convertible Top Replacement Co., Inc., 365 U.S. 336 (1961)..... 4

Ball Corp. v. United States, 729 F.2d 1429 (Fed. Cir. 1984)..... 8

BIC Leisure Prods. v. Windsurfing International, 1 F.3d 1214 (Fed. Cir. 1993)..... 4

Coon v. Wilson, 113 U.S. 268 (1885) 6

Donaldson, In re, 16 F.3d 1189 (Fed. Cir. 1994)..... 4

Gage v. Herring, 107 U.S. 640 (1883) 6, 7

Graham v. John Deere Co., 383 U.S. 1 (1966)..... 3

Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472 (Fed. Cir. 1998)..... *passim*

Hewlett-Packard Co. v. Bausch & Lomb Inc., 882 F.2d 1556 (Fed. Cir. 1989)..... 8

Hodosh v. Block Drug Co., 833 F.2d 1575 (Fed. Cir. 1987) 4

Hughes Aircraft Co. v. United States, 148 F.3d 1384 (Fed. Cir. 1998)..... 1, 2, 3, 10

Hughes Aircraft Co. v. United States, 140 F.3d 1470 (Fed. Cir. 1998) 2

Hughes Aircraft Co. v. United States, 215 U.S.P.Q. 787 (Ct. Cl. 1982), *aff'd-in-part, rev'd-in-part*, 717 F.2d 1315 (Fed. Cir. 1983) 2

James v. Campbell, 104 U.S. 356 (1882) 6

Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449 (Fed. Cir. 1998) 2

Mentor Corp. v. Coloplast, Inc., 998 F.2d 992 (Fed. Cir. 1993) 9

Newton v. Furst & Bradley Mfg. Co., 119 U.S. 373 (1886) 6-7

Schrader, In re, 22 F.3d 290 (Fed. Cir. 1994) 4

Texas Instruments Inc. v. United States Int'l Trade Comm'n, 988 F.2d 1165 (Fed. Cir. 1993) 8

Topliff v. Topliff, 145 U.S. 156 (1892) 9

U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp., 315 U.S. 668 (1942) 8

United States v. Adams, 383 U.S. 39 (1966) 3

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 117 S. Ct. 1040 (1997) 1, 2, 3

Weiler, In re, 790 F.2d 1576 (Fed. Cir. 1986).....7, 8

Wilder, In re, 736 F.2d 1516 (Fed. Cir. 1984)..... 9

Other Authorities **Page**

35 U.S.C. § 251 ..... *passim*

P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (1954) 4, 5, 6

Hon. Giles Rich, *Congressional Intent – Or, Who Wrote The Patent Act of 1952, in Patent Procurement and Exploitation* 61 (1963) 5

Manual of Patent Examining Procedure (6th ed. rev. 3 1997) 9

The Federal Circuit Has Inconsistently Applied *Warner-Jenkinson* In Three Recent Decisions

During the year following this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997), the Federal Circuit has inconsistently applied that holding in three different cases. Hester's main brief discussed the *Hester* and *Litton* cases.

Since the filing of its main brief, Hester has become aware of a more recent decision where a number of the Federal Circuit judges state in dissent that the court again misapplied *Warner-Jenkinson*. *See Hughes Aircraft Co. v. United States*, 148 F.3d 1384 (Fed. Cir. 1998). Judge Clevenger's dissent (joined in by Judge Gajarsa) states that *Hughes* is contrary to *Warner-Jenkinson* because the Federal Circuit held that the doctrine of equivalents applies even where prosecution history estoppel arises from claim amendments. *Id.* at 1385-86. Because of the importance of this conflict, Judge Clevenger urges that "the Solicitor General should ask the Supreme Court to grant a writ of certiorari in this case." *Id.* at 1386. Indeed, "The question posed ... is of utmost importance to patent law" and that a "swift answer to the question is needed." *Id.*

The striking disparity of application by the Federal Circuit of the *Warner-Jenkinson* decision in both the *Hester* and *Hughes* decisions is easily illustrated. In *Hester*, the Federal Circuit applied *Warner-Jenkinson* as support for the proposition that the recapture doctrine applies in the absence of claim amendment or cancellation despite the plain language in *Warner-Jenkinson* that this Court's "prior cases have consistently applied prosecution history estoppel only where claims have been amended for a limited set of

reasons, and we see no substantial cause for requiring a more rigid rule invoking an estoppel regardless of the reasons for a change." *Warner-Jenkinson*, 520 U.S. at __, 117 S. Ct. at 1050 (emphasis added).

Moreover, in *Hester*, the Federal Circuit improperly applied *Warner-Jenkinson* even though it did not involve a reissue patent, the meaning of "error" under Section 251, or patent invalidity under the recapture doctrine. Thus, the Federal Circuit in *Hester* also improperly expanded prosecution history estoppel by, for the first time, holding that attorney argument alone without any amendment or cancellation of claims can invalidate a reissue patent.

In contrast, in *Hughes*, the Federal Circuit refused to estop the patentee from asserting all equivalents based on prosecution history estoppel even though the claims were actually amended. *See Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1477 (Fed. Cir. 1998). In fact, all of the original claims were cancelled in *Hughes* and were replaced with new claims in order to overcome cited prior art. *See Hughes Aircraft Co. v. United States*, 215 U.S.P.Q. 787, 793 (Ct. Cl. 1982).

Simply stated, in *Hester* the Federal Circuit applied prosecution history estoppel to hold that mere argument (with no amendment of claims) invalidated reissue claims under the recapture doctrine whereas, in *Hughes*, it held that even the amendment of claims to overcome prior art did not invoke the doctrine of prosecution history estoppel to preclude application of the doctrine of equivalents.[1]

---

[1] Likewise, the Federal Circuit decision in *Litton* is inconsistent with *Hester*. *See Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1461

The repeated, inconsistent application of *Warner-Jenkinson* justifies the grant of petitions in *Hester* and *Hughes*. Significantly, multiple petitions have been granted under similar circumstances in the past in order to clarify patent law. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966); *United States v. Adams*, 383 U.S. 39 (1966).

No Factual Disputes Are Presented By This Petition

Stein's brief concedes that the only fact relevant to this petition is that Hester did not amend or cancel claims during the original patent prosecution.[2] Thus, the question is simple: "Is attorney argument alone (without claim amendment or cancellation) contemplated by the recapture doctrine under 35 U.S.C. § 251? *See Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1481 (Fed. Cir. 1998).

The Case Law, Legislative History And USPTO Rules Support The Grant Of This Petition

---

(Fed. Cir. 1998), where the court permitted the application of the doctrine of equivalents despite claim amendment to overcome prior art.

[2] The "analogy" to the three-legged chairs provided on page 3 of Stein's brief is not apt. The premise for that analogy is that a four-legged chair existed in the prior art.

In this case, however, there was no "four-legged chair" in the prior art. In Hester's situation – to make the analogy applicable – there is a five-legged chair in the prior art, but not a four-legged one. Hester argued in the original patent application that its three-legged chair claims were patentable over the five-legged chair. After issuance of the original patent, Hester realized that it could have claimed a "less than five-legged chair" and still have a patentable claim. This is what the reissue statute specifically authorizes and is exactly what Hester did.

First, Stein does not cite any legislative history to support its position. In fact, it concedes that the only discussion of Section 251 by any person involved in the drafting of the 1952 Patent Act is set forth in the writings of P.J. Federico, who was the primary drafter of that Act.

Mr. Federico wrote in his *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (1954) (App. F at 83a), that "error" as used in Section 251 is to be "liberally construed, except when the reissue sought to recapture claims cancelled during the prosecution of the original patent." *Id.* at 43. Thus, the *Commentary* is clear that broadening reissue is proper in all cases except where the patentee seeks to obtain claims that were cancelled during patent prosecution.

In an effort to denigrate Mr. Federico, Stein argues that his *Commentary* is not legislative history because he "was not a member of Congress" and he had no "staff" position with Congress.[3] Stein asserts that Mr. Federico merely "acted as a consultant for the House Committee."

---

[3] The Federal Circuit has taken a somewhat contradictory view of the *Commentary* as legislative history. *Compare In re Schrader*, 22 F.3d 290, 295 n.11 (Fed. Cir. 1994) (*Commentary* cited as "*See also*" with respect to legislative history); *BIC Leisure Prods. v. Windsurfing Int'l*, 1 F.3d 1214, 1221 (Fed. Cir. 1993) (*Commentary* cited as legislative history with respect to reissue statute); *Hodosh v. Block Drug Co.*, 833 F.2d 1575, 1578 (Fed. Cir. 1987) (*Commentary* cited as legislative history), *with In re Donaldson*, 16 F.3d 1189, 1193 n.3 (Fed. Cir. 1994) (*Commentary* not legislative history *per se*). In any event, the Federico *Commentary* has been cited as an authoritative indication of the meaning of the 1952 Patent Act. *See, e.g., Aro Mfg. Co., Inc. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336, 342 n.8 (1961).

That characterization is misleading since the House subcommittee on patents expressly asked Mr. Federico to draft the 1952 Patent Act, including Sections 251 and 252, in view of his position and expertise as Examiner-In-Chief of the Patent Office. *See* Hon. Giles Rich, *Congressional Intent – Or, Who Wrote The Patent Act of 1952, in Patent Procurement and Exploitation* 63-66 (1963).

Stein also ignores that Mr. Federico acted as a technical advisor or assistant during subcommittee hearings and meetings. *Id.* at 63-73. In short, Mr. Federico's *Commentary* (even if it is not legislative history *per se*) is the single most definitive source document regarding the meaning of Section 251. Congressman Crumpacker (who actively participated in the hearings as a member of the House patent subcommittee) put it best when he stated:

> When the courts, in seeking to interpret the language of the [1952 Patent] Act, go through the ritual of seeking to ascertain the "intent of Congress" in adopting same, they would do well to look to the writings of these men – Federico, Rich, Harris, and the others – as they, far more than any member of the House or Senate, knew and understood what was intended by the language used. [*Id.* at 78.]

Second, Stein incorrectly asserts that the recapture rule has been applied where there was no amendment or cancellation of claims during the original prosecution. That assertion is contrary to the Federal Circuit's opinion which considered the issue to be one of first impression. *See Hester Indus.*, 142 F.3d at 1481. Notably, the Federal Circuit rejected Stein's interpretation of the key cases cited in its opposition brief.

With respect to *James v. Campbell*, 104 U.S. 356 (1882), the patentee amended the claim during prosecution of the original patent application. In the 1880s, claims were written to relate back to the patent specification. Thus, original patent claim 1 covered a cancelling stamp device "substantially as herein described and set forth" in the specification. *Id.* at 361. Significantly, the patentee amended the specification during the original prosecution to limit the cancelling stamp to being made of "cork, rubber or other elastic substance." *Id.* at 368-69, 375-76. The reissue patent claims, however, covered "cork, wood, or other suitable material." *Id.* at 373. The Court invalidated the reissue claims because they covered non-elastic metal devices. *See id.* at 376. Thus, *James* actually holds that recapture applies where an amendment or cancellation of claims occurs during prosecution of the original application.

The other Supreme Court cases cited by Stein are irrelevant. For example, *Coon v. Wilson*, 113 U.S. 268 (1885), is not applicable since the "description [of the invention] had to be changed in the reissue, to warrant the new claims in the reissue." *Id.* at 277. Here, Hester's original and reissue specifications are identical. Thus, *Coon* merely conforms with the prohibition of the addition of "new matter" in reissues. 35 U.S.C. § 251, para. 1.

The remaining Supreme Court decisions concerned prior law that permitted the filing of reissue patent applications more than two years after issuance of the original patent. However, the 1952 Act changed that law and introduced a two-year limitation for filing a broadening reissue. *See* Federico, *Commentary*, 35 U.S.C.A. at 44-45. Thus, *Gage v. Herring*, 107 U.S. 640 (1883), and *Newton*

v. Furst & Bradley Mfg. Co., 119 U.S. 373 (1886), are not relevant since the reissues were sought in those cases more than 13 years after the original patents issued.[4]

Stein also cites two Federal Circuit decisions as support for its position. However, the Federal Circuit expressly rejected Stein's interpretation of these cases when it held that the issue in this case "has not been squarely addressed" before. *Hester Indus.*, 142 F.3d 1481.

In *In re Weiler*, 790 F.2d 1576 (Fed. Cir. 1986), the court applied the recapture doctrine to claims that were cancelled during the original prosecution. Specifically, after the original application was filed, the Examiner found that it contained 3 separate inventions and required the patentee to restrict the claims in the patent application to just one invention and to cancel the other claims. In that situation, if an applicant wishes to pursue patent protection for the cancelled claims, he must file a separate divisional application directed to those other claims. *Id.* at 1578.

Weiler cancelled claims, but he failed to file the divisional application. He sought to regain the cancelled claims via reissue. By acquiescing to the Examiner's restriction requirement, by deliberately cancelling claims during original prosecution and by failing to file a

---

[4] Other substantive grounds existed for the invalidation of those patents. In *Newton*, the reissue claims also were invalidated because they covered prior art devices. This, of course, is not permitted.

In *Gage*, this Court found no error because the original patent specification did not disclose the invention claimed in the reissue.

divisional application, Weiler was barred from broader reissue protection.[5] *See id.* at 1582-83.

Stein's reliance on *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556 (Fed. Cir. 1989), is likewise misplaced because it involved a "narrowed" reissue patent application. The decision stresses this fact and indicates that, because the narrower claims were necessarily encompassed within the scope of the original claims of the earlier application, they were effectively abandoned during the original prosecution. *See id.* at 1566.

The *Hester* case involves an entirely different situation. Here, the broadened reissue patent claims were never even considered during the original prosecution. Indeed, *Hewlett-Packard* specifically distinguished the narrowed patent reissue situation (where "error" cannot be found) from the broadened reissue case (where "error" is found). *See id.* (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1435-36 (Fed. Cir. 1984)). Hester's broadened reissue patents fall squarely within the *Ball* precedent.

Finally, Stein relies upon *Texas Instruments Inc. v. United States International Trade Commission*, 988 F.2d 1165 (Fed. Cir. 1993) and the cases cited in footnote 7. Those decisions did not involve any attorney arguments that were alleged to constitute the "error" supporting reissue.

---

[5] The comments in *Weiler* relating to claims 13 and 19 show that those claims failed to satisfy the "intent to claim" (same invention) test of *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942). However, *Weiler* was decided prior to *In re Amos*, 953 F.2d 613, 617-19 & n.2 (Fed. Cir. 1991), wherein the Federal Circuit held that the 1952 Act eliminated "intent to claim" as a separate requirement. *See also Hester Indus.*, 142 F.3d at 1484-85.

Consequently, they are not relevant to this case or to 35 U.S.C. § 251.[6] Moreover, they fail to discuss or apply the "intervening rights" test mandated under Section 252.

Thus, reissue law is uniform that recapture arises only by virtue of a claim amendment or cancellation during patent prosecution. *See, e.g., Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995-96 (Fed. Cir. 1993).

Third, Stein does not dispute that the current Rules of Practice at the USPTO only invoke the recapture rule where patent claims were amended or cancelled during the prosecution of the patent application. *See* Section 1412.02 of the *Manual of Patent Examining Procedure* (6th ed. rev. 3 1997). Rather, Stein attempts to confuse the issue by citing a recent change in USPTO Rules that eliminates the need for the reissue applicant to make a showing of "error." While this is intellectually interesting, the fact that a reissue applicant no longer needs to provide a factual basis for the "error" is totally unrelated to the application of the recapture doctrine under Section 1412.02.

CONCLUSION

---

[6] An underlying premise for the "liberal application" of the "error" language in 35 U.S.C. § 251 is the recognition that a patent owner should not be penalized due to the mistakes of its attorney or the failure of the inventor to understand the complexity of patent law with respect to drafting the patent claims and specification. *See In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984); *see also Topliff v. Topliff*, 145 U.S. 156, 171 (1892) ("The specification and claims of a patent ... constitute one of the most difficult legal instruments to draw with accuracy."). Here, the "error" was the argument of Hester's prior patent counsel. Under the reissue statute, Hester has a two-year "window" to correct that attorney "error" by filing a broadening reissue application.

No precedent from the legislative history, case law or USPTO Rules supports the holding that mere attorney argument can serve as the sole basis for invoking the recapture doctrine. Because the Federal Circuit has exclusive jurisdiction over patent disputes, this decision, unless reversed now, will be binding in all future patent litigation and upon the USPTO. As a result, this is the one and only time that this issue will be presented to this Court.

Moreover, the *Hester* decision will have an immediate, adverse impact upon patent practitioners and inventors. They will find themselves forever barred from correcting an "error" by virtue of the Federal Circuit's extension of the recapture doctrine to attorney arguments alone (i.e., in the absence of claim amendment or cancellation). In addition, the decision will invalidate hundreds of existing reissue patents so as to deprive inventors of their "exclusive Right to their ... Discoveries" under Art. I, Sec. 8, clause 8 of the Constitution.

Finally, *Hester* is one in a series of Federal Circuit decisions that inconsistently apply *Warner-Jenkinson*. The grant of this petition will permit the Court to clarify a critical area of patent law that has been confused by recent Federal Circuit decisions.

Respectfully submitted,

ROBERT W. ADAMS
Counsel of Record
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4022

Supreme Court, U.S.
FILED
OCT 5 1998
OFFICE OF THE CLERK

(4)

No. 98-239

In the Supreme Court of the United States

OCTOBER TERM, 1998

HESTER INDUSTRIES, INC., PETITIONER,

v.

STEIN, INC., RESPONDENT.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

SUPPLEMENTAL BRIEF FOR THE RESPONDENT

L. GENE SPEARS
Arnold, White & Durkee
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1611

STEPHEN M. SHAPIRO
Counsel of Record
JEFFREY W. SARLES
Mayer, Brown & Platt
190 South LaSalle Street
Chicago, Illinois 60603
(312) 782-0600

CHARLES H. DE LA GRAZA
Arnold, White & Durkee
4850 First Bank Place
601 Second Avenue South
Minneapolis, Minnesota 55402
(612) 321-2800

Counsel for Respondent

3 pp

SUPPLEMENTAL BRIEF FOR THE RESPONDENT

Pursuant to Supreme Court Rule 15.8, Respondent Stein, Inc. ("Stein") submits this Supplemental Brief to address new "authority" raised in the Reply Brief of Petitioner Hester Industries, Inc. ("Hester")—namely, Judge Clevenger's dissent from the denial of *en banc* rehearing in *Hughes Aircraft Co.* v. *United States*, 148 F.3d 1384 (Fed. Cir. 1998). The concerns voiced by Judge Clevenger in that dissent do not bear on any issue in this case, and thus that dissent does not support Hester's request that its petition be granted.

The Federal Circuit's decision in *Hughes* addressed a very different issue from that presented in Hester's petition. *Hughes* concerns prosecution history estoppel as a limitation on the doctrine of equivalents. See *Hughes Aircraft Co.* v. *United States*, 140 F.3d 1470, 1475 (Fed. Cir. 1998). It does not even address the issue presented in Hester's petition—the recapture limitation on the scope of error correctable under § 251. But even if this Court chose to analogize these two disparate points of patent law and address them within a common framework, it would find nothing in the *Hughes* decision that either contradicts or calls into question what the Federal Circuit did in its unanimous decision in this case.

Hester's petition questions what acts (*e.g.*, amendment, cancellation, and argument) may work a surrender of subject matter that cannot be remedied in reissue. The analogous question—what acts may work a prosecution history estoppel—is not raised in *Hughes*. In *Hughes*, the patent applicant narrowed its claims in response to a prior art rejection. *Hughes Aircraft*, 140 F.3d at 1477. The Federal Circuit found that this prosecution history would "serve to narrow the range of equivalents," but held that this narrowing "did not surrender" the specific subject matter accused of infringement. *Ibid.* Judge Clevenger's dissent proposes that the latter holding is inconsistent with *Warner-*

Jenkinson Co. v. *Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). Specifically, Judge Clevenger read *Warner-Jenkinson* as suggesting that *any* assertion of equivalents for amended claim limitations is foreclosed. 148 F.3d at 1385-1386.

Whatever the importance of the *Hughes* issue (*i.e.*, whether prosecution history estoppel bars all access to the doctrine of equivalents, without need to examine what subject matter is specifically surrendered), that issue is not raised in this case. Hester does not question that the subject matter it surrendered by argument was sought (and obtained) in its broadened reissue claims. Hester questions only whether it actually surrendered that subject matter in the first instance. *Hughes* does not address that question, either directly or by analogy. Accordingly, Judge Clevenger's dissent adds no weight to Hester's petition.

Respectfully submitted.

L. GENE SPEARS
Arnold, White & Durkee
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1611

STEPHEN M. SHAPIRO
Counsel of Record
JEFFREY W. SARLES
Mayer, Brown & Platt
190 South LaSalle Street
Chicago, Illinois 60603
(312) 782-0600

CHARLES H. DE LA GRAZA
Arnold, White & Durkee
4850 First Bank Place
601 Second Avenue South
Minneapolis, Minnesota 55402
(612) 321-2800

Counsel for Respondent

SEPTEMBER 1998